122-121

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

No. ~~940~~ 566 286

JOHN A. TOPLIFF AND GEORGE H. ELY, APPELLANTS,

vs.

ISAAC N. TOPLIFF.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF OHIO.

Filed Sept 6th 1884

SUPREME COURT OF THE UNITED STATES.

NO. ——

JOHN A. TOPLIFF AND GEORGE H. ELY, APPELLANTS,

sv.

ISAAC N. TOPLIFF.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF OHIO.

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Pleas in the Circuit Court of the United States for the Northern District of Ohio, Eastern Division, at the United States Court rooms in the city of Cleveland in said district, on the 22d day of February, at the February term of said court, in the year of our Lord one thousand eight hundred and eighty-four, and of our independence the one hundredth and eighth year.

AUGUSTUS J. RICKS, *Clerk.*

Circuit Court of the United States for the Northern District of Ohio.

JOHN A. TOPLIFF and GEORGE H. ELY,
Partners under the name and style of
TOPLIFF & ELY, Complainants,
against
ISAAC N. TOPLIFF, Defendant.

BILL IN EQUITY.

To the Honorable Judges of the Circuit Court of the United States in and for the Northern District of Ohio:

John A. Topliff and George H. Ely, of Elyria, county of Lorain and state of Ohio, and citizens of said Northern District, bring this Bill against Isaac N. Topliff, of the city of Cleveland in said Northern District of Ohio.

And thereupon your orators complain and say: that on or before the 24th day of August in the year one thousand eight hundred and seventy-five, the said John A. Topliff was the true, original and first inventor of a certain new and useful improvement in Carriage Bows, not known or used before, and not, at the time of his application for a patent, in public use or on sale with his consent or allowance.

And your orators further show unto your honors that the said John A. Topliff, so being the inventor of said improvement, and being a citizen of the United States aforesaid, made application to the proper department of the United States for letters patent in accordance with the then existing laws of Congress, and having duly complied in all respects with the conditions and requirements of said laws, on the 24th day of August, 1875, aforesaid, letters patent of the United States, signed, sealed and executed in due form of law, for the said invention or improvement of the said John A. Topliff were issued to complainants, your orators; the said John A. Topliff having, before the granting and issuing of said patent, duly assigned one-half of his right, title and interest in said improvement or invention to said George H. Ely, as your orators now allege and as appears on the face of said patent, which said assignment was and is duly recorded in the records of said patent office, by which letters patent there were secured to your orators, their heirs or assigns, for

the term of seventeen years from said 24th day of August, 1875, the exclusive right to make, use and vend the said invention throughout the United States and the territories thereof.

And your orators bring here into court a copy of said letters patent signed by the Acting Secretary of the Interior, and countersigned by the Acting Commissioner of Patents, with the seal of the Patent Office of the United States thereto affixed, and pray that the same may be taken as a part of this bill.

And your orators show that by reason of the aforesaid letters patent they became and ever since have been and now are entitled to and possessed of the exclusive right and liberty of making, constructing, using and vending to others to be used, the aforesaid improvement within and throughout the said United States.

And your orators further aver that they have been in the constant, exclusive and undisturbed use and possession of said improvement or invention described in and secured by said letters patent since the issue of the same as hereinbefore set forth, and have been ever since the issuing of said letters patent, and are now the sole and exclusive owners of said letters patent, and of the improvement or invention therein described and secured.

And your orators further show unto your honors that since the granting of the said letters patent as aforesaid, they, as partners under the aforesaid style of Topliff & Ely, have invested and expended large sums of money and have been at great trouble and expense in and about said invention for the purpose of carrying on the business of manufacturing and selling the same, and making the same profitable to themselves and useful to the public, and that said invention has been and is of great utility and value to the public, and has been and is sold by your orators to the great benefit and advantage of your orators and of the public, and that the public have acknowledged the right of your orators under said patent and have acquiesced in the same with the single exception hereinafter stated of infringement by said defendant; and that your orators will realize due gains and profits from said invention if further infringements of said letters patent by said defendant be prevented.

And your orators further show and charge the fact to be that the said defendant, well knowing the premises and the rights acquired by and secured to your orators as aforesaid; but contriving to injure your orators and to deprive them of the benefits and advantages which might and otherwise would accrue unto them from said invention as aforesaid, without the license of your orators, against their will and in violation of their rights as aforesaid since the granting of said letters patent aforesaid, has made and used, offered for sale and sold to others to be used, said invention and improvement, and is now continuing to make and sell said invention within said Northern District of Ohio and elsewhere in said United States, and has threatened and is

threatening to make, use and sell said improvement, and carriage bows containing said improvement, to others throughout the district aforesaid and the United States generally, and your orators have reason to believe will continue to make, use and sell the same, and refuse to pay to your orators any of the profits which he has made by such unlawful manufacture, use or sale, or to desist from making, using, or selling the same in violation and infringement of the rights of your orators secured to them as aforesaid, and against their consent and allowance; all of which acts and doings are in violation of the exclusive rights and privileges so as aforesaid vested in your orators by virtue of said letters patent, and are contrary to equity and good conscience, and tend to the manifest and irreparable injury of your orators in the premises.

Wherefore, and forasmuch as your orators can have no adequate relief except in this honorable court, to the end that the said defendant may, if he can, show why your orators should not have the relief hereby prayed, and may upon his corporal oath and according to his best knowledge, information and belief, full, true, direct and perfect answer make to the premises, and may be compelled to account for and pay to your orators the gains and profits by him acquired from the manufacture and sale as aforesaid, and the damages suffered by your orators from the aforesaid unlawful acts of the defendant, and be restrained from any further violation of the rights of your orators, your orators pray that your honors may grant the writ of injunction issuing out of and under the seal of this honorable court, and to grant a like preliminary injunction to be in force until the final hearing of this cause, enjoining and restraining the said defendant, his servants, agents, attorneys and workmen and each and every of them, from directly or indirectly making, constructing, using, vending, delivering or working or putting or constructing in practice, operation or use, or in anywise counterfeiting or imitating the said invention and improvement or any part thereof; and that the said defendant may be decreed to pay the costs of this suit, and that your orators may have such further or other relief as to this honorable court shall seem meet and as shall be agreeable to equity.

And may it please your honors to grant unto your orators not only a writ of injunction conformable to this bill, and a preliminary injunction in due form as above prayed, but also the writ of subpœna to be issued in this cause out of and under the seal of this honorable court, directed to the said defendant, Isaac N. Topliff, commanding him by a certain day therein to be named to be and appear in this honorable court, then and there to answer the premises and to abide by and perform such order and decree as may be made against him.

And your orators will ever pray.

GEORGE H. ELY,
JOHN A. TOPLIFF.
By WILLEY, SHERMAN & HOYT,
And R. P. RANNEY,
Their Solicitors.

WILLEY, SHERMAN & HOYT and R. P. RANNEY

UNITED STATES OF AMERICA,
Northern District of Ohio,
At Elyria, County of Lorain, ss:

On this 28th day of February, A. D. 1880, before me personally appeared George H. Ely, one of the complainants in the above-entitled cause, who being duly sworn deposes and says: that he has read the foregoing bill of complainant by him and John A. Topliff subscribed, and that the same is true of his own knowledge except as to matters as therein stated on information and belief, and as to those matters he believes it to be true.

GEORGE H. ELY.

Sworn to and subscribed before me this 28th day of February, A. D. 1880.

FRED. A. SMITH,
SEAL. *Notary Public for said county.*

Endorsed as follows:
Filed February 28th, 1880.
A. J. RICKS, Clerk.

THE UNITED STATES OF AMERICA,
Northern District of Ohio, ss:

The President of the United States of America to the Marshal of the Northern District of Ohio, greeting:

You are hereby commanded to summon Isaac N. Topliff, if he be in your district, to be and appear in the Circuit Court of the United States, within and for the district aforesaid, at Cleveland, on the first Monday of April next, to answer a certain bill in chancery filed and exhibited in said court against him by John A. Topliff and George H. Ely. Hereof he is not to fail under the penalty of the law thence ensuing. And have you then and there this writ.

Witness the Honorable Morrison R. Waite, Chief Justice of the United States, this 28th day of February, A. D. 1880, and in the 104th year of the Independence of the United States of America.

SEAL. A. J. RICKS, *Clerk.*
By E. W. PAGE, *Deputy Clerk.*

Memorandum:—The said defendant is required to enter his appearance in this suit in the clerk's office of said court, on or before the first Monday of April, 1880, otherwise the said bill may be taken *pro confesso.* A. J. RICKS, *Clerk.*

NORTHERN DISTRICT OF OHIO, ss:

On the 1st day of March A. D. 1880, I delivered to the within named Isaac N. Topliff a true and duly certified copy of this writ at Cleveland, Ohio.

Fees: Service 2.00; copy .50; actual expense 1.00.
N. B. PRENTICE, *U. S. Marshal.*
By JOHN ODELL, *Deputy.*

Returned and filed March 1st, 1884.
A. J. RICKS, *Clerk.*

IN THE CIRCUIT COURT OF THE UNITED STATES,
In and for the Northern District of Ohio.

JOHN A. TOPLIFF and GEORGE H. ELY, Partners under the name and style of TOPLIFF & ELY, Complainants,
vs.
ISAAC N. TOPLIFF, Defendant.
} IN EQUITY.

ANSWER.

Now comes the defendant, Isaac N. Topliff, and for answer to the bill of complaint filed against him by the above-named complainants, says: That he denies that John A. Topliff was the true, original, and first inventor of a certain new and useful improvement in carriage bows, described in said bill of complaint.

He admits that the said John A. Topliff claimed to be such inventor, and, claiming to be such inventor, that he made application for and secured a patent for such alleged invention in his own name and in the name of his co-complainant, George H. Ely, substantially as alleged in the bill of complaint. This defendant denies that the said complainants by reason of the aforesaid letters patent became or that they now are entitled to and possess all the exclusive rights, right and liberty of making, constructing, using, and vending to others to be used, the aforesaid alleged improvement, within and throughout the United States, as alleged in said bill of complaint. And he denies that they have been and that they are in such exclusive and undisturbed possession of said alleged improvement or invention. He denies that, since the granting of said letters patent as aforesaid, complainants, as partners, under the aforesaid style of Topliff & Ely, have invested and expended large sums of money, and have been at great trouble and expense in and about said invention for the purpose of carrying on the business of manufacturing and selling the same and making the same profitable to themselves and useful to the public; and he denies that said invention has been or is of great utility and value to the public, and that it has been of any utility or value to the public; and he denies that the public have recognized in any manner the exclusive or other right of said complainants in and to said alleged improvement; and he denies that the complainants have or can or that they are entitled to realize any exclusive or other gains or profits from the said alleged invention or improvement. And that this defendant denies every fact, statement, and allegation in said bill contained, alleging or charging him with infringing the rights of the complainants under said letters patent or under any letters patent mentioned in said bill. And this defendant denies each and every other fact, statement and allegation in said bill contained not hereinbefore expressly admitted or denied.

2. And for a further defense this defendant alleges that some time prior to the 27th day of December, 1870, he invented

also agree that they will make them of quality and finish to meet the approbation of said party of the first part.

In witness whereof the parties have set their hands and seals to duplicates the day and year first above written.

I. N. TOPLIFF. [SEAL.]
J. A. TOPLIFF, [SEAL.]
GEORGE H. ELY. [SEAL.]"

Which agreement was duly stamped and executed by the parties.

That, in pursuance of such agreement, the said complainants entered upon the manufacture and sale of carriage bows under the first named patent of this defendant, and from such manufacture they have made great gains and profits and have acquired great wealth. That this defendant devoted his time largely to the introduction and sale of said carriage bows throughout the United States, and also devoted his time, thought, and attention to making improvements therein, and that, from time to time, he did make improvements therein, and did communicate to the complainants the knowledge of the improvements by him made, and did instruct them how to use and apply them. That some of the improvements made by him were patented by the patent bearing date the 16th day of May, 1871, above mentioned. That, in pursuance of his said contract, entered into with the said complainants, as interpreted and understood by both parties, the said complainants adopted and had the exclusive use of said improvements for the period of eight years and more, and up to the time that this defendant commenced the manufacture of carriage bows, in accordance with his said patents, as hereinafter stated. That the said improvement so made by this defendant, and patented May 15, 1871, was a new and useful invention and improvement in carriage bows, and was of great service, benefit, and utility to the complainants, and which they distinctly recognized in their business and dealings with their customers and with this defendant and otherwise, and from the use of said last-mentioned improvement and invention of this defendant the said complainants made great gains and profits.

This defendant further alleges that, after the issuing to him of the last-mentioned letters patent, he made some slight changes and improvements in the manufacture of carriage bows, and communicated the same to said complainants, especially to said John, and requested that in the manufacture of carriage bows under his patent aforesaid that the said complainants should construct and manufacture them in accordance with his said suggestions and improvements, which improvements were communicated by this defendant to the said complainants on or about the first day of June, 1873. That thereupon his said suggestion and invention was adopted by the said complainants in the manufacture of carriage bows by the said complainants; and afterwards the said John A. Topliff for the purpose of securing the same to the complainants and to this defendant for their mutual

use and benefit, in accordance with the terms of said contract, made application for a patent thereon, and secured the alleged patent in the complainants' bill of complaint described. And this defendant alleges and says that if in reality there is anything new or useful embraced in the said letters patent, issued to the said John A. Topliff, that he was and is the true inventor and rightful owner thereof, and that the said John A. Topliff was not and is not the true and original inventor and discoverer thereof. And this defendant alleges that whether said patent, so issued in the name of said complainants, is or is not valid, that he, by the terms of his said contract entered into with said complainants, is entitled to use the same to the same extent that the complainants are entitled to use the same. That by the terms of said contract such right is expressly granted and conveyed to him, and that the complainants have so interpreted said contract, and have had upon their part the free use and benefit of the invention, discovery, and improvement made by this defendant and secured to him by letters patent dated May 16, 1871, as aforesaid, and other considerations therefor, as agreed; and that, relying upon said contract, he communicated to the said complainants the information and instructions in regard to manufacturing under his said patents and other improvements above named upon which the said John A. Topliff made the application and secured to the said complainants the letters patent said to be owned by them. And this defendant denies that he has made other use of the letters patent issued to the complainants than such as he was authorized to make by the terms of the contract aforesaid between the complainants and himself.

And the defendant further alleges that the said complainants from the date of said contract existing between him and them, have been and still are in the use and enjoyment of the letters patent owned by this defendant and above mentioned, in pursuance of said agreement. That they are still manufacturing carriage bows under and in accordance with his said letters patent; that the said carriage bows, made in accordance with the improvement and invention of this defendant, have been and are very popular with carriage-manufacturers and the public generally, and that a very large percentage of all the carriages made in the United States are furnished and supplied with bows made in accordance with the letters patent issued to this defendant as aforesaid. That the complainants have had and still have, in pursuance and in accordance with said agreement, the full use and benefit of the patents as aforesaid issued to this defendant, and from which they have derived very great gains and profit, and have acquired very great wealth.

And this defendant further says that he has established a manufactory of carriage bows at the city of Cleveland and that he is engaged in manufacturing carriage bows at said city in accordance with his several patents as aforesaid, and that he is

not and has not been engaged in manufacturing in any other place or places. That, by the terms of his contract with said complainants he is entitled to manufacture carriage bows at the city of Cleveland, and at least one other place in the United States, and that he is also entitled to use the alleged improvements so patented in the name of said John A. Topliff, if indeed such patent covered any actual improvement, and in the manufacture of carriage bows.

ISAAC N. TOPLIFF,
By S. BURKE
And W. B. SAUNDERS,
His Solicitors.

THE STATE OF OHIO,
Northern District of Ohio, ss:

Isaac N. Topliff, the above-named defendant, says that all the several matters and things set forth in the foregoing answer as of his own knowledge are true in substance and in fact, and that all the other matters therein contained he believes to be true.

ISAAC N. TOPLIFF.

Signed in my presence and sworn to by Isaac N. Topliff before me this 15th day of July, A. D. 1880.

JOHN BIGGS, *Notary Public.*

Notary seal.
Tax notary fees 40 cts.
Filed July 16th, 1880.
A. J. RICKS, *Clerk.*

CIRCUIT COURT OF THE UNITED STATES,
Northern District of Ohio.

JOHN A. TOPLIFF and GEORGE H. ELY,
Complainants,
versus IN EQUITY.
ISAAC N. TOPLIFF, Defendant.

The replication of John A. Topliff and George H. Ely, complainants, to the answer of Isaac N. Topliff, defendant:

These repliants, saving and reserving unto themselves, now, and at all times hereafter, all and all manner of benefit and advantage of exception which may be had or taken to the manifold insufficiencies of said answer, for replication thereunto, say that they will aver, maintain and prove their said bill of complaint to be true, certain and sufficient in law to be answered unto, and that the answer of the said defendant is uncertain, untrue and insufficient to be replied to by these repliants; without this, that any other matter or thing whatsoever in the said answer contained, material, or effectual in the law to be replied unto, and not herein and hereby well and sufficiently replied unto, confessed or avoided, traversed or denied, is true. All which matters and things these repliants are and will be ready to aver,

maintain, and prove, as this honorable court shall direct, and humbly pray as in and by their said bill they have already prayed.

WILLEY, SHERMAN & HOYT,
And R. P. RANNEY,
Complainants' Solicitors.

Filed Aug. 13th, 1880.
A. J. RICKS, *Clerk*.

COMPLAINANTS' TESTIMONY.

December 22d, 1882, the respective parties to the above entitled cause by their counsel, the Hon. George Willey on behalf of the complainants, and the Hon. W. W. Boynton on behalf of defendant, and John A. Topliff, witness on behalf of complainants, and thereupon the complainants offer in evidence letters patent granted to John A. Topliff and George H. Ely, dated August 24th, 1875, for improvement in carriage bows, hereto attached and filed and marked "Exhibit No. 1". Thereupon,

John A. Topliff, being by me duly sworn, deposes and says:

Q. State your age, residence and occupation, and how long and where you have been engaged in manufacturing bow sockets.

A. Age is 55; occupation is manufacturing bow sockets at Elyria, Ohio, in company with George H. Ely.

Q. How long had you been manufacturing bow sockets before the date of the above-mentioned patent?

A. About five years and a half.

Q. You may state with what success.

A. With very poor success until we commenced making according to this patent. (Objected to.)

Q. When you applied the invention covered by this patent, what results followed? We refer now particularly to the first claim.

A. We were successful. The two claims were used in connection with each other.

Q. What difficulties, if any, did the two inventions covered by this patent meet or obviate?

A. They strengthened the bow sockets, all of them, and especially the back bow, which we had the most trouble with.

Witness here produces a model of the back bow, herewith filed, marked "Exhibit No. 2", and says: I would say the method of manufacturing prior to my invention was simply a tube with a slat iron welded in at the small end; in that way they were sent to carriage-makers for them to fit their bows in, the bows intending to run clear down; we found by experience for some three and a half or four years, that the bow socket was too weak and was a perfect failure, so much so that our business was nearly ruined and that we were very much involved. We tried quite a number of ways to strengthen the back bow, but were not successful until we welded the steel into the slat iron

and filled them, the steel and wood filling shown by this exhibit.

Defendant's counsel objects to the language used in the foregoing answer, that "our business was nearly ruined and we were very much involved".

Q. State whether or not you have used these inventions in your manufacture from the time they were made to this, and with what results: first as to what useful results came to the strength of the socket; and second, with what business results.

A. We have used the improvements from the time of the invention until the present time in all that we have manufactured. The bow we found to be strong enough and the strongest back bow that we know of. Have had no failures from it. The business has increased from that time until the present, so much that it has in some years doubled from the previous year.

Objection to the answer respecting the increase of business; also to that part of the question as to what effect this improvement had on the business of the firm.

Q. State as to the usefulness, if any, of the two inventions and each of them.

A. The usefulness of welding the steel into the back bow was especially to strengthen it, from the slat iron up some twenty inches. The reason why this bow would be stronger than the others is that when the top is dropped back on what is called the top-prop, it receives the weight of the whole top besides the momentum, and all former bow sockets would bend, especially where they struck the back-prop; but this we found would stand the weight. But in order to make it still stronger, and to keep the steel from twisting or turning sidewise, we put in the wood filling which goes in each side of the steel in the bow socket, and thus keeps the steel in its place; and in the other bow sockets that have not steel in them, especially the front one, we found were too weak unless filled, and by filling that the weakness was materially overcome.

Q. Prior to your invention of this method of welding the steel slit to the slat-iron, what had there been in the way of a steel slip?

A. Nothing, as far as we were concerned. We put in no steel slip.

Q. You may state whether prior to this time you had furnished steel slips, and in what way to be used.

A. We had furnished steel slips, cut, and wrapped up six in a bundle, tucked into one of the bow socket tubes, to go with each box or three sets of bow sockets. In each box we put directions for the carriage-maker, when he fitted his bows that they should be fitted well, running clear down to the slat-iron, and when fitted, he should take a saw and split the back bow and insert the steel into the slit that he makes in the back bow, and then drive them into the bow socket with white lead or some other pasty substance.

Q. Then this slip which you furnished and to be driven into a slit made in the wooden bow, was not fastened in any way or welded to the bow socket or slat-iron?

A. It was not.

Q. Using such slips, if anywhere, where would the weakness or bending of this bow socket occur in practical use?

A. Between where the steel strip ended and the slat-iron.

Q. How serious was that difficulty or liability to bend at that point before the slips were welded according to your invention?

A. It was almost in every case, especially if the top had a hard usage or a reasonably hard usage.

Q. You may state whether or not the bows made up with the slips not welded to the slat-iron were practical or useful, or capable of success as a manufacture.

A. They were not practical, not useful, compared with the strength of an ordinary wood bow with a slat-iron covered with leather in the old style; and of course it would not be manufactured successfully if they lacked in strength, which they did.

Q. State what effect the introduction and use of this invention of welding the slips, as described in your patent, had upon the bows, and upon your manufacture as a business.

A. We have never made any without the wood filling, and therefore could not tell. I presume it makes them strong, but I have never tested them.

Q. When welded in together with the wood filling what sort of a bow is produced, both as to strength and salability?

A. It makes a very strong bow and has been very salable and successful.

Q. How long, Mr. Topliff, had you experimented in the means of strengthening the back bow before you hit upon this method of welding the slip to the slat-iron in your factory?

A. Twelve to eighteen months, I should say. I don't remember distinctly.

Q. How long prior to this had you been a practical carriage-maker?

A. About twenty years.

Q. Finally, what would you say as to the usefulness or otherwise of the intention described in and covered by this patent?

A. I say that it is a useful invention. I apply that to each of the claims.

I now file a half set of the bow sockets as manufactured by complainants, containing the improvements in said patent, marked "Exhibit No. 3". (By notary.)

Q. You may state whether you have seen sets of bow sockets manufactured by the defendant; if so, when did you first see them, and what is their description?

A. I would say that I have seen bow sockets not made in our shop, similar to ours with the steel welded in and the wood filling. That is all I can say.

Q. Did you see them before or after the commencement of this suit?

A. My impression is that I had seen them before, but I am not positive.

Cross-examination by Hon. W. W. Boynton.

Q. Are you a brother of the defendant?

A. I am.

Q. Were you, prior to 1870, at any time engaged with him in the manufacture and sale of carriages?

A. No, sir. I suppose you mean by being engaged in business with him.

Q. Yes, sir.

A. He worked for me some time. He learned his trade with me.

Q. How long was he in your employment?

A. I should say perhaps two or three years.

Q. During what years?

A. I should guess it was 1856 and 1857; it may have been later than that. I am not positive about that. He came when he was 21 and learned his trade with me.

Q. Did he work for you after that?

A. He worked for me in the winter of 1869–70 some.

Q. Where?

A. At my place.

Q. In Elyria?

A. Yes, sir.

Q. After that where was he engaged at work or in business?

A. He was engaged in business in traveling for us somewhat.

Q. How long?

A. I think he traveled for us until 1877 or 1878; I am not positive about that.

Q. Whom do you mean by "us"?

A. Topliff & Ely.

Q. What was he engaged in doing for you?

A. In the sale of the bow socket and connecting rod and wood work that we were manufacturing part of the time.

Q. I will ask you if the plaintiffs entered into a contract, somewhere near the first day of December, 1870, with the defendant, a copy of which is set out in the answer of the defendant in this action?

A. We did enter into a contract of which I presume this is a copy.

Q. You may state whether or not what purports to be a copy set out in the answer is, in fact, a copy of that contract?

A. It is.

Q. You may state when the plaintiffs commenced the manufacture of bow sockets.

A. We commenced manufacturing the bow sockets under that

contract—we were getting ready in December, 1869, but I hardly think we manufactured any until perhaps February, 1870.

Q. You manufactured under the contract set out in the answer?

A. Yes.

Q. You may state whether or not you have been engaged in the manufacture of bow sockets from that day to this.

A. We have; but not according to that contract.

Q. I do not ask you about the contract; I ask you whether you have been engaged in the manufacture of bow sockets from that day to this.

A. We have been manufacturing; yes, sir.

Q. Continuously?

A. Yes, sir.

Q. At what place?

A. Elyria, Ohio.

Q. Up to what time did you pay the defendant royalty in pursuance of the terms of the contract set out in the answer.

A. My impression is that 1879 was the last royalty we paid him.

Q. What time in 1879?

A. That I would not be able to tell. Mr. Ely tends to that business and he could tell.

Q. In what year did you commence to pay royalty?

A. It is my impression we commenced in 1870.

Q. State whether you had any other contract with him concerning the payment of royalty than the one set out in the answer.

A. We had not.

Q. You commenced in 1870, you say. For how many years did you continue?

A. It would be eight or nine years.

Q. State whether or not you paid him royalty annually.

A. I think we paid him quarterly.

Q. Quarter-yearly?

A. Yes, sir.

Q. During those years?

A. Yes, sir.

Q. You may state whether you continued to manufacture and sell sockets under the patent of your brother until your patent was obtained in 1875.

A. We did; yes, sir.

Q. Your patent, as I understand you, was for an improvement in bow sockets?

A. Yes, sir.

Q. And for an improvement in the particulars set out in the specification upon which your patent was issued?

A. Yes, sir.

Q. After your patent was issued you went into the manufac-

ture of the improved article?

A. Yes, sir.

Q. Continued in the manufacture from that down to the present time?

A. We did.

Q. And are still engaged in it?

A. Yes, sir.

Q. Is your brother a mechanic?

A. He is; yes, sir.

Q. A carriage maker?

A. He has carried on carriage making: yes, sir.

Q. He is now engaged in the business of—what?

A. Well, bow sockets, I suppose; that I am not positive about.

Q. You may state whether the respects in which you claim your invention to be an improvement upon your brother's consists in placing a filling of wood in the tubes of the bow sockets to strengthen the same, and also in extending the strip of steel which is inserted in the wood filling far enough down to enable it to be welded or otherwise fastened to the slat iron?

A. That is the improvement; yes, sir.

Q. Do you claim any other or further improvement?

A. The wood filling and the welding of the steel into the slat-iron.

Q. Or otherwise fastening it?

A. Yes, or otherwise fastening it.

Q. That is the extent of the improvement you claim upon your brother's bow socket?

A. That is my patent, not the improvement on his.

Q. That is the extent of your improvement.

A. That is the extent of my patent.

Q. You used the words "improvement in carriage bows" in the terms of your application for a patent?

A. Yes.

Q. I would enquire of you whether or not in making an application for an improvement in carriage bows you did not make an application for an improvement of those that you were then engaged in manufacturing?

A. Yes, sir; those that we were then manufacturing.

Q. What would you say as to the utility or the beneficial use of the bow sockets manufactured under the patent of your brother, if there were no other bow sockets in existence than that one?

A. I don't know as I understand your question.

Q. I will repeat it in another form. Do you say that the bow socket manufactured under your brother's patent could not be applied to any useful or beneficial purpose if there were no better bow sockets than that? In other words, in determining its utility and usefulness, do you do it by comparison with other bow sockets?

A. I do it by comparison with other bows.

Q. And if there were no other bows but that, would you say that that was beneficial and useful or not?

A. I should say that it was not beneficial and useful because it is not strong enough.

Q. I am now speaking of the bow upon the supposition that no others existed but that. Would you then say that it could be made to subserve a beneficial purpose or be useful?

A. Not unless you were rich enough to keep your tops repaired.

Q. Can you tell how many sets of carriage bows you sold prior to 1875?

A. No, sir; I cannot. I know but very little about that.

Q. Can you tell about how many?

A. How many sets a year or altogether?

Q. A year.

A. O, I should say we sold five thousand sets a year. It might be more than that and it might be less; I could not say.

Q. About how much a set did you sell them for during these years?

A. That I don't remember distinctly about. The price was changed somewhat. At one time I think we sold them at $3.50, and I think within that time they were down to somewhere about $3.00 perhaps; I don't remember distinctly about it.

Q. What was your brother engaged in for you between the years 1875 and 1879?

A. What time he was engaged for us he was traveling for us.

Q. For what purpose was he traveling?

A. Selling the bow sockets and other goods that we manufactured.

Q. He was your traveling agent?

A. Yes, sir.

Q. For that purpose?

A. Yes, sir.

Re-direct examination by Mr. Willey.

Q. You took that license from him at what time?

A. It was December, 1869, I think it was made out.

Q. It was about a year before it was dated?

A. It was about a year before it was dated and before the patent was granted.

Q. Show the patent referred to in that contract.

A. (Witness produces the patent of December 27, 1870, to Isaac N. Topliff). I do so and file and attach a copy of the patent marked "Exhibit 4."

Q. That patent is for what?

(Question objected to.)

A. It is a combination patent. The terms are these: a bow socket and a bow iron; the bow iron is made tubular and flat-

tened at the end in connection with a wood bow running from one side to the other. That is the patent.

Q. The patent shows for itself, I suppose.

A. Yes, sir.

Q. I will ask you the question whether the improvements referred to in that contract were improvements which either party might make on the combination as patented by him?

(Question objected to.)

A. Let me understand the question.

Q. You stipulate there for the use of improvements. I enquire of you whether they were improvements which either of you might make on his combination?

(Question objected to.)

A. Why, the contract says that either party could make improvements on the article.

Q. On what article?

A. On the article that he had patented.

Q. Which was the combination?

(Question objected to as leading.)

A. Yes, sir.

Q. How long did you manufacture under that first patent?

A. Never manufactured a set.

Q. Did you ever combine the tubes with the plates?

A. We did; yes, sir.

Q. For how long a time?

A. Till May, I should guess, of 1870.

Q. Did you ever combine the tubes with the bow?

A. We never did—not as a company; I have done it individually in my own business.

Q. But after this contract was made?

A. I say as a company we never did.

Q. When did you say you stopped combining the tubes with the plates described in that patent?

A. In May, I think, but it may have been June, May or June, I should say, of 1870.

Q. Why did you discontinue it?

(Question objected to.)

A. We discontinued it for the reason that they were good for nothing. They were sent back so that we never had to make only a thousand sets, and they will last us a thousand years.

Q. You may say whether the sets that you thus made, by combining the tubes with the plates, were useful or valueless.

A. They were perfectly valueless and were finally thrown into the river, lots of them—most of them, I might say.

Q. Was your brother with you at that time?

A. He was traveling for us a part of the time and part of the time he was working for me, especially, in my trimming department.

Q. You may state whether or not that was abandoned with his approbation.

A. It was abandoned with his approbation, as far as I know, as he was there and knew of their coming back—of their failures.

Q. And what did you substitute for these plates described in that patent?

A. We commenced substituting what you might call a malleable slat-iron—a little slat-iron that was cast and made malleable and slipped up in here (indicating) and soldered to this tube.

Q. I will ask you whether those slat-irons that you then combined these with were things in common use at that time.

A. You refer now to the first patent?

Q. No, I am referring to the slat-irons which you say you substituted for those plates.

A. O, they were in common use. That is, not the special shape, but the slat-iron was in common use.

Q. A slat iron substantially like that?

A. Yes, sir.

Q. From that time on have you ever used the combination contained in his original patent?

A. We never have; no, sir.

Q. But you have continuously continued to use and have always used in your manufacture since, what kind of slat-iron?

A. We have always used since, the slat-iron in connection with the tube.

Q. What sort of slat-iron?

A. At first the malleable iron slat-iron, and since then a wrought iron slat-iron.

Q. Wrought iron after the fashion that is shown in the exhibit that you have introduced showing your work?

A. Fashioned after the same style; yes, sir.

Q. How long had that kind of slat-iron been in common use?

A. The slat-iron had been in common use ever since I was a carriage-maker, but with a different shape—the top part of it.

Q. But substantially the same?

A. Substantially the same; yes, sir.

Q. Had been used for how long? twenty years?

A. Yes, more than that.

Q. Have you ever used these improvements that you made and patented on any combination such as is described in his patent of 1870?

A. No, sir.

Q. You may state whether a set of tubes made up and supplied with the improvement described in your patent and applied to such a combination as he describes in his patent of 1870 would make useful tubes?

(Question objected to as leading.)

A. It could not be applied.

Q. A question was put to you in relation to your paying royalties. You may state about that. You have paid royalties, as I

understand you, from about the time the contract was made down to what year?

A. 1879, I think.

Q. Under what circumstances did you continue to pay royalties?

A. We paid royalty from the fact that we supposed that we were working under his original patent; we did not know to the contrary. The original patent was somewhere, perhaps, in our office, and was burned up in 1873, I think—I think that was the time of the fire—and we had not seen it for a long time and supposed that we were working under the original patent until we finally received the file wrappers from Washington, informing us to the contrary, and when we received them, together with the patent, we found out that we were not working under his patent and refused to pay further royalty.

(That part of the foregoing answer of the witness relating to information received from Washington, objected to by defendant's counsel.)

Q. You may state whether you sued to recover back what you had paid?

A. We did; yes, sir.

Q. Then you may state whether these royalties which you paid were, in fact, paid under your contract.

(Question objected to.)

A. They were, in fact, paid under our contract.

Q. In what way were they paid under your contract if your contract did not require you to pay them?

(Question objected to as leading and argumentative.)

A. They were paid under the contract from the fact that we supposed that we were working under the original patent.

Q. Then you say, or do you not, that these royalties were paid under a mistake, you supposing that you were paying under the contract, when, in point of fact, the contract did not require you to pay them?

Question objected to as leading and suggestive.

A. We paid, of course, from the fact that we did not know but what we were working under the original patent. That is, it was a mistake in paying it.

Q. Then as soon as you discovered the mistake you ceased paying?

(Question objected to.)

A. We did; yes.

(Answer objected to.)

Q. You may state whether or not the improvements which you made and patented were improvements on the combination described in his original patent?

A. They were not.

Re-cross-examination.

Q. Do you mean to say that they were not improvements, in act, of the article manufactured under his patent?

A. Under his original patent they were not, sir.

Q. Was your patent an improvement of his reissued patent?

A. I don't really know what his reissued patent is. I don't know anything about it.

Q. Do you mean to say that the articles you manufactured under your improvement were not, in fact, improved articles of the kind that you manufactured under your brother's patent?

A. They were not improved articles of that.

Q. Not any better, you mean?

A. No, I don't mean that. I mean that they were distinct, as one slat-iron is perfectly distinct from another slat-iron.

Q. You mean that there were certain particulars in which the article manufactured differed from your brother's?

A. Well, they differed so much that this improvement could not be applied to it.

Q. They were both carriage bows, were they not, that were manufactured?

A. Well, yes, sir, they were both for carriage bows, but they have twenty different patents on slat-irons—just on different slat-irons.

Q. When you say that yours was not an improvement upon his patent you mean to say that the article that you manufactured was not an improvement upon the article that was manufactured under his patent?

A. I mean to say that it was better, but not specially an improvement of that, but it was a better article.

Q. A better article of carriage bows than his?

A. Yes, but not an improvement on his.

Q. You mean that it was not an improvement on his technically speaking?

A. Yes, sir.

Q. You say that you sued to recover back your royalty?

A. Yes, sir.

Q. You did not succeed in obtaining a recovery, did you?

A. We did not.

Re-direct examination.

Q. Slat-irons, you say, are old?

A. Yes, sir.

Q. And there are a great many different sorts?

A. A great many different sorts of patents of slat-irons.

Q. You may state whether or not the plates such as were described in his patent of 1870 were substantially like or substantially different from slat-irons that were in common use and as you used them?

A. There was one kind of slat-iron that was what was called the Bidwell patent. Mr. Bidwell, of New Haven, Conn., had a patent on that slat-iron, and he or the man that owned the patent finally sued us for using it, and we settled on account of that. He sued us in court and we settled for it.

Q. My inquiry was whether it was substantially different from ordinary slat-irons and from the slat-iron that you used.

A. It was the same as the slat-iron in his original patent, but it was different from what we use now, altogether.

Q. Substantially different.

(Question objected to.)

A. Substantially different; yes, sir.

Q. Do you say that it was substantially different, or substantially like?

A. It was very different.

Q. And slat-irons of all sorts had been in common use for more than 20 years?

A. Yes, sir.

Q. Is the slat-iron which you substituted for the plates of his which you first attempted to use, substantially like or unlike slat-irons which had been in use before?

(Question objected to.)

A. They were like slat-irons that had been used before, in part.

Q. Only with a variation in form?

A. Yes, sir.

Q. You say that the plates that he described in his patent as a part of his combination you tried and found to be useless?

A. We did, yes, sir.

(Signed), JOHN A. TOPLIFF.

Complainants here put in evidence and file marked "Exhibit 5," a certified copy of the file wrapper and contents from the Patent Office relating to the patent of I. N. Topliff, of December 27, 1870.

It is agreed by I. N. Topliff that he was at commencement of this action manufacturing the article or bow socket attached to this deposition and marked "Exhibit 6."

CHARLES BALFOUR,
Special Examiner.

Complainants' Exhibit No. 1.

UNITED STATES PATENT OFFICE.

John A. Topliff, of Elyria, Ohio, Assignor of one-half his right to George H. Ely of the same place. Improvement in Carriage Bows. Specification forming part of Letters Patent No. 166,950, dated August 24, 1875; application filed November 16, 1874.

To all whom it may concern:

Be it known that I, John A. Topliff, of Elyria, county of Lorain, and State of Ohio, have invented a new and useful improvement in bow sockets for buggy-tops; and I do hereby declare that the following is a full, clear and exact description of

J. A. TOPLIFF.

Carriage-Bows.

No. 166,950. Patented Aug. 24, 1875

Fig 1.

Fig 2.

Fig 3.

Fig 4.

Witnesses:

Norman Ely

Fred A. Smith

Invintor

J. A. Topliff

the same, reference being had to the accompanying drawings, forming a part of this specification, in which—

Figure 1 is a part sectional view of the bow-socket embodying my invention; Fig. 2, a detached view of the strip of steel; Fig. 3, a detached view of the wood filling; and Fig. 4 a side sectional view of my invention.

This invention has relation to bow-sockets for buggy-tops; and consists in placing a filling of wood in the tubes of the bow-sockets to strengthen the same; also, in extending the strip of steel which is inserted in the wood filling far enough down to enable it to be welded or otherwise fastened to the slat-iron.

Previous to my invention the method employed for strengthening the bows was to slit the wooden bow, placing therein a tapering piece of sheet-steel. The great difficulty in the bows constructed as above described was the continued bending or breaking of the back tubes where the steel strip ends near the slat-iron. To prevent this, in making the bow-sockets there is inserted in the back tube A a tapering strip of steel or other suitable metal, *a*, the same extending far enough down to enable it to be welded into or otherwise fastened to the slat-iron, *b*, the strip of steel, *a*, being in reality a continuation of the slat-iron within the tube A, thus leaving no weak place to bend. I have also found that all the tubes of a bow-socket are much stronger when they are well-filled with wood, and as it is difficult to properly fill them with the bows used on the buggy-top, I make small pieces of wood, *c*, the shape of the inside of the tube, as illustrated in Fig. 3 of the drawings, and large enough to drive in tightly, and when driven in to reach from the slat-iron, *b*, to within a short distance of the top of the tube, or far enough from the top to allow the buggy-bows to enter sufficiently to hold them. It is necessary that the wood filling for the back tubes be split far enough from the small end to receive the steel strip *a*. The wood filling *c* is formed with the usual groove *d* for the bead or lock upon the inside of the tube. The wood fillings can be made by machinery to fit the tubes much better than the wood bows can be fitted by hand, and very much cheaper, and, as they fit better, will make them stronger.

Having now fully described my invention, what I claim as new and desire to secure by letters patent, is—

1. In combination with the back tubes of bow-sockets and wood bows or fillings, a steel or other hard-metal plate, welded or otherwise fastened within the tube to the slat-iron, substantially as and for the purpose specified.

2. The combination, with the metal tubes of bow-sockets, of a wooden filling, substantially as and for the purpose set forth.

JOHN A. TOPLIFF.

Witnesses:
HERMAN ELY,
FRED. N. SMITH.

Complainant's Exhibit No. 4.

UNITED STATES PATENT OFFICE.

Isaac N. Topliff, of Adrian, Michigan. Letters Patent No. 110,513, dated December 27, 1870. Improvement in carriage bows. The schedule referred to in these letters patent and making part of tne same.

I, Isaac N. Topliff, of Adrian, in the county of Lenawee and State of Michigan, have invented certain improvements in carriage-bows, of which the following is a specification.

The nature of my invention consists in constructing the straight part of carriage bows out of tapering tubes made of sheet-iron with soldered seams, and lower ends flattened, to form, in part, the hinge, in conjunction with the bows, made of wood, shaped and fitted into the upper ends of the tubes.

Also in the bow-socket, made of two sheet-iron concave disks or plates, placed with concave faces together, so that the tube A may extend downward between them, to receive the swivel-bolt *m*, to make it firm to the socket.

In the annexed drawing—

Figure 1 is a side elevation of the several bows of a carriage-top, embodying my invention.

Figure 2 is a plane section of one of the bows A' and bow-socket D, cutting the line *x y*.

A' is one of the several similar tapering tubes of sheet-iron, forming the straight part of the bow for carriage-tops, and flattened at the lower end to enter the bow-socket D.

This tube is to be manufactured of sheet-iron or of any other suitable sheet-metal, with soldered seam, and into its upper end the wooden part B' of the bow is inserted, the wooden part being the same, as far as it goes, as that now in use.

The bow-socket D is also made of sheet metal, and it consists of two concave pieces with their edges soldered together, their concave sides facing each other, and having scalloped upper edges, into which the tubes A A', &c., are inserted and secured by the pivots 1, 2, 3, 4.

The second bow A extends its flattened portion C downward to and receives the joint-bolt *m*, so as to prevent radial movement of the bow around the pin 3.

When the top of the carriage is thrown back the bow-socket D, turns upon the joint-bolt *m* only to the extent of the sweep of the solid-jointed bow A,

What I claim as my invention is—

The straight part of the bow A, tubular and flattened at the lower end, the bow-socket D, consisting of two concave scalloped pieces, and the bent part of the bow B', all combined, constructed, and arranged as and for the purposes set forth.

ISAAC N. TOPLIFF.

Witnesses:
WM. A BLANDEN.
M. E. STEWART.

I. N. TOPLIFF.

Carriage Bow.

No. 110,513. Patented Dec. 27, 1870.

Fig. 1

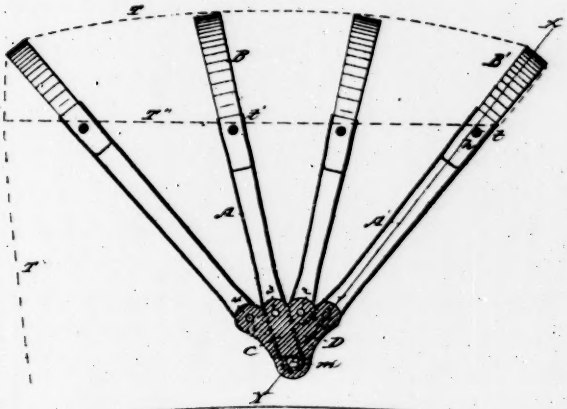
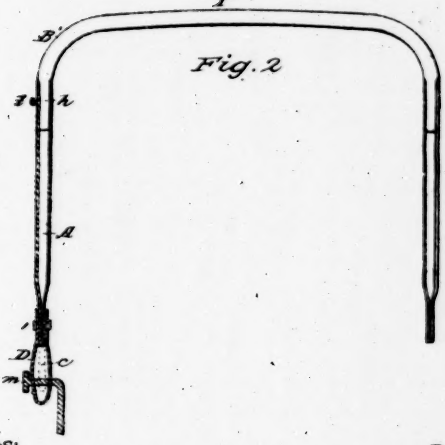


Fig. 2



Witnesses:

E. Richards

W. H. Cornell

Inventor:

Isaac N. Topliff

Complainants' Exhibit No. 5.

Isaac N. Topliff patent, December 27, 1870. With file wrapper and contents.

United States Patent Office to all persons to whom these presents shall come, greeting.

This is to certify that the annexed is a true copy from the digest of this office of all assignments, agreements, licenses, powers of attorney, and other instruments of writing found of record up to and including October 16, 1879, under or relating to letters patent granted to Isaac N. Topliff, December 27, 1870, No. 110-513, "carriage-bows."

In testimony whereof, I, W. H. Doolittle, acting commissioner of patents, have caused the seal of the patent office to be hereunto affixed this eighteenth day of October, in the year of our Lord one thousand eight hundred and seventy-nine, and of the Independence of the United States the one hundred and fourth.

[L. S.] W. H. DOOLITTLE,
Acting Commissioner.

Application to the Commissioner of Patents of the United States of America.

The petition of Isaac N. Topliff, of Adrian, in the County of Lenawee, and State of Michigan, respectfully represents:

That your petitioner has invented a new and useful improvement in carriage-bows, which he verily believes has not been known or used prior to the invention thereof by your petitioner. He therefore prays that letters patent of the United States of America may be granted to him therefor, vesting in him and his legal representatives the exclusive right to the same upon the terms and conditions expressed in the act of Congress in that case made and provided, he having paid fifteen dollars into the treasury of the United States, and otherwise complied with the requirements of said act.

ISAAC N. TOPLIFF.

Affirmation.

STATE OF MICHIGAN,
County of Lenawee, s s:

On this second day of November, 1869, before the subscriber, a notary public in and for said county, personally appeared the above named Isaac N. Topliff and made solemn affirmation that he verily believes himself to be the original and first inventor of the within described improvement in carriage-bows, and that he does not know or believe that the same was ever before known or used; and that he is a citizen of the United States.

[L. S.] WILLARD STEARNS,
Notary public in and for Lenawee county, Michigan.

I, Isaac N. Topliff, of Adrian, in the county of Lenawee, and State of Michigan, have invented certain improvements in carriage-bows, of which the following is a specification:

The nature of my invention consists in constructing the straight part of carriage bows out of tapering tubes, made of sheet iron, with soldered seams, and lower ends flattened to form, in part, the hinge, in connection with the bows made of wood shaped and fitted into the upper ends of the tubes.

Also in the bow-socket, made of two sheet-iron concave disks, or plates, placed with concave faces together so that the tube A A may extend downward between them to receive the swivel-bolt *m* to make it firm to the socket.

In the annexed drawings—

Figure 1 is a side elevation of several bows of a carriage-top, embodying my invention.

Figure 2 is a plane section of one of the bows A', and bow-socket D, cutting the line X Y.

A' is one of the several similar tapering tubes of sheet-iron forming the straight part of the bow for carriage-tops, and flattened at the lower end to enter the bow-socket D. This tube is to be manufactured of sheet-iron or of any other suitable sheet metal, with soldered seam, and into its upper end the wooden part B' of the bow is inserted, the wooden part being the same, as far as it goes, as that now in use. The bow-socket D is also made of sheet metal, and it consists of two concave pieces with their edges soldered together, their concave sides facing each other, and having scalloped upper edges into which the tubes A A', etc., are inserted and secured by the pivots 1, 2, 3, 4.

The second bow A extends its flattened portion *c* downward to and receives the joint-bolt *m*, so as to prevent radial movement of the bow around the pin 3.

When the top of the carriage is thrown back the bow-socket D turns upon the joint-bolt *m* only to the extent of the sweep of the solid jointed bow A.

What I claim as my invention is—

Erase and substitute "D."
Filed December 9, 1869.

1st. The upright part of carriage-bows constructed of tubular sheet metal A, in construction with the wooden bow B', put together in the manner and for the purposes set forth and described.

Filed July 27, 1870.

2d. The tube A with elongated flat portion *c* to form a solid joint with the bow-socket D in the manner described.

Filed August 9, 1870.

Filed October 5, 1870.

3d. The scallop-edged sheet-iron bow-socket D to be used in connection with the tubes A and A' in the manner described.

ISAAC N. TOPLIFF.

Witnesses:
WM. A. BLANDEN,
M. E. STEWART.

ADRIAN, MICH, Nov. 9, 1869.

To Commissioner of Patents:—Enclosed please find money order for fifteen dollars, the payment on application for patent on carriage bow improvement. Yours truly,

ISAAC N. TOPLIFF.

U. S. PATENT OFFICE,
WASHINGTON, D. C., Nov. 23, 1869.

Isaac N. Topliff, Adrian, Michigan: Sir—Please find below the communication of the examiner in charge in the matter of your application for patent for carriage-bow, filed Nov. 10, 1869.

Very respectfully,

COMMISSIONER.

EXAMINER'S ROOM, No. 150.

The application above referred to has been examined, and it is rejected for want of novelty. The 1st claim is anticipated by the patent of A. C. Shelton & Byron Tuttle, dated December 29, 1857, "joints for calash carriage-tops," which shows a metal socket for the reception of the bows; and the forfeited case of Ferdinand Selle, filed September 7, 1867, exhibits a carriage-bow covered with tin or sheet metal from the slat-iron to the bend in the bow. The 2d and 3d claims are anticipated by the patents of G. W. Slater, dated April 9, 1867, No. 63,660, and Lewis Righter, dated January 12, 1869, both of which exhibit a tube with a flat portion forming a solid joint with the bow-socket—the latter formed in two pieces of iron. The substitution of sheet metal is not patentable. The application is necessarily rejected.

A. SCHOEPF,
Examiner.

ADRIAN, MICH, December 4, 1869.

To the Commissioner of Patents: Dear sir—I have to acknowledge the receipt of your letter of rejection in the case of my application for a patent on an improvement in carriage-bows, and have carefully examined the cases cited, in view of which I have thought best to amend my claims, and have accordingly done so, and I send herewith the amendments.

In the first case mentioned, No. 18,992, A. C. Shelton and Byron Tuttle, "improvement in joints for carriage-tops," the patentees do not claim a tubular bow, or even a socket, but an improvement on the slat-irons when pivoted onto the seat iron, not where my improvement is claimed.

The second case, the forfeited one of Ferdinand Selle, filed September 7, 1867, which shows a carriage-bow covered with tin or sheet metal, from the slat-iron to the bend in the bow.

The covering of bows with sheet metal I did not suppose patentable, as bows have been covered with leather and cloth for years, and substituting iron or tin would have no novelty except in material used. My improvement varies materially from that. I construct my bow of a tube, from the pivot-iron

on the seat to the bend in the bow, having no wood, except 3 or 4 inches, just enough to fasten them together, and no slat-irons, thereby making the bows lighter and stronger, as well as cheaper.

I have been in the carriage business for about twenty years, and have used all the different kinds of irons cited, and I know my irons are nothing like them in principle or construction.

ISAAC N. TOPLIFF.

ADRIAN, MICH, Dec. 4, 1869.

To the Commissioner of Patents:—In the matter of my application for letters patent for an improvement for carriage-bows, I hereby amend my claim by striking out all three claims, and inserting the following two in their place:

1st. The carriage-bow consisting of a slightly flattened conical tube, having the wood portion connected at or near the lower bend in the bow, in the manner described.

"A" Substitute, December 9, 1869.

2d. The scalloped-edged sheet-iron plates D, when soldered together in the manner described, for the reception of the tubular bow ends.

ISAAC N. TOPLIFF.

ELYRIA, O., January 4, 1870.

To Commissioner of Patents: Dear sir—You will please direct any communication you may have in regard to my application for a patent on carriage-bows to this place, instead of Adrian, Michigan. I have not heard from the application since amended.

Yours truly,

ISAAC N. TOPLIFF.

U. S. PATENT OFFICE,
WASHINGTON, D. C., Jan. 31, 1870,

Isaac N. Topliff, Elyria, Ohio: Please find below a communication from the examiner in charge in the matter of your application for a patent for carriage-bow, filed November 10, 1869.

Very respectfully,

ELISHA FOOTE,
Commissioner.

EXAMINER'S ROOM, No. 150.

In the matter above referred to it has been re-examined, in view of the amended claim filed by applicant, and the 1st claim is finally rejected upon the reference formerly cited, and especially upon the forfeited case of F. Selle, cited in the official letter of Nov 23, 1869. The mere cutting off of the bow and using the covering shown in Selle's forfeited case cannot be considered as a patentable feature. The 2d claim is still regarded as in conflict with the references formerly cited, the mere uniting the parts together by solder is a matter of choice and not invention.

The devices of the 1st and 2d claims if combined into one claim, might be allowed.

A. SCHOEPF,
Examiner.

ELYRIA, O., July 21, 1870.

Commissioner of Patents: Dear sir—I made application for a patent some time last November on the construction of carriage-bows, by means of tubes formed of sheet-metal. It was rejected once, and then amended and partly rejected again. I was on to Washington in February and saw the examiner and again amended it to meet his objection, since which I have not heard from it. Please inform me what has been done with it.

Yours truly,

I. N. TOPLIFF.

To the Commissioner of Patents: In the matter of my—— ——— for letters patent for an improvement in carriage-bows, I hereby amend my claim by striking out all three claims and inserting the following.

"B" Substitute, July 27, 1870.

The carriage-bow consists of slightly flattened conical tubes, extending from or near the pivot on the seat to near the bend in the bow, and connected to the wood portion as described.

ISAAC N. TOPLIFF.

U. S. PATENT OFFICE,
WASHINGTON, D. C., July 27. 1870.

I. N. Topliff, Elyria, Ohio: Please find below a communication from the examiner relative to application for patent for carriage-bow, filed November 10, 1869.

Very respectfully,

COMMISSIONER.

EXAMINER'S ROOM, No. 150.

The amended claim is rejected upon former references. It was suggested in a former letter that a combination claim might be allowed, and such a claim may yet be considered.

A. SCHOEPF.

T. C. WOODWARD, S. A. EX.

ELYRIA, O., August 5, 1870.

To Commissioner of Patents. Dear sir—I have amended the claim to my application for a patent on carriage bows the best I could to meet your suggestion. I have left a blank space after plates, in which please insert the proper letters, as I have not got a copy of the original here, and don't know what they

Yours,

I. N. TOPLIFF.

To Commissioner of Patents: I hereby amend the claim to my application for a patent on "carriage bows" by inserting the following in the place of all former claims:

I claim the combination of the metallic bow cover and slat iron pivoted to the plates ———, as shown and described.

"C" Substitute, August 9, 1870.

ISAAC N. TOPLIFF.

ELYRIA, O., August 5, 1870.

U. S. PATENT OFFICE,
WASHINGTON, D. C., August 25, 1870.

Isaac N. Topliff, Elyria, Ohio: Please find below a communication from the examiner, relative to application for patent for carriage bow, filed November 10, 1870.

Very respectfully,
COMMISSIONER.

EXAMINER'S ROOM, No. 150.

The applicant is hereby advised to write to the office, requesting that the amended claim be cancelled and the following claim inserted:

CLAIM—The straight part of the bow *A:* tubular and flattened at the lower end; the bow socket *D,* consisting of two concave scalloped pieces, and the bent part of the bow B', all combined, constructed and arranged as and for the purposes set forth.

A. SCHOEPF,
T. C. WOODWARD, S. A. EX. Examiner.

Commissioner of patents: I hereby amend the claim to my application for a patent on "carriage bows" by cancelling the amended claim and inserting the following:

"D" Substitute, October 5, 1870.

CLAIM—The straight part of the bow *A*, tubular and flattened at the lower end; the bow socket *D,* consisting of two concave scalloped pieces, and the bent part of the bow *B'*, all combined, constructed and arranged as and for the purposes set forth.

ISAAC N. TOPLFF.

ELYRIA, O., October 1, 1870.

ELYRIA, O., December 12, 1870.

Commissioner of patents, Washington, D. C.: Dear sir—Inclosed I send you J. W. Hulbert, cashier's draft No. 15,564, on National Park Bank, New York, for twenty dollars, balance of fee due for my patent on carriage bows. Please issue patent and send to me here. Yours, very respectfully,

I. N. TOPLIFF.

107–56 1869. Schoepf.
No. 110,513. W

Isaac N. Topliff, of Adrian, County of Lenawee, State of Michigan.

CARRIAGE BOW.

Received November 10, 1869.
Petition " " "
Affidavit " " "
Specification " " "
Drawing " " "
Model " " ".

Cert. dep.
Cash $15, November 12, 1869.
Additional fee cert.
Additional fee cash $20, December 15, 1870.
Examined October 6, 1870, A. Schoepf.
Issue Grinnell October 7, 1870.
Patented December 27, 1870.
Recorded, vol. ——, page ——.
Circular October 7, 1870.
Rejected November 23, 1869.
Letter January 31, 1870.
Rejected July 27, 1870.
Letter August 25, 1870.
[For drawings, etc., belonging to exhibit No. 1, see accompanying file.]

DEFENDANT'S TESTIMONY.

Isaac N. Topliff, of lawful age, being first duly sworn, deposes and says as follows:

Q. (By Judge Hale) Have you the letters patent dated May 16th, 1871?

A. Yes, sir.

Defendant offers in evidence letters patent dated May 16th, 1871.

Q. You may state your name, age and place of residence.

A. Isaac N. Topliff, 50 years old, Cleveland, Ohio.

Q. What is your occupation?

A. Manufacturer.

Q. What relation are you to John A. Topliff, one of the plaintiffs?

A. Brother.

Q. At the time the letters patent attached to the testimony of the plaintiffs were issued to you, bearing date December 27th, 1870, where were you residing?

A. At Elyria.

Q. How long did you continue to reside at Elyria?

A. About 10 years.

Q. After the making of the contract, a copy of which is in your answer, what was done in the way of manufacturing bow sockets?

A. Topliff & Ely commenced manufacturing very soon the bow socket, and I went onto the road selling them, perhaps in January following.

Q. For whom?

A. For Topliff & Ely.

Q. How long did you continue in their employment?

A. Off and on for 7 or 8 years.

Q. In what capacity?

A. Traveling salesman; most of the time as agent.

Q. For what?

A. For the purpose of selling their goods.

Q. And those goods were?

A. Those goods were in the main the tubular bow socket. They manufactured some other things.

Q. How long, if at all, did they continue the manufacture of the goods under the first patent?

A. I think some 6 months.

Q. What changes, if any, were then made?

A. Then I got out another patent—made an improvement locking the tubes together. First we soldered them; the original patent was soldering the tubes, and the next was locking. That was one claim of the patent, and a strip of steel running up the back bow to stiffen them. Also welding the slat iron, or the little forged piece at the end of the socket, into the tube. That was the third claim of the patent, I think.

Q. Will you explain fully the changes made from the first article manufactured to the improved article?

A. The first article manufactured was simply a tube for the upright part with the ends brought together with a piece of steel or iron to strengthen the end, and that all went between a couple of plates at the lower end; the bow part was inserted in and extended down the back bow nearly the whole distance. In the others it was not necessary, we thought. The bow part we never sent out with the articles; it was simply the tubes and what was called the socket. Carriage manufacturers were expected to use the bows that were then in use.

Q. And who would furnish the bows?

A. The bows were furnished by carriage makers. Then the next change was we commenced locking the tubes together and welding the slat iron into the ends of the tubes, and putting in the strip of steel to stiffen the back bow.

Q. When was that done?

A. That was done during the year 1870; sometime in July or August, I should think, 1870.

Q. How long did Topliff & Ely continue to manufacture the articles as thus improved?

A. About 3 years with no great change.

Q. What change was then made?

A. Simply the welding of the steel to the slat iron and inserting a filling into all bows. We inserted a filling into the bows up to within 8 or 10 inches of the top of the bow socket.

Q. How early did you commence that filling?

A. That filling was commenced generally, on almost all that were sent out, sometime in 1873; I cannot say exactly, but it was in the neighborhood of July or August, 1873.

Q. State more definitely just what that filling consisted of.

A. It was simply wood—ash, or any softish wood turned to the size and shape of the inside of the tube, and driven in solid.

We had done that filling before, as early as during the year 1870; had filled a number of sets—a number of pieces.

Q. Where?

A. In Elyria, as early as July or August, 1870.

Q. At whose shop?

A. At my brother's shop.

Q. What knowledge had your brother of that fact?

A. He knew that it was done. I filled one or two sockets that went onto a carriage for Dr. Sampsell, that I remember distinctly at that time.

Q. Who made the carriage?

A. It was made by Mr. J. A. Topliff, my brother.

Q. After 1873 what improvements were made in the article, if any?

A. There was no further improvement that I know of, only they were better made. There was no radical change in the socket.

Q. How soon did Topliff & Ely commence the manufacture of the bow socket in substantially its present form?

A. In July or August, 1873, substantially the same as to-day. They made quite a good many after that and sent them out without filling. They had some customers that preferred to fill them themselves. But the majority of them were sent out filled.

Q. You may state how those improvements were brought about and what discussions you had concerning them with your brother. State fully the history of the transactions from the beginning down to the last improvement made.

A. All of the improvements were made in consultation with Mr. Topliff, my brother, and Mr. Ely. As we saw that they needed improvement we improved on them. The improvement of filling was put in because we saw that carriage-makers did not fill them as fully as they should. In shaving the bow they would not fill, and so by having the pieces turned they were better filled and driven in by ourselves. The first idea of the filling was my own as early as June or July in 1870, about the same time that we inserted this strip of steel in the back bow as a stiffener. That was my suggestion also. The locking of the tube was at my suggestion as early as January 1870, and soon after they began to get up the machines to lock them.

Q. Those were all the improvements down to 1873?

A. Those were all the improvements and they were patented in my name. There never was any dispute but what I was the inventor of the patented devices.

Q. What change, if any was made in 1873?

A. There was no change in 1873, with the exception of welding the steel to the end of the slat-iron, as we call it, and putting the filling into all that we sold. We had put in filling before that but it was mainly done on repair jobs. When a man would

break a bow, to repair it we would cut off the broken bow and fill one of the tubes.

Q. Whose device was this welding?

A. The welding of the steel to the slat-iron, I supposed, was my brother's device. I understand that it has been claimed, though, by others—that others did it previously to that.

Q. How did it come about that the firm of Topliff & Ely and yourself adopted that device?

A. It was talked up that those steels that we sent out with the sockets to be put into the bows we often found were not put in, and my brother suggested that we weld them right to the slat-iron and put them in ourselves, and in that way the carriage-makers would be compelled to use them if they used the sockets.

Q. Was that a subject matter of conversation between you and your brother?

A. Yes, it was talked up a number of times before it was adopted.

Q. Was there any conversation between you and your brother as to procuring a patent for that device?

A. Yes; some time in 1874 or 1875, I think it was, I came home, and my brother said that they had concluded to patent that device of welding the steel to the slat-iron, and he said that he thought that they had better take out a patent or make one claim for the filling also. I told him that the filling, of course was my improvement, and I did not know that it would be right to insert it into his patent. He said it would make no difference, as our contract would cover it all. He said that it would make no difference which took out the patent, whether it was in his name or my name, and I made no further objection to it; but I always claimed, and he never disputed it that time, that the device was mine as far as the filling was concerned. I had used it from as early as July or August, I am not certain which, in 1870.

Q. At what time did you commence the manufacture of the bow-sockets on your own account?

A. I commenced along in the fall of 1879 to prepare for it; I think it was in January or February of 1880 that I manufactured the first.

Q. Up to what date did you continue in the employment of Topliff & Ely?

A. In 1878, I think, I did some business for them.

Q. What change, if any, was made in the relation between yourself and that firm prior to 1879?

A. There was no change. I simply started out to manufacture according to the contract and our agreement.

Q. The contract spoken of by you is the contract a copy of which is set out in your answer?

A. I suppose it is; yes, sir. I have the original if you would like to see it. I believe that to be an exact copy; I am not certain.

Q. Up to what date did Topliff & Ely continue to pay you royalty under that contract?

A. I think it was in August or September, 1879, that they paid me the last royalty.

Q. Was that before or after you had left their employment?

A. It was after I had left them.

Q. Prior to the time you left their employment what controversy, if any, had there been between you and that firm as to the payment of royalty, or your right to receive the same?

A. We had had some one or two conversations. They had told me that if I commenced manufacturing according to the contract as I understood it, that they should not pay me any more royalty. They made no objection if I did not commence manufacturing; they would continue the royalty the same; they had no objection to paying the royalty if I would not go into business the same as they had. They never told me they would not.

Q. Prior to 1879 what claim if any, did they make, against your right to receive royalty?

A. I think near the time that the five years spoken of in the contract expired I had some talk with them that I thought I had a right to go to manufacturing, and did not know but I should, and at that time they claimed that I had no right to manufacture.

Q. What claim did they make as to your right to receive royalty?

A. They did not deny my right to receive royalty at any time up to 1879.

Q. Will you state whose invention or device, in fact, was embodied in the patent taken out by your brother in 1875?

(Objected to.)

A. I think it was my invention mostly. It was, of course, the result of some conversations between us but as far as the filling was concerned there was no question about that, and there never had been, but what I was the inventor of that portion of it at the time his patent was taken out.

Q. Will you state the character of the discussions between your brother and yourself that led to the improvements that were embodied in your brother's patent, by which I mean what was said in substance?

A. I made a good many complaints because the sockets were not strong enough. Traveling on the road as I did, I would discover the faults; carriage-makers would show them to me, and I would go home and show them to my brother, and often would carry them broken pieces that carriage-makers had given to me and show them where they were weak, and consult with them as to how it was best to strengthen them. There was no radical change, it was simply changing a little here and a little there from time to time. From the time we first began to make the

socket there was a gradual change. Perhaps the sockets have been improved and strengthened as much in the last five years as in the first five.

Q. And these discussions that you had with them were what led to the strengthening of the sockets?

A. Yes. Wherever I discovered that there was a weak point I would make complaints to them and we would see if we could not remedy it.

Q. And what was the result?

A. The result was the various improvements that have been made either by my brother or myself.

Q. Whom did Topliff & Ely have on the road traveling for them beside yourself during the first five years of their manufacture?

A. I think Mr. Thomas Hammond did a little traveling during that time.

Q. Who principally worked up the trade for the firm?

A. I did most of the traveling.

Q. How long did you continue to travel?

A. The greater share of the time for 7 or 8 years.

Q. Will you now describe the success of the manufacture and of the business from the time you entered upon it in 1870 or 1869 down to 1879, when you left their service?

A. It has been a continued success. There were some failures in the start, but very few—not so many as I would have supposed there would have been—they were so poorly manufactured. If they had been well made, as they should have been, and as I tried to have them made, they would have been a perfect success from the start even in the old New Haven pattern.

Q. Whose fault was it that they were poorly manufactured? (Objected to.)

A. It was the fault of the manufacturers.

Q. You may state whether or not the defects could have been remedied, and whether they were remedied after a time.

A. The defects could have been remedied in the old first pattern, the New Haven pattern, as they call it, had they been manufactured out of heavy enough iron, and a piece welded or soldered in where they are riveted together at the lower end. The way they manufactured them was just simply to take No. 25 or 26 iron, make a tube and smash the end and put a rivet-hole through it without any reinforcing or strengthening whatever at the lower or small end. If it had been reinforced there with a piece welded in, or soldered in when they soldered it, it would have been as strong a socket as we are making now.

Q. You mean by "reinforced" strengthened?

A. Yes, by adding a piece of steel or iron. The sheet-iron that they made them of at first was very soft and very thin, not over half as strong as that they are using now.

Q. About how much royalty did they pay you under your contract after 1875 and down to 1879?

A. From $25,000 to $30,000, I should say; perhaps more.

Q. Will you state whether Topliff & Ely at any time from 1870 to 1876 issued catalogues descriptive or the bow-sockets that they were manufacturing and selling?

A. Yes, sir; in 1871, 1872, 1873 and 1876 they issued catalogues, to my knowledge.

Q. You may state whether you now hold in your hand the catalogues they issued.

A. I have a copy of the catalogues of the 4 years.

Q. Will you annex them to your deposition and make them a part thereof.

A. I will. The same are hereto annexed, marked "Exhibits A, B, C, and D."

Q. You may state how extensively the catalogues were circulated among the customers of Topliff & Ely or among the trade.

A. They were sent out in quite large quantities; I should say from five to ten thousand every year that they issued the catalogues.

Q. Will you annex to your deposition and make it a part thereof a half a set of the bow-socket as originally manufactured by Topliff & Ely?

A. I will. "Exhibit E," hereto attached, is such a half set.

Q. Will you annex to your deposition and make it a part thereof a half a set of the improved bow-socket that was manufactured under your second patent of the date of 1871?

A. I will, and "Exhibit F." hereto attached is such a half set.

Q. Will you annex to your deposition and make it a part thereof a half set of the bow-socket as improved and patented by your brother in 1875?

A. I will, and "Exhibit G," hereto attached, is a half set of such improved article.

Q. Will you annex to your deposition and make it a part thereof a tube such as you made in 1870?

A. I will annex such a tube as I made for my first sample, and all the samples that I carried on the road in 1870 to show customers, with a piece welded into the end. The tube is hereto attached, marked "Exhibit H," and made a part of this deposition.

Q. Will you furnish and annex to your deposition tubes made by Topliff & Ely from 1870 to 1873 while experiments were going forward for improvements?

A. I will. The tubes hereto attached, marked "Exhibit I," are such tubes, and I make them a part of my deposition.

Q. You may state whether the contract between you and Topliff & Ely, a copy of which is set out in your answer, is still subsisting between you?

(Objected to.)

A. It is.

Q. You may state whether Topliff & Ely have ever surrend-

cred or offered to surrender to you their contract or any rights acquired under it?

(Objected to.)

A. They never have.

Q. You may state whether that contract was made in duplicate.

A. It was.

Q. Who has the two parts?

A. I have one of the originals and I suppose they kept the other; they said they did.

Q. You may state whether you ever made any different arrangement with them from the one embodied in that contract respecting the manufacture or sale of bow-sockets.

A. I never did.

Q. You may state whether you have ever released them from any obligations that that contract imposed upon them.

A. I never have.

Cross-examination by MR. WILLEY:

Q. At what time was the manufacture of these bows according to your original patent of 1870, the combination of tubes and plates, discontinued by Topliff & Ely?

A. I should think in July or August, perhaps, of 1870.

Q. That was really before the patent was issued, was it not?

A. Yes, sir.

Q. But it was according to the patent as finally issued?

A. Yes, sir.

Q. The plates described in that patent to be used in combination with the tubes were plates that you subsequently found to be covered by another patent, were they not?

(Objected to.)

A. Yes, sir.

Q. Whose patent?

(Objected to.)

A. I think the Bidwell patent covered that, or a portion of it.

(Answer objected to by defendant's counsel.)

Q. It covered the plates, did it not?

(Objected to.)

A. I am not certain whether the Bidwell patent covered the plates or the manner of stiffening one of the bows in the plates. There was some point that the Bidwell patent covered about the plates.

Q. Was there anything in your patent about furnishing a slat for the purpose of strengthening the plates to which your tubes were to be attached?

A. In the second patent, not in the first.

Q. In the patent of 1871?

A. The patent of 1871, yes.

Q. Where does the strengthening steel in the patent of 1871 come in.

A. It extends in the back bow from the slat-iron up as high as it is required, twenty to twenty-two inches.

Q. Is it fastened at all to the slat-iron in the patent of 1871?

A. In the patent of 1871 it was not attached to the slat-iron.

Q. You say that you at one time inserted wooden filling in some bows for Dr. Sampsell. In what year was that?

A. I think in 1870, in July or August. It was in the summer, I know, of 1870.

Q. Was it to repair a bow?

A. To repair a broken bow. I filled a tube and put on one of our sockets for two of them. I think I put on two.

Q. For how many other persons did you do the same thing that year?

A. I think that summer and fall I put on some 5 or 6.

Q. Where did the people live who had them?

A. In Elyria, or in that neighborhood.

Q. Can you remember the names of any other parties?

A. I can remember Dr. Cushing. I put on one or two for him.

Q. What sort of a wooden filling was that you used?

A. An ordinary ash bow—pieces of ash.

Q. This "Exhibit H" does not show a continuation and a welding does it?

A. Yes, sir, of steel.

Q. Where was this "Exhibit H" made?

A. In my factory.

Q. When?

A. It was made the fore part of this week, I think, mostly.

Q. Is this welded to the slat-iron?

A. The steel is welded to the tube.

Q. When do you say you made anything of this kind?

A. I made them early in the season of 1870.

Q. Who made them?

A. I had them made.

Q. By whom?

A. I could not say what the blacksmith's name was that welded them, but I had them made for me.

Q. Is the blacksmith living in Elyria?

A. I do not know that he is. I don't know that I know his name.

Q. Did he live there then?

A. He did; yes.

Q. How many of them did he make?

A. I had two or three of them made for samples to carry with me. They never were put onto tops, but were simply for samples.

Q. There was no manufacture which followed this?

A. Not in any quantity; no, sir.

Q. And it was never put into use?

A. Never put onto a top that I know of, in that way.

Q. Did you show it to anybody?

A. Oh, yes, sir.

Q. Did you show it to Mr. Topliff?

A. The original sample half set that I had was made in that way, with the exception that the steel or iron only ran up to about two inches from the end to reinforce or strengthen the end. That was a sample half set that I had made.

Q. How far did the steel that you made and that you say this represents, run up?

A. It ran up from 16 to 18 inches.

Q. Then this is not like what you made then?

A. Yes, sir.

Q. Did it run up from 16 to 18 inches from the hole at the lower end?

A. Yes, sir.

Q. What you made, then, only ran up two or three inches?

A. The half set that I made, and I don't know but some of my samples underrun that; but about the time that I was figuring on putting in the steels to stiffen the bow, I had some made in the style of this, "Exhibit H," some time in the middle of the summer of 1870; had some made with the steel running up 16 to 18 inches from the hole.

Q. Was this "Exhibit H" gotten up to be used with the combination of the first patent of December, 1870?

A. Yes, sir; to go between the plates or sockets as described there.

Q. When you put this into use in the original combination under the patent of December, 1870, did you ever make that steel to run up more than two or three inches?

A. Not in the original half set that was made.

Q. The object of that strip was to strengthen the tube where it was riveted, was it not?

A. That was the object in that original sample that I had, yes, sir: to strengthen it at the hole.

Q. It was not to strengthen the tube, but it was to strengthen the plates, was it not?

A. The steel strip was to strengthen the tube; the piece welded or soldered in at the end was only to strengthen the hole.

Q. Then "Exhibit H" was only to strengthen it where it was riveted?

A. No, sir; it was to strengthen the tube also.

Q. But those plates were two or three inches long?

A. The plates in the original half set that I made were only two or three inches long. Those were made in a set in October of 1869. This kind that I speak of, with a steel running up, was made eight or nine months after that. After I found that the bows began to bend and that they required some reinforcement, then in the samples that I carried on the road I put this steel.

Q. Where were those samples obtained?

A. They were made there at the factory, in my brother's blacksmith shop.

Q. They were made by Topliff & Ely, or under their direction, I suppose?

A. No, sir, they were made under my dirction. I had my samples gotten up under my direction.

Q. Topliff & Ely were familiar with those samples?

A. They saw them generally.

Q. Do you say they saw these?

A. I do not know whether they saw them or not. I used to have a half dozen samples of different kinds of bow and pieces of bow that I carried with me, and this represents one kind that I carried at that time.

Q. Do you mean to say that under the patent of 1870 you had any samples or models showing this steel strip?

A. Yes, sir; not cut away to show that, but in other respects it was the same.

Q. Was it on the inside?

A. The steel was on the inside; yes, sir.

Q. You made your headquarters at Topliff & Ely's establishment, did you not?

A. Generally at the carriage factory more than at the bow factory.

Q. Who was at the carriage factory?

A. My brother was there part of the time.

Q. And he was familiar, as I understand you, with the samples that you took out for exhibition?

A. I do not know that he was.

Q. In making bow sockets covered by which patent would this "Exhibit H" be used?

A. It would show the steel of the second patent and the tube of the first, perhaps.

Q. Could that tube be used under the second patent?

A. No, sir; not in that state.

Q. In the first patent was there any steel strip spoken of as welded in at all?

A. No, sir.

Q. That piece that you welded into the tubes to be used with the patent of July 27th, 1870, was used for what purpose?

A. I welded it in for a stiffener, to show people how stiff they could be made with the steel in.

Q. How could people see that the steel was in?

A. They would know it was in if I told them so, and they could see the end where it was welded in.

Q. That would not have shown unless it was cut away.

A. The object was to show the stiffness of it. You could take the old tube across your knee and bend it, and with the steel strip in you could not. You take that tube with the steel

strip in and put it across your knee and you cannot bend it. They would often bend the old tube without any stiffener in, and the object of the steel strip was to stiffen it.

Q. Did you not testify a few minutes ago that these pieces that were welded into these particular tubes, under the patent of 1870, were to strengthen the rivet hole?

A. Yes, sir; that was the original idea.

Q. And this exhibit is offered to show how you wished that rivet hole strengthened in this particular socket to be used on the bow sample manufactured under the patent of 1870?

A. This would show the manner of strengthening the hole and also stiffening the tube.

Q. Was a set ever made that went into the market under the patent of 1870; with the plates that had a steel welded into it as you show in this sample?

A. I do not know that there was.

Q. You never knew of one, did you?

A. No, I never knew of any set being made.

Q. Then this is something different from anything that was ever manufactured by Topliff & Ely?

A. Yes; that is, in complete sets.

Q. Did you ever know of Topliff & Ely making a tube pinched together at the end, such as would be used in the original patent, that had a steel welded in?

A. No, sir; not in complete sets, but I had two or three samples made in that way.

Q. And those were the short pieces?

A. No, sir; they had steels running up from sixteen to eighteen inches.

Q. For what purpose were they made?

A. To stiffen them.

Q. Was it represented to the customers of Topliff & Ely that they stiffened those manufactured under the first patent in that way?

A. That was during the time that we were experimenting on the second patent, putting in the steels.

Q. But while Topliff & Ely were working on the first patent, not the second patent, did you have any tubes with the steel welded in at the bottom?

A. No, I think not; not during the time that they were manufacturing under the first, but I carried it after. There were some manufactured and some sold afterwards.

Q. But were not all those samples that you carried composed of a steel welded into a slat iron, and not into a pinched tube?

A. Those that I carried later, in 1873 and 1874, and along there; yes, sir.

Q. Did you ever carry a sample where the steel was welded into a tube pinched together in this way?

A. Yes, sir; in 1870.

Q. When was the manufacture under the original patent of 1870 discontinued?

A. I should think sometime in June, or July perhaps, of 1870. They might have finished up a few later than that.

Q. From that time down to the present, have either Topliff & Ely or you, since you have commenced the manufacture, used the combination of that original patent?

A. No, sir; I have not, and I do not know that they have.

Q. They have not used the patent tube and have not used the plates described in that original patent, have they?

A. No, sir; not that I am aware of.

Q. And you have not?

A. I have not; no, sir.

Q. Is there any one of the elements of the original patent which either they or you have used since 1870?

A. We have used the tube.

Q. In the same shape, flattened at the end?

A. Yes, sir.

Q. To go between the plates?

A. Not to go between the plates, but to be riveted together. They all are flattened, with a hole in the end.

Q. Is the tube flattened or is the slat iron flattened?

A. The slat iron is welded into the tube, and that is flattened, so that it is a continuation of the tube.

Q. Is not the tube round, as far as the tube goes?

A. The tube is; yes, sir.

Q. The welding that you do is the same as described in John A. Topliff's patent, is it not?

A. The welding of the steel into the slat iron; yes, sir.

Q. At what time did Topliff & Ely begin the manufacture of wooden fillings and send them out filled into the tubes?

A. I think it was in the latter part of the summer of 1873. There might have been some sent out before that, but, as nearly as I can recollect, it was about that time.

Q. Did you put a steel welded in that way as you now weld it into Dr. Sampsell's buggy?

A. No, sir.

Q. You yourself never combined those two, did you, until 1873, when they were combined by Topliff & Ely?

A. I do not remember that I ever combined them on a carriage before that.

A. When did you say that the last payment of royalty was made to you?

A. I think it was in August, 1879.

Q. Prior to that you had had interviews with them in regard to the contract and whether they would pay you any more royalty, etc., had you not?

A. As early as 1876, about the time that the five years mentioned in the contract expired, we had had some conversation on the contract.

Q. After the last royalty was paid a conversation took place, did there not, between you and Mr. Ely and your brother at Elyria?

A. Yes, sir.

Q. They have refused to pay you royalty ever since that conversation, have they not?

A. Yes, sir; they have never paid any royalty since then.

Q. They sued you to recover what they had paid, and you sued them to recover what they had not paid, did you not?

A. Yes, sir.

Re-direct examination:

Q. You say that in traveling for Topliff & Ely you used a sample such as is shown by "Exhibit H?"

A. Yes, sir.

Q. And that was before any bows were being manufactured according to that pattern?

A. Yes, sir.

Q. What was your object in using it?

A. To show how the steel stiffened the bow and made it strong enough.

Q. What were you doing in reference to perfecting the bow at this time?

A. We were at work at it, and I think that most of the bows that were put on in the latter part of the season had the steel strip put in at my brother's factory.

Q. Was it during the time that you were perfecting your second patent or the improvement shown by that patent?

A. Yes, sir.

Q. After Topliff & Ely commenced to manufacture the bow-sockets did they ever discontinue that business?

A. No, sir, they never did.

Q. What, then, do you mean when you say that they discontinued the manufacture under the first patent?

A. They changed from the first patent to the principle in the second patent—the improved bow-sockets. They used that some three years I should think, without any material change, and then changed to welding the steel in with the slat-iron, and also putting the fillers in, in 1873.

Q. All improvements made upon the article from the first were with the full knowledge of all the parties, were they not?

A. Yes, sir.

Q. What question, if any, was ever made by Topliff & Ely that the improved articles were not articles being manufactured under that contract down to 1879?

A. It was never questioned. I never heard it called in question that it was not the same article that they originally commenced to manufacture.

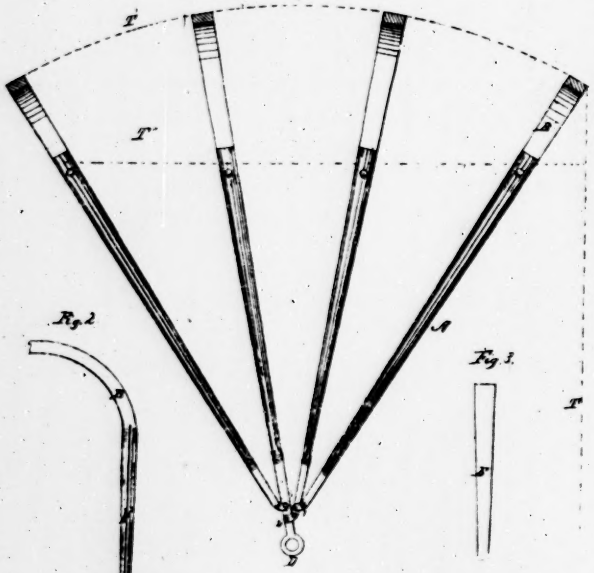
(Signed) ISAAC N. TOPLIFF.

I. N. TOPLIFF.

Improvement in Combined Carriage-Bow Covers and Slat-Irons.

No. 114,885. Patented May 16, 1871.

Fig 1.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Defendant's Exhibit No. 1.

UNITED STATES PATENT OFFICE.

Isaac N. Topliff, of Elyria, Ohio. Letters patent No. 114,885, dated May 16, 1871. Improvement in combined carriage-bow covers and slat-irons. The Schedule referred to in these letters patent and making part of the same.

To all whom it may concern: Be it known that I, Isaac N. Topliff, of Elyria, county of Lorain, and State of Ohio, have invented a new and improved carriage-bow cover and slat-iron combined; and I do hereby declare that the following is a full and exact description thereof; reference being had to the accompanying drawing and to the letters of reference marked thereon making a part of this specification.

Figure 1 is a perspective view of the bows covered on a four-bow top with open sides.

Figure 2 represents a section of a bow as seen when out of the cover.

Figure 3 shows a tapering piece of sheet-steel or other hard metal.

To enable others skilled in the art to make and use my invention, I will proceed to describe its construction and operation.

A in Figure 1 represents one of my bow-covers, which is constructed as follows:

I take sheets of steel or other hard metal, from which I cut tapering strips of steel like Figure 3. These are usually from two to three feet long. They are first taken to a folding-machine, in which both edges are folded over, then to a bending-machine, in which it is bent round a mandrel, bringing the folds together so as to lock them; then putting the tube I have formed on a groove mandrel, I run it between rollers, which press the folds together, forming a strong, tight lock, with the bead or fold on the inside, leaving the outside smooth and even.

I do not claim as new the locking only as applied to metallic bow covers.

Into the small ends of these tubes or bow-covers thus formed I weld, solder, or otherwise fasten pieces of iron, shaped and formed like 1, 2, and 3 in figure 1 or any other shape desired.

One or more of these ends 1, 2, and 3 should have a large eye or hole, as shown at D in Figure 1, at which it is attached to the iron on the seat of the carriage in the usual manner.

My drawing represents a four-bow top, but I do not confine myself to that number of bows or any particular shaped ends.

After fastening the ends together in any form desired the whole is then japanned, and, thus finished, resembles patent-leather.

These bow covers should be long enough to extend above the dotted line T″ or near to the bend in the bows.

The dotted lines T T′ T″ show the outlines of the leather forming the top.

The wood bow B may extend the whole length of the metallic cover, or only part, but should be driven on tight, and then fastened with a knob, nail, or screw.

Before the bow is inserted into the cover I take a saw and slit it as shown in figure at F, into which I insert the tapering piece of sheet-metal, represented in figure 3, to give the bow greater strength.

The whole thus described makes a neat, substantial, and durable bow-cover and slat-iron.

I do not claim as new the covering of bows with sheet metal; but—

What I claim, and desire to secure by letters patent, is—

1. The combination of the metallic carriage-bow cover and slat-iron.

2. The locking of the metallic carriage-bow covers.

3. The tapering piece of sheet-steel E, for the purpose shown and described.

ISAAC N. TOPLIFF.

Witnesses:

F. D. HAYDEN,
A. F. PARSONS.

Defendant's Exhibit A.

Circular of 1871.—Office of Topliff & Ely, sole manufacturers of steel tubular bow-sockets and Beer's patent seat riser; also manufacturers of wagon and carriage wood-work. Elyria, Ohio, January 2, 1871.

We have the pleasure of presenting to our numerous friends and customers, in the following pages, a descriptive catalogue of our bow-sockets. We have now been manufacturing the bow-socket for a year, during which time we have constantly been improving them,—overcoming every fault that has been discovered,—and now offer them as the best article that can be used in making a top for buggies and carriages.

The demand for the bow-socket was so much greater than we had expected that we were obliged to disappoint many who favored us with orders, it being utterly impossible to manufacture enough to supply the demand. That we may be able to fill all orders promptly, we have greatly increased our facilites for manufacturing, and hope to be able to give all orders prompt attention. We shall be pleased to hear from all our old customers, and as many new ones as may favor us with their orders.

Very respectfully,

TOPLIFF & ELY.

As the bow-socket is comparatively a new article, we will explain its use, which will be readily understood by examining the cut on the preceding page.

Heretofore buggy tops have been supported by wooden bows covered with leather, which at the bottom are connected and

fastened to the body by a slat-iron. Now, imagine these leather covers to be steel tubes, japanned and pivoted at the bottom, and you have the idea of a bow-socket. Then by comparing the strength of a leather cover with these steel covers, you readily see the superiority of this improvement. The objection to the common buggy bows is that they are not stiff enough, bending when one takes hold of them to help himself into the buggy. The leather with which the bows are covered adds do strength, and soon wears out. They are apt to break, and when broken are hard to repair. These tubes, while they add greatly to the beauty of a top, being about half the size of leather-covered, give more than double the strength to the bow.

We attach the tubes to quite a number of different styles of slat-irons, having lately added some new patterns to our previous assortment. We can also make to order any pattern not described which may be desired, or if any prefer to make their own slat-irons and send to us it can be done by writing to us how to make the shanks to which the tubes are attached.

Full directions accompany all the bow sockets (directions will also be found on page 8), and if these directions are carefullyl followed the bow-socket will give perfect satisfaction. and will last much longer than leather-covered bows. Besides all the other advantages of the bow-socket, it is so cheap no carriage-maker can afford to use anything else. Their comparative cost will be found in following list of prices furnished us by a prominent manufacturer for a four-bow top:

Slat-irons	$	70	to	$1	25
10 ft. leather, from 14 to 24 cts. per ft	1	40	"	2	40
Rounding bows and fitting slat-irons	1	00	"	1	50
Screws, etc.,		10	"		10
Covering bows		75.	to	2	00
Total cost from	$3	95	to	$7	25
Adding 50 cents for fitting bows to price of cheapest and price of best bow-sockets	$3	50	and	$5	50
We have a balance in favor of the bow-sockets of from	$	45	to	$1	75

Mr. J. W. Goslin, of Cincinnati, O., has used the bow-sockets since we first commenced manufacturing, and writes us the following letter:

CINCINNATI, December 8, 1870.

Messrs. Topliff & Ely, Elyria, O., Gents—We are using on most of our buggies and light barouches the improved "steel tubular bow-sockets," with the wrought-iron ends and the steel strip in the back bows.

They will, no doubt, prove to be a decided improvement on the ordinary covered bow.

Yours truly,
J. W. GOSLING,
By GEO. R. GROOT, *Supt.*

We are indebted to one of the largest carriage establishments in the West for the following recommendation:

INDIANAPOLIS, Aug. 15, 1870.

We have used Topliff & Ely's tubular bow-sockets during the past season on a large number of our vehicles, and in no single instance have we had occasion to repair or alter the same, and it gives us pleasure to say that we believe they ought and will be used to the exclusion of every other kind now in use. And we recommend them to every person desiring a neat, light, and substantial carriage-top.

SHAW, LIPPINCOTT & CONNER.

These bow-sockets are made by pivoting tubes to malleable plates. We can furnish of this pattern plated ends, both silver and gold, for four and five bow, also all kinds of extension tops.

Messrs. J. Colyer & Co., of Newark, N. J., have used this kind altogether, and have favored us with following letter in regard to bow-sockets.

NEWARK, N. J., Dec. 12, 1870.

Messrs. Topliff & Ely: Sirs—We think the bow-sockets the best improvement that has been put on a buggy—they come cheaper, and are neater and stronger. We have used about one hundred set, and find them stronger. We have had the old-fashioned bow break in letting down too quick—in letting it fall back too heavy; but we have had none of these break. The old bow springs out sometimes, so that the top will catch in raising or letting down, but we have not had that trouble with this bow, as they never spring out. Our customers all prefer them to the old bow. We are using them altogether, and would not do without them. Some say that they rattle, but if they use dry bows and they are fitted well, there is no trouble.

Very respectfully yours,

J. COLYER & CO.

Defendant's Exhibit B.

Circular of 1872. Office of Topliff & Ely, sole manufacturers of patent tubular bow-sockets and Beer's patent seat riser, also manufacturers of wagon and carriage wood-work.

ELYRIA, O., January, 1872.

We have the pleasure of presenting to our numerous friends and customers, in the following pages, our second annual catalogue of bow-sockets. We have now been manufacturing the bow-sockets for two years, during which time we have constantly been improving them, overcoming every fault that has been discovered—and now offer them as the best article that can be used in making a top for buggies and carriages.

In our last catalogue we had some patterns which were not so strong as those we now make, and we have, therefore, left them out of the present catalogue, and offer only those which, by long

and severe trial, have stood every test. The bow-sockets we now make only differ from each other in style of slat-iron, and of these we have a variety of styles to suit all tastes. (The slat-irons are all forged from the best Norway iron, and the tubes are welded on.)

Many of the best carriage-makers in the country have favored us with recommendations of the bow-socket, but the simple fact that these same carriage-makers use the bow-socket is as valuable an endorsement as any letters can be; we therefore give a partial list (see page 9) of well-known carriage-makers who have been using the bow-socket during the past year. As far the greater number buy from the hardware dealers, our list includes only a small part of those who are using the bow-socket, and only those who have bought direct from us. Probably everyone will find in the list we give the names of one or more with whom he is acquainted, and their disinterested opinion will have more influence than any statements we can make.

We also insert, at the end of our catalogue, the cards of some of the more prominent dealers, in different parts of the country, who keep our goods, and from whom all patterns of our bow-sockets can be obtained, as well as from us.

Very respectfully,

TOPLIFF & ELY.

Defendant's Exhibit D.

Circular of 1876. The improved tubular bow socket. Three years ago we had hardly a dozen customers who were using the bow-socket. Feeling confident that with the improvement made it was sure to be adopted by all who would give it a fair trial, we spared no expense or labor to bring it before carriage-makers.

The result has proved us correct. Those who have given it a fair trial, have continued to use it, and the number of our customers has been continually increasing. In 1874, our sales were double what they were in 1873. In 1875, double those of 1874, and there is every indication of a corresponding increase in 1876.

Many carriage-makers who made the best work and are very cautious in making any change, knowing that their reputation must be sustained, a year or two ago would take a set of bow-sockets and put them on a buggy to be used by themselves or some one near them that they might test them, and these tests have eventually resulted in their adopting the bow-socket on all their best work. We received a letter, dated November 20, 1875, from Messrs. G. Woeber & Bros., of Davenport, Iowa, whose reputation is well-known at the West, in which they say: "Have concluded to adopt the bow-socket for next year, as we are satisfied they are a good, practical thing that combines both neatness and durability." This and many similar letters received during the past year, we value; as they show that the bow-socket

is being adopted, not from any recommendation or guaranty, but from its own merits after a careful test.

The centennial. We have received orders from many of the best carriage-makers for bow-sockets for work to be exhibited at the centennial. We shall be glad to have all interested compare top-buggies with bow-sockets and without, and have them, also, examine our goods, which will be on exhibition there.

COMPLAINANTS' REBUTTAL.

Geo. H. Ely, of lawful age, being first duly sworn, deposes and says as follows:

Q. (By Mr. Willey.) Are you one of the complainants in this case?

A. Yes, sir.

Q. When did you commence manufacturing carriage-bows with your partner, John A. Topliff, in Elyria?

A. We commenced manufacturing tubular bow-irons about the first of the year 1870, or the latter part of December, 1869.

Q. At that time what was presented you by the defendant in the way of a patent or an application for a patent?

A. At that time I remember of no papers being presented to us, but an article purporting to be made under a patent which had been applied for was shown us.

Q. And you and your partner made the contract with the defendant which is set up in the pleadings?

A. Yes, sir.

Q. What did you understand from the defendant that the patent was to cover?

(Objected to.)

A. A tubular iron for the support of the buggy-top, to take the place of the straight part of a wooden bow.

Q. What examination, if any, did you make of the patent when it came on subsequently?

A. I don't remember any examination.

Q. At what time was that patent destroyed by the fire?

A. We suppose it to have been burned up in March, 1873.

Q. Did you ever see it from the time of the fire in 1873?

A. I do not remember ever to have seen the original patent after that fire.

Q. How long did you manufacture the combination contained in that patent of 1870?

A. I could not state positively, but six months, more or less.

Q. Were you a machinist—had you worked in iron?

A. I had learned the machinist trade as a boy.

Q. You may state whether you and John A. Topliff gave joint attention or not to the manufacture under this first patent as long as you manufactured under it.

A. The most attention was given by John A. Topliff, but I

always gave more or less to it. My duties were office duties, and I had not as much time to give to it as he did.

Q. Still you gave some to it?

A. I gave it several hours every day in the shop.

Q. While these were being manufactured?

A. Yes, sir.

Q. You may state as to the manner in which those manufactured under the original patent were manufactured. Of what material and with what skill.

A. As we were in hopes of working up a prosperous business, it was for our interests to and we did manufacture them as well as we knew how, with the information and experience we had at that time, and used what we deemed would be the best materials for the purpose.

(Answer objected to by defendant.)

Q. You may state whether or not they were manufactured well or otherwise to make the combination a success, if it could be so made?

(Objected to.)

A. The material used was the same, the iron was substantially the same, that has proved successful in similar use since, and therefore we think it was as good as we could have used at that time; it was the best that could be obtained for the purpose at that time.

(Objected to.)

Q. You may state whether or not the defendant was with you, aiding or suggesting in any way with regard to the manufacture under the original patent.

A. Most of the time he was traveling. Occasionally he would be at home, and then would advise and consult with us.

Q. Do you know of his making any objections to the manner in which you were making them?

A. Yes.

Q. At what time?

A. I could not state the time. He would see failures, that would occur as they would in any new article, and speak of them and suggest remedies; sometimes would show dissatisfaction, as was natural, for he was anxious to see a success of it, and would, as he supposed, justly hold us accountable for the failures, where we would say unjustly, because our interests were as great as his to make it as successful as we could.

Q. Were his suggestions considered by you?

A. They were considered—occasionally may have been adopted; occasionally we thought best not to adopt them.

Q. Your partner was also an experienced carriage-maker was he not?

A. Yes, sir.

Q. And a machinist?

A. A mechanic, rather than a machinist.

Q. What suggestion was there, or what was done, if anything, with regard to putting a slip, or wedge, in between the plates to strengthen them, in the tubes manufactured under the original patent?

A. I myself cannot remember anything having been said about that. Whether it was talked of between Mr. I. N. Topliff and my partner or not, I cannot say. In our manufacture I do not remember that we ever stiffened the lower flattened part of the tube by putting in any extra piece of iron or steel to straighten the rivet-holes.

Q. Did you ever see or know anything of his having any model, or any strip of steel which he exhibited among his models which he took out to travel with?

A. Not for those made under the original patent, except in this: Before we had sold all that we did sell made under the original patent of 1870, we had commenced furnishing to carriage-makers strips of steel for them to strengthen their bows with, and some of these strips of steel were sent out with the bow-sockets manufactured under the original patent, for carriage-makers to stiffen their bows, to be used with those.

Q. And where were these strips to be used?

A. They were to be inserted in the bow to strengthen the bow, that the bow might be strong enough to make the combined article strong when put in use.

Q. They had nothing to do with the socket, or the lower part of it?

(Objected to.)

A. They were independent of the socket, but when the top was completed of course they were in the socket and formed part of it.

Q. But they would be inserted in the wooden part of the bow?

A. Yes, sir.

Q. But they had nothing to do with the lower part of the tube?

(Objected to.)

A. No, sir, they had nothing to do with strengthening the rivet-holes.

Q. Or strengthening the lower part of the tube, had they?

(Objected to.)

A. Well, the bow rendered strong in this way would strengthen the tube so far as the steel went.

Q. I mean the lower part of the tube?

A. Not at the slat-iron.

Q. You may state how long you continued to manufacture the combination of the patent of 1870.

A. I think I have testified six months, more or less.

Q. How did that manufacture turn out?

(Objected to.)

A. Financially it turned out very disastrously, as all the goods put upon the market proved a failure.

(Objected to.)

Q. You may state what the value or utility of such a combination as described in the patent of 1870 was.

(Objected to.)

A. In our experience it was worthless, and could not be carried on without loss. A durable substantial article could not be made under that patent, as described in the patent.

Q. Then what would you say as to the invention described in the patent.

(Objected to.)

A. I should say that it was, so far as utility is concerned, or as a profitable invention to manufacture, worthless.

Q. You may state whether the manufacture was abandoned after a period of about six months with the consent and approbation of the defendant.

(Objected to.)

A. He was cognizant of the fact that we discontinued the manufacture. I have no remembrance of his stating in positive language, "I consent to this manufacture's being discontinued," but he was cognizant of the fact at the time it was done.

Q. State whether he made any objection to it.

A. I do not remember of any objections being made to that being abandoned.

Q. You may state what was the first change you made after manufacturing under the patent of 1870.

(Objected to.)

A. While we were manufacturing under the original patent, we locked the tubes together instead of soldering them together, as we had first done, and as, I think, is shown in the specifications of the patent. That is the only change I remember in the sockets made under the original patent.

Q. You may state who got up that locking and reduced it to practice.

A. I should suppose that Adam was the first so far as I know to do locking, it has been done so long. As we were the only parties manufacturing these, we were of course the first to introduce it in practice.

Q. Who got up the machine for it?

A. All the machinery for making them lock was invented by and made under the direction of John A. Topliff. There was no machinery that could be obtained by which the tubes we made could be locked.

Q. What was the next step?

A. The next step was abandoning the combination and substituting a different pattern of slat-iron, instead of the plate shown in the first patent. These ordinary slat-irons were sold-

ered and afterwards welded into tubes round at the end into which the slat-irons were inserted.

Q. You may state whether they were substantially different from the plates described in the patent of 1870.

A. Yes, sir, they were decidedly different from the plates.

Q. What was the next point of change?

A. I cannot say in order of time, but while these changes were being made, or after the changes I have spoken of had been made, it was found that the back tube of the bow-sockets broke, and we sent out with the bow-sockets plates of steel for the carriage-makers to strengthen their bows with, so that the bow would have strength enough to enable the tube to stand when put in use where it would be before broken.

Q. Where were these strips of steel to be used?

A. They were to be inserted in the bows by the carriage-makers, and then the bow inserted into the tube.

Q. What came next?

A. That proving a failure, in that the tubes continued to break where this steel plate would end, John A. Topliff invented the combination of the slat-iron and the steel; that is of welding the steel into the slat-iron and strengthening the tube, so that the tube itself would be strong, regardless of the bow.

Q. That was the invention covered by his patent?

A. Yes, sir.

Q. And that slip sent out was welded in in what way?

A. A slit was made in the slat-iron, into which the steel was inserted and welded, making, in fact, the slat-iron continuous. There was no weak point, as there was in the other, where the steel ended, between the end of the steel and the slat-iron.

Q. You may state whether or not that proved effectual to make the bow and tube and slat-iron strong and perfect.

A. Previously to adopting that, the business, which was quite large at first, decreased. Our sales were less and less, until the adoption of that; and after that they increased continually up to the present day, and gave universal satisfaction, and we never have known of a failure of a back tube made in that way.

Q. You may state to what extent, prior to the adoption of this invention as described in the patent in suit, loss had accrued in manufacturing.

(Objected to.)

A. Without reference to accounts I could not state definitely, but, as nearly as I can remember, I should say we lost from twenty to twenty-five thousand dollars in the manufacture up to the time we adopted that improvement.

(Answer objected to.)

Q. After the adoption of this improvement, how large a business, speaking in round numbers, was built up by you, and how profitable?

(Question objected to.)

A. For the first year or two the business was not very profitable, as there was a prejudice to overcome, occasioned by the failure of what we had made before that time; but after a year or two the business became very profitable, and the sales increased largely every year, making it a very satisfactory business for all concerned.

Q. Run along through the years up to the present time, and give a sort of approximate estimate, if you can, of the number of tubes sold and the extent of the business.

(Question objected to)

A. As nearly as I can remember, the business, from being unprofitable at the time of the adoption of Mr. John A. Topliff's invention, increased until the profits in six or eight years from that time amounted to perhaps $50,000 a year. That is an estimate.

Q. Can you approximate the number of bow-sockets sold?

(Objected to.)

A. Speaking entirely from memory, I should say that at the time of adopting that we were making perhaps 10,000 sets a year, and in six or eight years from that time 100,000 sets. That is without the aid of any books, and a rough guess.

(Answer objected to.)

Q. State whether the bow-sockets manufactured under the John A. Topliff improvement in this patent have given general satisfaction or not.

(Objected to.)

A. They have.

Q. You may state at what time you discovered that the patent of 1870, which was the basis of your contract with the defendant, covered nothing but a combination that you had abandoned?

(Objected to.)

A. The first remembrance that I have of our knowing that was in August, 1879.

Q. Up to that time about how much royalty had you paid the defendant?

A. About $40,000.

Q. How did you make this discovery?

A. We sent to Washington for copies of the patent, and on examining it found what it was.

(Objected to.)

Q. Did you, at the same time, get a copy of the file wrappers?

A. At about that time. In the month of August or September we obtained copies of the file wrappers of the patent of 1870.

Q. What followed that, so far as your having interviews was concerned?

(Question objected to.)

A. We took counsel then to find out what our position was—whether we were under any obligations to Isaac N. Topliff under

the contract which had been subsisting between us, and after obtaining legal opinions we presented the legal opinions to him, a little before the middle of September, or about the middle of September, 1879, and after reading him the opinion that we had obtained from Judge Ranney told him that that opinion was our position, and that we should take the position as given us in that opinion, and, in carrying out that position, told him that we conconsidered that the contract which had been made between us null and void, as we were not manufacturing the article named in the patent

(Answer objected to.)

(The opinion referred to by the witness is offered in evidence by the complainants, and is hereto attached, marked "Exhibit No. 1 to deposition of George H. Ely." Objected to by defendant's counsel.)

Q. You may state if, after that, you refused to pay any more royalty.

A Yes, sir.

Q. Did you have any subsequent interviews with the defendant?

A. Not by appointment—no formal interview. Of course, we met occasionally.

Q. Where was this interview, and who were present?

A. At the office of Topliff & Ely. There were present Isaac N. Topliff, Charles Hunt, John A. Topliff, and George H. Ely.

Q. You may state whether you and your partner brought a suit to recover the royalties back that you had paid.

(Objected to.)

A. We brought suit to recover back the royalties paid.

Q. Did he bring suit to recover royalty?

(Objected to.)

A Isaac N. Topliff brought suit against us for additional royalty.

Q. You did not recover in your case?

(Objected to.)

A. No, sir, we did not recover in our case.

Q. Did he recover in his case?

(Objected to.)

A. Judgment was given him in the Court of Common Pleas up to the time of this interview, in Sept. 1879, but not after, as the Judge held that the contract was legally terminated at that time.

(Answer objected to.)

Complainants put in evidence the re-issued letters patent of January 6, 1880, together with the file wrapper and contents, which are hereto attached, marked "Exhibit 2 to Deposition of George H. Ely."

Q. Did you or your partner, to your knowledge, ever give any consent to the obtaining of such re-issue?

A. We neither of us gave any consent or were aware that any re-issue was to be obtained until it had been granted.

Q. When did that knowledge come to you?

A. In December, 1879, or January, 1880, I could not say which.

Q. On page 10 of defendant's deposition certain exhibits are referred to, marked "F," "G," and "H." Please examine these exhibits, and in the first place explain the difference between "Exhibit F" and "Exhibit G" and in the second place as to "Exhibit F," examine it, and state whether it is like what you made; and if not, show the difference.

(Question objected to.)

A. "Exhibit F" I can explain best by reading the language of the specifications of the patent which covers that part. In the specifications of I. N. Topliff's patent of May 16, 1871, he says: "Before the bow is inserted into the cover, I take a saw and slit it as shown in 'Figure 2' at 'F,' into which I insert the tapering piece of sheet steel represented in 'Figure 3,' to give the bow greater strength." The end of the piece of steel shown where this exhibit is cut away shows this strip of steel used to strengthen the bow. "Exhibit G," which shows the invention of John A. Topliff, where it is cut away shows a strip of steel running into the slat-iron and welded thereto, which was to strengthen the tube regardless of the bow. The invention of Isaac N. Topliff being, so far as this plate of steel is concerned, to strengthen the bow; the invention of John A. Topliff to strengthen the tube. "Exhibit H" is unlike anything ever manufactured in our works, and is liable to mislead in this. that while it purports to be for the purpose of strengthening the rivet-hole by short pieces of iron, as described by the defendant, two or three inches long, a long piece of steel is used, similar to those described in the patent of John A. Topliff, and it is shown as welded to the tube. We never weld it, and there never was welded in our shop a strip of steel to a flattened tube used in bow-sockets manufactured under the original combination. Up to the time and beyond the time that we manufactured those tubes we supposed, and the blacksmiths we employed told us, that so thin iron could not be welded, and it was not until some time after the abandonment of the manufacture of these tubes flattened at the end, that we tried welding, and persuaded our blacksmiths that it could be done. After experience shows it to be simple. But, at that time, I remember distinctly the question being discussed, and it was decided it could not be welded, so that it was not done in our shop. We never made any bow-sockets or put any onto the market containing the flattened tube of the first patent, that had a strip of steel in it. This fact is testified to by Isaac N. Topliff, and, as he was our agent, we were conversant with his samples. We never saw a sample which had that steel welded in,

and should not have permitted him to carry any, as it would have represented something which we did not manufacture, and could not furnish, and no such misrepresentation should we have allowed to go to our customers. If he ever carried a flattened tube with a steel welded in, it was not made at our shop, and not carried with our knowledge or consent, and we never saw or knew of a flattened tube such as would have been used in his original combination, which contained a steel welded to the iron. In farther explanation, I can say with regard to that, that a machine was used to flatten the end which so flattened it that it would be impossible to insert a piece of steel. We had no steel of that kind about our works at the time these were made. But, that I may not be misunderstood, I would say that he did take tubes flattened at the end, the same as used in the original patent, which had a piece of bow into which the steel was inserted as described in his patent of 1871, and with sockets manufactured under the patent of 1870 we did send out pieces of steel to be used in the bows as described in the patent of 1871. But we never furnished either sample or sockets with the steel welded in, and none was ever welded in our shop.

(Answer objected to.)

Q. You may state whether your contract with the defendant, dated December, 1870, has been at any time subsisting between you and the defendant since the interview you had with him in 1879, which you have before set forth.

(Question objected to.)

A. At that interview we informed him that the patent was null and void, and we never have retracted or modified that statement in any way, and have acted in accordance with the position taken at that time ever since.

Q. Has there been any contract subsisting between you since then?

A. No, sir.

(Question objected to.)

Q. You may state whether at that interview you told him, in addition to what was contained in the opinion you read to him, that you had no longer any mutual rights to use the patent.

(Objected to.)

A. We did so state to him; yes, sir.

Q. And whether you stated that the contract was at an end between you.

(Objected to.)

A. We stated that the contract was at an end between us.

Cross-examination by JUDGE HALE:

Q. At the time of making the contract between your firm and the defendant a sample of the articles intended to be manufactured was present?

A. A sample half-set was present.

Q. And you knew the patent applied for by Mr. Topliff related to those articles, did you not?

A. We were informed by him that it did; that is all I know.

Q. When the letters patent were finally issued they were delivered into your possession, were they not?

A. We had them in our possession at some time, and, I suppose, had them in our possession at the time of the fire. Whether immediately after they were issued they were presented to us or not I could not state.

Q. Is it not your recollection that you had them in your possession continuously from about the time of their issue until the fire?

A. I should say not, but I do not remember.

Q. Do you recollect where you kept them?

A. They were kept in a safe in our office.

Q. Did the defendant have access to that safe?

A. Not in the way of having a key and a right to go to the safe at any time he wanted to. He may or may not have given us papers to hold for him. Whether he did or not I cannot say.

Q. Were the papers in the safe at the time of the fire destroyed?

A. The safe was so effectually destroyed that it was never opened. I never have seen any of the contents of the safe.

Q. At the time the letters were issued were you manufacturing?

A. We were.

Q. Is it not a fact that you at that time read over the letters patent?

A. I could not state; I do not know.

Q. What is your best recollection about it?

A. I should suppose that I did, but I have no remembrance of doing it. I would say, in explanation of that, that when the patent was issued we had ceased to manufacture the combination described, and I. N. Topliff had made application for a second patent, and we paid little attention to the first one.

Q. Mr. I. N. Topliff was in the employment of Topliff & Ely from the first commencement of the manufacture of the tubular bow-sockets, was he not?

A. For most of the time for several years.

Q. And his business was what?

A. To solicit orders throughout the United States for the goods we manufactured.

A. And of course he came in contact with the parties that were using the articles manufactured by you?

A. Yes, sir.

Q. As he came in from his trips were any suggestions made by him as to the manufacture of the articles?

A. I presume there were.

Q. Was it a matter of consultation between him and the firm as to defects and the mode of manufacturing the article?

A. He would consult with either of us, generally with my partner, John A Topliff.

Q. As a result of those interviews, the first change made was a change from soldering to the locking of the bows, was it not?

A. As I remember it, that was the first radical change. There were some other little changes in material, which were immaterial changes, I suppose.

Q. The next change in the article manufactured, in the order of time, so far as you now recollect, was what?

A. Abandoning the plates described in his first patent entirely, and inserting separate slat-irons into the tubes and soldering them in. Afterwards we welded instead of soldering.

Q. Is "Exhibit I" attached to defendant's deposition a fair sample of the article after the last-named change?

A. It is.

Q. The next change made in the article was what?

A. The next change that I remember was the adoption of the invention of John A. Topliff, of inserting the steel and welding it to the slat-iron of the back tube. Previously to that we had furnished steels for strengthening bows, but which necessitated no change in the article as manufactured.

Q. How early did you commence the use of the steel to strengthen the bow-socket?

A. About the close of the year 1872 we used the steel to strengthen the bow-socket. Previously to that we had sent out steels to strengthen the bow.

Q. Will you explain precisely the difference between the strengthening of the bow and the strengthening of the bow-socket, as referred to in your last answer?

A. The bow-socket, as made previously to the adoption of the invention of John A. Topliff, of itself was not strong enough to stand ordinary use. The back tubes would break where they struck the prop, and it was necessary either to make a stronger tube, or that a bow should be used strong enough to make the combined bow and tube of sufficient strength to stand. The steel plates were sent out as described in the patent of I. N. Topliff, of May, 1871, to strengthen these bows, so that the bow would be strong enough if the tube was not. This did not obviate the difficulty, as it left a weak point at the end of this steel, between the end of the steel and the slat-iron. So John A. Topliff devised a means of strengthening the tube so that this should be strong regardless of the bow, whether the bow was made of basswood or whatever it might be made of.

Q. You first sent out a steel with the expectation that the carriage-maker would insert it in the bow?

A. We did.

Q. And then the bow would be inserted into the bow-socket?
A. Yes, sir.
Q. And thus the whole be strengthened?
A. Yes, sir.
Q. Does "Exhibit F" show the manner in which the bow and the socket were to be used when thus strengthened as made at the time of the 1871 patent?
A. It does, except that the steels which were furnished did not run as low as that shown in "Exhibit F." They stopped two or three inches above the slat-iron.
Q. Was there any particular point specified in the patent at which the steel should cease?
A. There was no particular point specified, but in fact these steels were only about sixteen inches long, and would not have reached from the prop to the slat-iron, and the piece of steel shown in the drawings of the patent shows a short piece of steel, which would not have been long enough to reach to the slat-iron and, in fact they did not. The steel used by John A. Topliff is a longer piece of steel lengthened at the lower end long enough to go to and into the slat-iron.
Q. You began the use of the steel to strengthen the bow-socket and experimented with it from time to time until it assumed its present use, did you not?
A. I know of no other experimenting than abandoning the plates to be used in the bows, and adopting the longer steel to be welded into the slat-iron.
Q. You never ceased the manufacture of the bow-socket, did you, after you commenced?
A. No, sir.
Q. But changed from one improvement to another till you produced the article in its present shape?
A. Yes, sir.
Q. You say that at times the defendant, as he came in from his trips, found some fault with the material or the style of manufacture of the article sent out?
A. Yes, sir.
Q. Did that relate to the iron or material used and to the manner in which the articles were manufactured?
A. I cannot remember the particular points complained of.
Q. As a matter of fact, did you use the same weight of iron in the manufacture of the first articles as you now use.
A. After the first month or two we did.
Q. Are you sure as to the time at which you changed from the lighter to the heavier iron?
A. Yes, sir. I would say I am sure in this way: Because I personally went to Pittsburgh and had the iron made specially for the purpose, and remember all the detail of the contract under which that iron was made.
Q. But do you remember at what date that was?

Q. Is it not a fact that the Topliffs, John and Isaac, were in frequent consultation over this defect and the manner in which it could be remedied—don't you know that to be true?

A. I know that to be true; yes, sir.

Q. That together they experimented on a mode of remedying that defect?

A. I do not know that.

Q. You do not know that they were in frequent consultation about it?

A. I know that he would speak of these faults and we were all of us trying to remedy them, and he may have suggested some; a good many were suggested that never were adopted; they were deemed impracticable, and at the time the steel was welded into the slat iron I think he was not present in Elyria at all; I think he was out on the road.

Q. At what time did you commence the use of the article with the steel welded into the slat iron?

A. In the latter part of the year 1872.

Q. Immediately after that was done were samples furnished Mr. I. N. Topliff, or did he have samples showing that change?

A. I suppose he did.

Q. And as these changes were made from time to time, and prior to September, 1879, was any question whatever made by your firm as to payment of royalty?

A. The question was discussed in 1875, I believe, with him and doubt was expressed of the rights of the different parties under the contract, the particulars of which I have nearly forgotten and could not definitely state.

Q. And after that discussion and having your attention brought directly to it, you continued to pay royalty for some five years?

A. My impression is that discussion was more as to his having a right to manufacture, and more with regard to a demand that he made for an increased royalty than as to whether royalty was due or not under the contract or under the patents.

Q. Then is it true that you ever in any manner denied his right to royalty under the contract prior to September, 1879.

A. I don't remember that we did.

Q. At the time of this discussion over the rights of the parties was the contract there present?

A. It is my impression that it was, but I am not positive.

Q. Did you at that time take any legal advice as to the respective rights of the parties, in 1875, at the time of this interview?

A. We did, yes, sir, on the point of his right to manufacture articles containing the improvement of John A. Topliff only. That was the only point on which we took counsel.

Q. You took no advice as to his right to receive or demand royalty?

A. None whatever; never took any counsel upon that point until the summer of 1879.

(Signed.) GEO. H. ELY.

Complainants' Exhibit, No. 1.

September 12th, 9.

Messrs. Topliff & Ely, Elyria, Ohio. Gentlemen: At the request of Mr. Willey, of Willey, Sherman & Hoyt, I have devoted a day to carefully examining Letters Patent Nos. 110,513, 114,885, 166,950, and the contract between you and I. N. Topliff dated December 27, 1870, with the letter or written opinion of W. S. & H. addressed to you on the 1st inst. I also had before me and carefully examined in connection with the patents the articles represented by the first patent, and the article now manufactured by you.

With these aids to forming an opinion I will say that I agree with the above firm in the views and opinion contained in their letter as follows:

First. As to the rate of royalty; if it amounts to above one-third of the net profits, it would strike me as being very high for any invention however well perfected and successful, but I am not myself familiar with what is usual in such cases, and this is a business rather than a legal question.

Second. It is my opinion that under the license you can only be required to pay royalty when the articles you manufacture contain substantially the combination and all the elements thereof, as found embodied in the claim of the patent under which the license is granted.

Third. That the article as you now manufacture it does not contain such combination. The bow A. is not flattened at the lower end and more especially the bow socket D. is entirely absent, ordinary slat irons being substituted.

Fourth. If you in fact used said combination with all its elements, the defence would be open to you that such combination was entirely useless or the patent therefor void for impracticability or want of novelty.

Fifth. I do not regard the subsequent patents, the one granted to I. N. Topliff and the other to John A. Topliff, as being improvements on the combination described in the first patent of 1870, in such sense as that they are within the clause in the contract which provides that improvements made by either party shall be for the benefit of both parties; for the reason that they do not contain the combination described in the first patent. They are new combinations and not improvements on the old combination, which is abandoned. Hence it follows that John A. Topliff has the exclusive right to his invention and that I. N. Topliff has the exclusive right to the invention described in his Second Patent, but,—

Sixth. If, as I am informed, the first two claims in this patent are for things invented by some other party then these claims are void, for the reason that the true and actual inventor must always appear in the application for a patent.

As to the third claim for the tapering piece of sheet steel E, I consider that it is not used in the article you now manufacture. What you do use is an entirely different thing both in form, location and mode of attachment. It is combined also with the wooden filling instead of the bow. It is substantially a part of the slat iron extended. It is effective and sufficient to give the required strength throughout, while the tampering piece E. is not effective except to transfer a point of weakness from one place to another.

In no view then under either of these claims can you be interfered with in manufacturing what you now do if the contract between you above referred to should be cancelled. But I do not think he could use what is described in the last patent to John A.

Seventh. I agree entirely with the views expressed by W. S. & H. that public controversy over these patents, or a knowledge of their defects and weaknesses if put to the test with any outside party who could not be relied upon both in the present and in the long future, would be the worst kind of legal and business policy.

Your position is substantially this: what is common to the public or not protected by valid patents you have the free right to use. What you have yourselves invented and secured by patent you have the exclusive right to use. What you do not use in your present style of manufacture or what is useless and impracticable to use you are not bound to pay any royalty to anybody for. Although, owing to the fact that the original suggestion to engage in this manufacture came from I. N. Topliff, and to the further fact that there might be some advantage in having all these patents remain unattacked and unquestioned publicly, I should advise as liberal a royalty to that end as you feel you can afford to pay, bearing in mind that what was brought to you proved, if I am correctly informed, substantially impracticable and valueless, and that the present successful manufacture is owing to the experiments, inventions, improvements, time, capital and losses which resulted from the imperfection of the first article you as a firm have put into the business.

I am very truly yours,

RUFUS P. RANNEY.

Complainants' Exhibit No. 2:

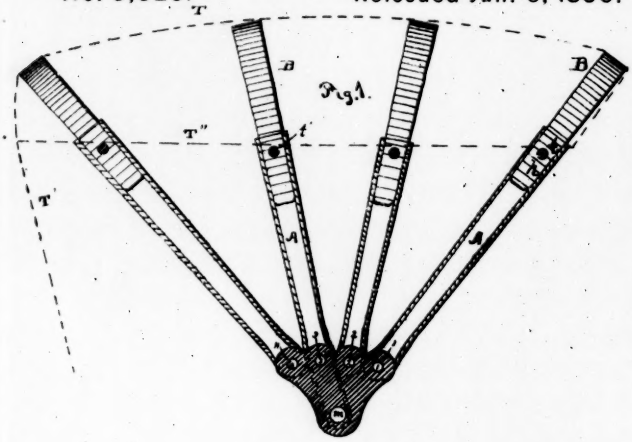
UNITED STATES PATENT OFFICE.

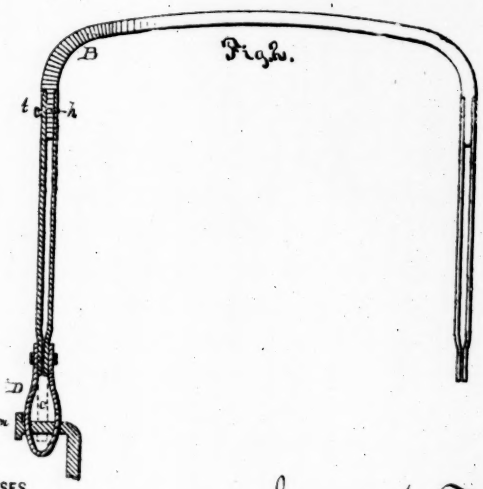
Isaac N. Topliff, of Elyria, Ohio. Carriage-Bow. Specification forming part of Reissued Letters Patent No. 9,026, dated January 6, 1880. Original No. 110,513, dated December 27, 1870. Application for reissue filed October 18, 1879.

To all whom it may concern: Be it known that I, Isaac N. Topliff, of Elyria, in the county of Lorain and State of Ohio,

I. N. TOPLIFF.
Carriage-Bow.

No. 9,026. Reissued Jan. 6, 1880.





WITNESSES
Frank M. Fabor
Willard Fracker

INVENTOR
Isaac N. Topliff.
By Liggett & Liggett ATTORNEYS

have invented certain new and useful Improvements in Carriage-Bows; and I do hereby declare the following to be a full, clear, and exact description of the invention, such as will enable others skilled in the art to which it pertains to make and use it, reference being had to the accompanying drawings, which form part of this specification.

My invention relates to carriage-bows; and it consists in a bow of the character and construction hereinafter specified and claimed.

In the drawings, Figure 1 is a side elevation of the several bows of a carriage-top constructed according to my invention. Fig. 2 is a view in longitudinal section of one of the bows A and its socket D.

A A are the upright or straight portions of the carriage-bow; B, the upper bent and horizontal portions of said bow.

The parts A B, when united substantially as shown in Fig. 2 of the drawings, form a carriage-bow in three parts. The side or upright portions, A A, I make tubular. Into the upper end of the tubular portion A is inserted the top section, B. The lower or terminal portion of the tube A is suitably formed for attachment to the carriage-seat or bow-socket D.

The bow-socket D consists of two concave portions with their edges united and their concave sides facing each other. Within the cavity between said concave pieces the tubes A A are inserted and secured.

By constructing the carriage-bows with tubular sides or upright portions A A, I can produce an article possessing the qualities of cheapness, beauty, strength, and durability.

Moreover, when, from any reason, any tubular portion A should become worn or damaged, it can readily be replaced without material disturbance of the carriage-top structure.

I prefer constructing the portions A A from metal.

Believing myself to be the original inventor of a carriage-bow having tubular side portions A A, I claim, broadly—

1. A carriage-bow the side or upright portions, A A, of which are tubular, substantially as and for the purpose shown.

2. A carriage-bow consisting of the bent wooden section B and the tubular sections A A, the latter constituting the vertical sides or arms of the bow, the opposite ends of the bent portion B being secured to the upper ends of the tubular sections A A, substantially as set forth.

3. A carriage-bow consisting of the bent wooden section B and the metallic tubular sections A A, the latter constituting the straight or vertical sides of the bow, substantially as set forth.

4. A carriage-bow consisting of the bent wooden section B and the tubular sections A A, the latter constituting the straight or vertical sides of the bow, and constructed at their lower ends

to be attached to a socket or carriage-seat, substantially as set forth.

In testimony whereof I have hereunto set my hand in the presence of two witnesses.

ISAAC N. TOPLIFF.

Witnesses:
R. W. POMROY,
A. R. WEBBER.

Department of the Interior. United States Patent Office.

To all persons to whom these presents shall come greeting: This is to certify—That the annexed is a true copy from the files of this office of the file wrapper and contents in the matter of the re-issue Letters Patent granted Isaac N. Topliff January 6, 1880, No. 9,026, for improvement in carriage bows.

In testimony whereof, I, E. M. Marble, Commissioner of Patents, have caused the Seal of the Patent Office to be hereunto affixed this eighteenth day of September, in the year of our Lord one thousand eight hundred and eighty, and of the independence of the United States the one hundred and fifth.

E. N. MARBLE, Commissioner.

Hon. Commissioner of Patents:

Your petitioner, at the time of granting U. S. patent No. 110,513 dated December 27th, 1870, a resident of Adrian, Lenawee County, Michigan, but now a resident of Elyria, Lorain County, Ohio, prays that he may be allowed to surrender the Letters Patent for an improvement in Carriage Bows granted to him December 27th, 1870, whereof he is now sole owner, and that letters patent may be reissued to him for the same invention upon the annexed amended specification.

Accompanying this petition is an abstract of title, duly certified, as required in such cases.

And I hereby constitute and appoint Messrs. Leggett & Leggett consisting of M. D. & L. L. Leggett, of Washington, D. C., my attorneys with full power in the premises.

ISAAC N. TOPLIFF.

To all whom it may concern:

Be it known that I, Isaac N. Topliff of Elyria, in the County of Lorain, and State of Ohio, have invented certain new and useful improvements in carriage-bows, and I do hereby declare the following to be a full, clear, exact description of the invention, such as will enable others skilled in the art to which it pertains to make and use it, reference being had to the accompanying drawings, which form part of this specification:

My invention relates to carriage-bows; and it consists, first, in constructing the upright or straight portion of the bows from metal, and in tubular form; second, in a carriage-bow having its upper or bent portion joined to tubular metallic ends or straight portions; third, in a carriage-bow constructed essentially of three parts, viz: an upper horizontal, or bent piece, and two tubular metallic side pieces or ends; fourth, in a carriage-bow having its straight or side parts formed of a metallic tube, and having its lower or attached ends flattened, to form, in part, the hinge by which it is attached to the carriage-body or seat; fifth, in a bow-socket made of two sheet-iron concave disks, or plates, placed with the concave faces together, so that the tubular end of the bow may extend downward between them to receive the swivel-bolt and make it firm to the socket.

Erase and insert "B."

In the drawings figure 1 is a side elevation of the several bows of a carriage-top, constructed according to my invention.

Figure 2 is a view in longitudinal section of one of the bows A, and its socket D.

AA are the upright or straight portions of the carriage-bow; B, the upper bent and horizontal portions of said bow. The parts A B when united substantially as shown in figure 2 of the drawings, form a carriage bow in three parts.

The side, or upright portions, AA, I make tubular.

Into the upper end of the tubular portion A is inserted the top section B. The lower or terminal portion of the tube A is suitably formed for attachment to the carriage-seat or bow-socket D.

The bow-socket D consists of two concave portions with their edges united and their concave sides facing each other. Within the cavity between said concave pieces, the tubes AA are inserted and secured.

By constructing the carriage-bows with tubular sides or upright portions AA, I can produce an article possessing the qualities of cheapness, beauty, strength and durability.

Moreover, when, from any reason, any tubular portion A should become worn or damaged, it can readily be replaced without material disturbance of the carriage-top structure.

I prefer constructing the portions AA from metal.

Believing myself to be the original inventor of a carriage-bow having tubular side portions AA—

I claim broadly:

1. A carriage-bow, the side of upright portions AA of which are tubular substantially as and for the purpose shown.

strong, and durable sides to the bow, and is vast improvement on the wooden sides or arms as in Sheldon & Tuttle.

The claims have been changed to avoid the objection that might have been urged against those originally filed.

Respectfully, etc.,

LEGGETT & LEGGETT,
Attorneys.

WASHINGTON, D. C., Dec. 16, 1879.

In re Isaac N. Topliff's application for reissue patent "carriage-bows," filed October 18, 1879.

Hon. Commissioner of Patents: Sir—It is desired to amend this application as follows:

On first page of specification erase all matter from and after line 14. Also first ten lines of second page of specification, and substitute therefor the following:

"B" "My invention relates to carriage-bows, and it consists in a bow of the character and construction hereinafter specified and claimed,"

Respectfully, etc.,

LEGGETT & LEGGETT,
Attorneys.

Room No. 39, Department of the Interior, U. S. Patent Office, Washington, D. C., Dec. 17, 1879.

Isaac N. Topliff, care Leggett & Leggett, present:

Sir—Your application for reissue of patent No. 110,513, for improvement in carriage-bows, has been examined and allowed.

The patent will be forwarded to you as soon as practicable in due order of business.

Very respectfully,

H. E. PAINE,
Commissioner of Patents.

4,204. 1879. Sanders.

Reissue.

No. 9,026.

Isaac N. Topliff, of Elyria, County of Lorain, State of Ohio.

CARRIAGE-BOWS.

Received October 18, 1879.
Petition " " "
Affidavit " " "
Specification " " "
Drawing " " "
Abstract of title, October 18, 1879.
Certified copy old patent, No. 110,513, December 27. 1870.
Cert. dep.
Cash $30, October 18, 1879.
Examined December 16, 1879, Sanders.

Issue December 17, 1879, Arthur W. Crossley.
Patented December 27, 1870.
Reissued January 6, 1880.
Circular December 17, 1879.
LEGGETT & LEGGETT, Present.

Contents.

Application papers.
Rej. October 24, 1879.
"A," November 25, 1879.
"B" December 16, 1879.
(For drawings, etc., belonging to Exhibit No. 2, see accompanying file.
(For Exhibits Nos. 3 and 4 see accompanying file.)

And afterwards, to-wit, on the 22d day of February, being a day of the February term, A. D. 1884, of said Court, before the Hon. John Baxter, Circuit Judge, the following decree was entered, viz:

Chancery.

JOHN A. TOPLIFF ET AL., *vs.* ISAAC N. TOPLIFF. } No. 3,964.

This cause came on for hearing before the Honorable John Baxter, Circuit Judge, upon the pleadings, exhibits, and testimony and ———— was argued by counsel, upon consideration, and the Court being fully advised in the premises, and being satisfied that under the contract set up in the answer, each party has the right to use, without the payment of royalty, the patent issued to the complainant; it is therefore ordered and decreed that the bill be dismissed at complainant's costs to be taxed at $54.30 for which execution may issue as upon judgments at law, from which decree the complainants pray an appeal to the next term of the Supreme Court of the United States, which is allowed, and bond fixed at $500.

Know all men by these presents, that we, John A. Topliff and George H. Ely as principals, and Heman Ely and Fred N. Smith as sureties, are held and firmly bound unto Isaac N. Topliff in the sum of five hundred dollars, to the payment whereof, well and truly to be made, we bind ourselves, our heirs, executors and administrators, jointly and severally, firmly by these presents. Sealed with our seals, and dated this 23d day of June, in the year of our Lord one thousand eight hundred and eighty-four.

Whereas, the above bounden John A. Topliff and George H. Ely have appealed to the next Supreme Court of the United States from a decree of the Circuit Court of the United States, for the Northern District of Ohio, bearing date the 22d day of February, A. D. 1884, in a cause wherein the said John A. Topliff and George H. Ely were complainants, and the said Isaac N. Topliff is respondent, now, therefore, the condition of this obligation is such, that if the above-named appellants, John A. Topliff and George H. Ely, prosecute their said appeal with effect, and pay all such damages, costs and expense as shall be awarded against them as such appellant therein, then this obligation to be void: otherwise, to remain in full force and effect.

JOHN A. TOPLIFF, [SEAL]
GEORGE H. ELY, [SEAL]
HEMAN ELY, [SEAL]
FRED N. SMITH. [SEAL]

Sealed and delivered in presence of
JNO. W. HULBERT,
T. W. BRUSH.

It is agreed and stipulated by and between counsel of the respective parties in this cause that the notices, captions and certificates to the depositions herein, the orders appointing special examiners to take testimony, adjournments and continuances shall be omitted by the clerk in making up this record.

HENRY S. SHERMAN,
Of Counsel for Complainants.
W. W. BOYNTON,
Of Counsel for Defendant.

UNITED STATES OF AMERICA,
Northern District of Ohio.

I, Augustus J. Ricks, clerk of the Circuit Court of the United States for said district, do hereby certify the above and foregoing to be a true, correct and complete transcript of the record of all the proceedings had in said court, except as modified by stipulation of the parties as stated, the record in the cause wherein John A. Topliff and George H. Ely are complainants and Isaac N. Topliff is defendant, as the same appears from the files and records of said court now remaining in my custody.

In testimony whereof I have hereunto set my hand and affixed the seal of said court at my office in Cleveland in said district, on this 20 day of Sept, A. D. 1884, and in the Independence of the United States the 109th year.

Augustus J. Ricks
Clerk

127-121

Office Supreme Court U. S.
FILED.
APR 23 1887
JAMES H. McKENNEY.
CLERK.

Supreme Court of the United States,

OCTOBER TERM, 1886.

No. 286.

JOHN A. TOPLIFF, et al.,
Appellants,

vs.

ISAAC N. TOPLIFF,
Appellee.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF OHIO.

BRIEF FOR APPELLANTS.

HENRY S. SHERMAN,
W. BAKEWELL,
Counsel for Appellants.

Supreme Court of the United States.

OCTOBER TERM, 1886.

JOHN A. TOPLIFF AND GEORGE H. ELY, *Appellants*,
vs.
ISAAC N. TOPLIFF.

Appeal from the Circuit Court of the United States for the Northern District of Ohio.

BRIEF ON BEHALF OF APPELLANTS.

STATEMENT OF THE CASE.

John A. Topliff and George H. Ely, partners under the firm name of Topliff & Ely, filed their bill in the United States Circuit Court, for the Northern District of Ohio, against Isaac N. Topliff, for making and selling carriage bows which infringed upon letters patent granted to John A. Topliff, number 166,950, dated August 24, 1875. The bill contained the usual averments, and prayed an injunction and an accounting. (*Record p. 5.*) The case went to a hearing before Hon. John Baxter, circuit judge, who rendered a decree dismissing the bill upon the ground that the defendant had a right to use the complainants' invention under a certain contract between him and the complainants, which was set up in the defendant's

answer. (*Record p. 77.*) An appeal was allowed, and the case comes into this court upon that appeal.

ASSIGNMENT OF ERRORS.

The appellants contend that the circuit court erred:

1. In dismissing complainants' bill.

2. In holding that at the time of the commission of the acts of infringement complained of in the bill, the contract set up in the defendant's answer was then still in force and binding upon the parties.

3. In holding that under the contract set up in defendant's answer, each party had the right to use, without the payment of royalty, the patent issued to the complainants.

4. In holding that the contract set up in the defendant's answer had not been rescinded prior to the infringement of the complainants' patent by the defendant.

5. In holding that under the contract set up in his answer, the defendant had, at any time, a right to manufacture and sell carriage bows constructed as described and claimed in letters patent No. 166,950, dated August 24, 1875, on which this suit was brought.

6. In holding that the defendant had not infringed the letters patent No. 166,950, dated August 24, 1875, on which this suit was brought.

THE COMPLAINANTS' PATENT.

The invention described and claimed in the letters patent of complainants', sued on, was an improvement in carriage bows, invented by John A. Topliff, one of of the complainants, whose application for a patent was filed in the patent office November 16, 1874. The improvement consisted in making the straight part of the bows for a carriage top of tapering tubes of sheet metal, with a strip of steel of taper shape corresponding to the taper of the tubular piece of the bow, and placing the same inside of the tube, and welding the lower end of it to a slat iron which was inserted into the open lower end of the tube, thus making the steel strip, in effect, a continuation of the slat iron. These steel strips extended upward nearly to the top of the tube, leaving room for the insertion of the wooden part of the bow. Strips of wood were also inserted as filling on each side of the steel strip within the tube. For this improvemet a patent No. 166,950 was granted to John A. Topliff on the 24th of August, 1875. (*Record, p. 27; also, see Patent Office copy of same patent attached to this brief as appendix B.*)

STATE OF THE ART.

Prior to the invention of John A. Topliff, two patents for improvements in carriage bows had been granted to Isaac N. Topliff, dated respectively December 27, 1870, and May 16, 1871. In the first of the

above patents of Isaac N. Topliff, No. 110,513, the invention claimed was for a *combination* of the straight part of the carriage bow made of sheet metal, tubular and flattened at the lower end, and the bow socket formed of two concave scalloped pieces of sheet metal and a bent wooden bow. (*Record p. 28.*) This form never was used by the public to any great extent, and its manufacture was abandoned for two reasons—

1st. Because it was practically useless on account of its lacking strength for the purposes intended. (*Record pp. 22 and 57.*)

2d. Because one of the elements of the combination claimed in the patent, to-wit: the socket formed of two concave scalloped pieces of sheet metal, was found to be an infringement of a prior patent, and the manufacturers were compelled to discontinue its use. (*Record pp. 25 and 42.*)

The invention described in the second patent granted to Isaac N. Topliff, dated May 16, 1871, No. 114,885, (*Record p. 49,*) was intended to avoid the use of the infringing bow socket device, and to overcome the practical defects of the invention claimed in the patent No. 110,513 of December 27, 1870. In the tubular bow, made under this later patent, the concave scalloped socket was wholly abandoned, and instead of flattening the lower end of the tubular metal part of the bow, the old-fashioned slat iron was substituted in order to strengthen the bow, which under the first

patent had been found to be weak in practical use; loose strips of tapering steel conforming to the shape of the inside of the tube were provided and were sent out with the tubular bows, with instructions to carriage makers to slit the wooden portion of the bow and insert one of these steel strips into the wood before the wooden bow was driven into the tube. (*Record, pp. 49-50 and 16.*) This invention was also soon abandoned as practically useless, because the carriage bow, made as thus described, was too weak and would easily break or bend where the steel terminated, and when thus broken or bent could not be repaired as the old-fashioned wooden bow could be. (*Record, pp. 16, 58, 64.*)

The art was in this state when John A. Topliff, one of the complainants, made his invention as shown and described in the letters patent in complainants' bill mentioned, which overcame all the difficulties and caused the manufacture to prove a great success.

THE ISSUES MADE IN THE PLEADINGS.

In order that the court may intelligently consider and apply the facts shown in the testimony, it is proper briefly to state the issues made in the pleadings.

The only defenses set up by the answer are the following:

1. Non-infringement.
2. Want of novelty.
3. That the defendant had a right to manufacture

complainants' device under a written agreement set up in the answer.

As we shall see, the last of these defenses is the only one seriously contended for by the appellee.

INFRINGEMENT.

Although denied in the answer, the infringement is not, in fact, disputed otherwise than by justifying the use of the appellants' patent.

The patent alleged to be infringed is No. 166,950, dated August 24, 1875, to John A. Topliff and George H. Ely, the appellants. (*Record, pp. 26-27; also appendix B to this brief.*)

The invention, as stated in the patent, has relation to bow sockets for buggy tops, and consists in placing a filling of wood in the tubes of the bow sockets to strengthen the same; also in extending the strip of steel, which is inserted in the wood filling far enough down to enable it to be welded, or otherwise fastened, to the slat-iron.

The claims are: (*Record p. 27.*)

1. "In combination with the back tubes of bow sockets and wood bows, or fillings, a steel or other hard metal plate *welded* or otherwise fastened within the tube to the slat iron, substantially as and for the purpose specified."

2. "The combination with the metal tubes of bow

sockets of a wooden filling, substantially as and for the purpose set forth."

The proof of infringement consists of the production of the device manufactured by the defendant marked "Exhibit 6," and the following admissions of record.

(*Testimony of Isaac N. Topliff, appellee, Record p. 47.*)

Q. The welding that you do is the same as described in John A. Topliff's patent, is it not?

A. The welding of the steel into the slat iron; yes, sir.

(*Stipulation of Isaac N. Topliff, appellee, Record p. 26.*)

It is agreed by I. N. Topliff that he was, at commencement of this action, manufacturing the article or bow socket attached to this deposition and marked "Exhibit 6."

CHARLES BALFOUR,
Special Examiner.

This proof is sufficient, as it needs no testimony to show the identity of the device manufactured by the appellee, and that described and claimed in the appellants' patent.

This court has said that infringement is ordinarily best determined by comparison of the exhibits made by respondent with the mechanism described in complainants' patent.

Bates vs. Coe, 98 U. S., 31.

Blanchard vs. Putnam, 8 Wall, 420.

Seymour vs. Osborne, 11 Wall, 516.

NOVELTY.

The denial of novelty as made in defendant's answer, unaccompanied by any specific allegation of prior knowledge, or use of prior patents or prior publication, would render any proofs of want of novelty incompetent. But as there are no such proofs, and no serious attempt to disprove the novelty of the invention of John A. Topliff, this head of the defense needs no further consideration, especially as the appellee substantially admits the novelty of John A. Topliff's invention by stating in his testimony,—(*Record p. 38*):

"Q. Whose device was this welding?"
"A. The welding of the steel to the slat-iron, I sup-
"posed, was my brother's device."

The questions of infringement and novelty being thus practically admitted by the appellee, we submit that the appellants are entitled to a decree in their favor, unless the appellee can sustain his third and only remaining defense, to-wit: that he has a right to manufacture, under the appellant's patent, by virtue of the contract which he sets up in his answer. This, we think, is clearly apparent by considering

JUDGE BAXTER'S DECISION.

Such was evidently the view taken by the court below, and Judge Baxter's decision, as the decree dismissing the bill clearly shows, (*see Record, p. 77,*) was based wholly upon his assumption and finding that said contract was still in existence and in force between the parties at the commencement of this suit, and that by the terms of the contract each of the parties had the right to use the complainants' invention.

FACTS IN THE CASE.

Before discussing the errors assigned in this appeal it is proper and necessary that we should briefly state the facts of the case as they are disclosed by the evidence.

It appears that in the years 1869 and 1870 the complainants were engaged in manufacturing carriage hardware at Elyria, Ohio, and while so engaged they were shown by Isaac N. Topliff, the defendant, an improvement in carriage bows, claimed by defendant to be an invention of his for which, he stated, he had applied for a patent. He represented to the complainants that his invention consisted of "*a tubular iron for the support of the buggy top to take the place of the straight part of a wooden bow.*" (Record, p. 54.) This resulted in the written agreement set out in the defendant's answer. Although the defendant alleges in his answer that this agreement was entered into sometime in Sep-

tember, 1870, the testimony of both defendant and the complainants agrees in fixing the date of its execution about the latter part of December, 1869, and that it was executed, as the contract itself shows, without the insertion of any date at all. This agreement commences by reciting that Isaac N. Topliff was "the sole owner of a certain patent for *tubular iron bows* used in manufacturing carriage and buggy tops, which patent was issued on the....day of....., A. D....." Whereas, the fact was that no such patent was then in existence, and that no patent was issued until about one year subsequent to the actual execution of the contract, the date of the patent being December 27, 1870.

(*Testimony of John A. Topliff. Record, p. 21.*)

Q. You took that license from him at what time?

A. It was December, 1869, I think it was made out.

Q. It was about a year before it was dated?

A. It was about a year before it was dated and before the patent was granted.

(*Testimony of Isaac N. Topliff. Record, p. 42.*)

Q. At what time was the manufacture of these bows according to your original patent of 1870, the combination of tubes and plates, discontinued by Topliff & Ely?

A. I should think in July or August, perhaps, of 1870.

Q. That was really before the patent was issued, was it not?

A. Yes, sir.

Q. But it was according to the patent as finally issued?

A. Yes, sir.

As will be seen from the contract, (*Record, p. 11,*) it purports to give the exclusive right of manufacture and sale "of the above mentioned article throughout the United States for five years," to the appellants, Topliff & Ely; that after that time the patentee was to have "the right to have the above named articles manufactured [it does not state by whom] at not more than two other places, to be sold at prices to be adopted by said party of the second part," [Topliff & Ely]. The parties were to share the expenses of maintaining the right of the patent against infringers. "It is also further agreed that any improvement made on these articles, by either party, shall be for the mutual benefit of the parties." Topliff & Ely agreed to pay the patentee fifteen per cent. of the wholesale selling prices as royalty, the prices to be settled by mutual agreement between both parties. Topliff & Ely also agreed to push the sale and to manufacture the articles of quality and finish to the approval of Isaac N. Topliff.

It appears that at the time when the contract in question was entered into, it was the understanding of Topliff & Ely that the invention made by Isaac N. Topliff, and to be covered by the patent for which he had applied, was "*a tubular iron for the support of the*

buggy top, to take the place of the straight part of the wooden bow." (*Record p. 54.*) And it was that device, and Isaac N. Topliff's representation that he was the first inventor thereof, and would get a patent therefor, which induced Topliff & Ely to enter into this contract and agree to pay the extravagant royalty of fifteen per cent. on the gross sales.

Now, the records of the patent office show that before this contract was entered into (which was in the latter part of December, 1869, as all are agreed), to-wit: on the 23d of November, 1869, the application of Isaac N. Topliff had been rejected by the patent office (*Record p. 31*). The first claim, which was "the upright part of carriage bows constructed of tubular sheet metal in connection with the wooden bow, put together in the manner and for the purposes set forth and described," and which was the only claim of any value, being rejected on "the forfeited case of Ferdinand Selle, filed September 7, 1867." This was an application on which a patent had been allowed and was *forfeited*, and had become public property by non-payment of the patent fee.

At the time, therefore, when Isaac N. Topliff made this agreement with Topliff & Ely, he knew that his application for the *tubular iron* was rejected, a fact of which Topliff & Ely were ignorant.

Immediately upon the execution of the contract, Topliff & Ely purchased tools and machinery and

commenced the manufacture of the carriage bows after the pattern shown to them by Isaac N. Topliff, (like Exhibit E.) and like also the drawing and description of the Isaac N. Topliff application. (*Record, p. 19.*) This was several months before the issue of the patent to Isaac N. Topliff, and this was done by Topliff & Ely under the belief, on their part, that Isaac would be able to procure a patent on the *tubular iron*, that being the main feature, and, as all admit, the only thing of any value in the defendant's device.

Before the patent was issued the device constructed as described in Isaac's specifications had been put out on the market and had proved a failure and was abandoned, and those which had been manufactured and sold were returned in quantities to the manufacturers, Topliff & Ely.

(*Testimony of John A. Topliff. Record, p. 22.*)

Q. When did you say you stopped combining the tubes with the plates described in that patent?

A. In May, I think, but it may have been June, May or June, I should say, of 1870.

Q. Why did you discontinue it?

Question objected to.

A. We discontinued it for the reason that they were good for nothing. They were sent back so that we never had to make only a thousand sets, and they will last us a thousand years.

Q. You may say whether the sets that you thus made, by combining the tubes with the plates, were useful or valueless?

A. They were perfectly valueless and were finally

thrown into the river, lots of them—most of them, I might say.

* * * * * * *

Q. You may state whether or not that was abandoned with his approbation?

A. It was abandoned with his approbation, as far as I know, as he was there and knew of their coming back—of their failures.

(*Testimony of Isaac N. Topliff, p. 47.*)

Q. When was the manufacture under the original patent of 1870 discontinued?

A. I should think sometime in June, or July perhaps, of 1870. They might have finished up a few later than that.

Q. From that time down to the present, have either Topliff & Ely or you, since you have commenced the manufacture, used the combination of that original patent?

A. No, sir; I have not, and I do not know that they have.

Q. They have not used the patent tube and have not used the plates described in that original patent, have they?

A. No, sir; not that I am aware of.

Q. And you have not?

A. I have not; no, sir.

(*Testimony of Geo. H. Ely, pp. 57-8.*)

Q. You may state how long you continued to manufacture the combination of the patent of 1870?

A. I think I have testified six months, more or less.

Q. How did that manufacture turn out?

Objected to.

A. Financially it turned out very disastrously, as all the goods put upon the market proved a failure.

Objected to.

Q. You may state what the value or utility of such a combination as described in the patent of 1870 was.

Objected to.

A. In our experience it was worthless, and could not be carried on without loss. A durable substantial article could not be made under that patent, as described in the patent.

Q. Then what would you say as to the invention described in the patent?

Objected to.

A. I should say that it was, so far as utility is concerned, or as a profitable invention to manufacture, worthless.

The tubular iron as constructed by Isaac N. Topliff was a long narrow tube *soldered* along the edges. (*Record, pp. 28 and 64.*) This was found not to be strong enough. Locking the edges was suggested, but no machinery could be found that would lock a long seam in a tube of such narrow diameter. John A. Topliff obviated this difficulty by inventing a machine which successfully locked the seam. (*Record p. 57.*) Still the device was not a success. The object of the invention was to furnish a bow that would be strong, and overcome the tendency of the back bow to break where it came in contact with the back prop of a buggy when the calash cover was lowered, but it was found that the tubular bow readily broke, and when broken was useless, as it did not admit of repair as a wooden bow does.

(*Testimony of Geo. H. Ely, Record p. 64.*)

A. The bow socket as made previously to the adoption of the invention of John A. Topliff, of itself was not strong enough to stand ordinary use. The back tubes would break where they struck the prop, and it was necessary either to make a stronger tube, or that a bow should be used strong enough to make the combined bow and tube of sufficient strength to stand.

The scalloped socket used by Isaac N. Topliff for attaching together the lower ends of the tubular bows was found to be an infringement of a prior patent and the firm being sued for infringement, they discontinued the use of the bow socket (*Record pp. 25 and 42.*) and inserted the ordinary kind of slat iron into the open end of the tubular bow.

(*Testimony of John A. Topliff, Record p. 25.*)

Q. You may state whether or not the plates, such as were described in his patent of 1870, were substantially like or substantially different from slat irons that were in common use and as you used them.

A. There was one kind of slat iron that was what was called the Bidwell patent. Mr. Bidwell, of New Haven, Conn., had a patent on that slat iron, and he, or the man that owned the patent, finally sued us for using it, and we settled on account of that. He sued us in court and we settled it.

* * * * * * *

Q. And what did you substitute for these plates described in that patent?

A. We commenced substituting what you might call a malleable slat iron—a little slat iron that was

cast and made malleable and slipped up in here (indicating) and soldered to this tube. (*Page 23.*)

(*Testimony of Isaac N. Topliff, Record p. 42.*)

Q. The plates described in that patent to be used in combination with the tubes were plates that you subsequently found to be covered by another patent, were they not?

Objected to.

A. Yes, sir.

Q. Whose patent?

Objected to.

A. I think the Bidwell patent covered that, or a portion of it.

This was done with Isaac's consent. (*Record pp. 57 and 23.*) In order to strengthen the bow they also provided loose strips of steel which they sent out with their tubular bows, instructing carriage makers to slit the wooden portion of the bow and insert one of these steel strips into the wood before inserting it into the tubular portion of the bow. Still, however, the bows broke or bent where the steel terminated.

(*Testimony of John A. Topliff, Record pp. 16-17.*)

Q. You may state whether prior to this time you had furnished steel slips, and in what way to be used.

A. We had furnished steel slips, cut, and wrapped up six in a bundle, tucked into one of the bow socket tubes, to go with each box or three sets of bow sockets. In each box we put directions for the carriage maker, when he fitted his bows that they should be fitted well, running clear down to the slat iron, and when fitted, he should take a saw and split the back bow and insert the steel into the slit that he makes in the back bow, and

then drive them into the bow socket with white lead or some other pasty substance.

Q. Then this slip which you furnished and to be driven into a slit made in the wooden bow, was not fastened in any way or welded to the bow socket or slat iron?

A. It was not.

Q. Using such slips, if anywhere, where would the weakness or bending of this bow socket occur in practical use?

A. Between where the steel strip ended and the slat iron.

Q. How serious was that difficulty or liability to bend at that point before the slips were welded according to your invention?

A. It was almost in every case, especially if the top had a hard usage, or a reasonably hard usage.

Q. You may state whether or not the bows made up with the slips not welded to the slat iron were practical or useful, or capable of success as a manufacture.

A. They were not practical, not useful, compared with the strength of an ordinary wood bow with a slat iron covered with leather in the old style; and of course it would not be manufactured successfully if they lacked in strength, which they did.

(*Testimony of Geo. H. Ely, Record p. 58.*)

Q. What was the next point of change?

A. I cannot say in order of time, but while these changes were being made, or after the changes I have spoken of had been made, it was found that the back tube of the bow sockets broke, and we sent out with the bow sockets plates of steel for the carriage makers to strengthen their bows with, so that the bow would have strength enough to enable the tube to stand when put in use where it would be before broken.

Q. Where were these strips of steel to be used?

A. They were to be inserted in the bows by the carriage makers, and then the bow inserted into the tube.

Q. What came next?

A. That proving a failure, in that the tubes continued to break where this steel plate would end, John A. Topliff invented the combination of the slat iron and the steel; that is of welding the steel into the slat iron and strengthening the tube, so that the tube itself would be strong, regardless of the bow.

Q. That was the invention covered by his patent?

A. Yes, sir.

* * * * * *

(*Same, p. 64.*)

Q. How early did you commence the use of the steel to strengthen the bow sockets?

A. About the close of the year 1872 we used the steel to strengthen the bow socket. Previously to that we had sent out steels to strengthen the bow.

Q. Will you explain precisely the difference between the strengthening of the bow and the strengthening of the bow socket, as referred to in your last answer?

A. The bow socket, as made previously to the adoption of the invention of John A. Topliff, of itself was not strong enough to stand ordinary use. The back tubes would break where they struck the prop, and it was necessary either to make a stronger tube, or that a bow should be used strong enough to make the combined bow and tube of sufficient strength to stand. The steel plates were sent out as described in the patent of I. N. Topliff, of May, 1871, to strengthen these bows, so that the bow would be strong enough if the tube was not. This did not obviate the difficulty, as it left a weak point at the end of this steel, between the end of the steel and the slat iron. So John A. Topliff devised a means of strengthening the tube so that this should be strong regardless of the bow,

whether the bow was made of basswood or whatever it might be made of.

Q. You first sent out a steel with the expectation that the carriage maker would insert it in the bow?

A. We did.

This was the condition of things when the patent to Isaac N. Topliff was granted on the 27th of December, 1870.

ISAAC N. TOPLIFF'S PATENT OF DECEMBER 27TH, 1870.

It here becomes important to ascertain what was covered by this patent.

As before stated, the application had been rejected in November, 1869, and on the 1st of October, 1870, Isaac N. Topliff withdrew his claims as filed, abandoning his claim to the combination of the tubular sheet metal bow and wooden bow, and made the following single claim: (*Record p. 34.*)

"The straight part of the bow A, tubular and flat-
"tened at the lower end; the bow socket D, consisting
"of two concave scalloped pieces, and bent part of the
"bow B, all combined, constructed and arranged as
"and for the purposes set forth."

This claim is for a combination of parts, constructed and arranged as described, and did not cover any of these parts separately, nor when constructed or arranged in any manner substantially different to that

described in the specification ; moreover, by withdrawing his claim to a combination of a tubular iron with the wooden part of the bow, the patentee deprived himself of the right of ever thereafter making such a claim. *Leggett vs. Avery, 101 U. S., 256.*

It is clear, therefore, that at the time when the patent, which forms the consideration for the contract, was granted, the complainants, Topliff & Ely, were manufacturing a carriage bow which was not in any respect covered by the patent, and that they had been led to abandon the invention covered by the patent, first, because the article manufactured, as described therein, proved a failure, (*Brief, ante, p.* 13,) but secondly and chiefly, because they could not any longer continue to manufacture the combination of devices covered by the patent, for the reason that one of the elements of the combination was the scalloped bow-socket, the use of which they were compelled to discontinue on being sued for infringement of a prior patent on that device. As we have already stated, this change, which involved the abandonment of the patented combination was known and assented to by Isaac N. Topliff. (*Brief ante, pp.* 14–17.)

That the complainants' carriage bow, as made by them after the issue of the patent, (like Exhibit F,) was not covered by the claim of the patent is manifest when we consider that the combination therein claimed, consisted of the following three elements :

1. The straight part of the bow, tubular and flattened at the lower end,

2. The bow socket, consisting of two concave scalloped pieces.

3. The bent part of the bow, made of wood.

The specifications, moreover, contained the following further limitations: (*Record, p.* 28.)

1. That the straight part of the bow should be made of sheet iron or other suitable sheet metal, with a soldered seam.

2. That the bow socket should also be made of sheet metal of two concave pieces with their edges soldered together and their concave sides facing each other, and having scalloped upper edges.

By the very form of the claim the individual elements are admitted to be old, because not separately claimed.

Keystone Bridge Co. vs. Phœnix Iron Co., 95 U. S., 274.

Miller vs. Brass Company, 104 U. S., 350.

The complainants, Topliff & Ely, having been obliged to abandon the use of the bow socket, substituted the old style of slat iron, to do which they had to abandon the flattening of the lower end of the tubular iron, which is a feature expressed in the claim of the patent. And in making this substitution of the old style of slat iron in the place of the scalloped bow socket described in the defendant's patent, the complainants practically adopted the inven-

tion described and claimed in the application of Ferdinand Selle, which, as we have already shown, was forfeited, and had become public property by reason of the non-payment of the patent fee. (*Record p. 31.*)

It appears, therefore, that at no time after the patent was granted in December, 1870, did the complainants manufacture or sell carriage bows which were covered by that patent, and that, without any fault on their part, the tubular carriage bows manufactured by the complainants continued to prove a failure until John A. Topliff, one of the complainants, made an improvement which overcame all the difficulties and caused the further manufacture to prove a great success. (*Record pp. 15, 17 and 58.*) For this improvement the patent now in suit was granted to John A. Topliff on the 24th of August, 1875.

It is true, as claimed in the answer and shown in the evidence, that the complainants continued to pay royalty to the defendant according to the terms of this contract until about April 1, 1879, having been making and selling since early in the year 1873, only carriage bows made under the John A. Topliff patent. This they did under the erroneous belief induced by the representations of the defendant that his patent was for the *tubular iron* as a separate device and covered its use and protected them in that manufacture. (*Record p. 66.*)

During this period the complainants paid the defendant upwards of $40,000 as royalty under a worthless patent for the making of articles which were not covered by that patent at all. (*Record p. 59.*)

RESCISSION OF THE CONTRACT.

In the summer of 1879, a dispute arising between the parties on some point under the contract, then for the first time the complainants discovered that Isaac's patent of 1870, covered nothing but a particular combination of devices which had long before proved a failure and which they had been compelled to abandon. (*Record, p. 59.*)

They at once sought counsel and were advised by Judge Ranney (*see Judge Ranney's letter, Record, p. 69.*) that they were paying royalty on a patent which was void in itself, and did not cover their manufacture and that they were not legally obliged to pay any royalty at all. This led them to examine the patent of Isaac N. Topliff and the proceedings at the patent office as contained in the file wrapper of his application; and the result was, that acting under legal advice, they, sometime in September, 1879, notified Isaac N. Topliff that his patent was invalid, that it did not cover their manufacture and that they regarded the contract as of no binding force. This notice was based upon the ground that the patent was invalid for want of novelty,

and that it did not cover the tubular iron as a separate device, which they had supposed it did.

(*Testimony of John A. Topliff. Record, pp. 23-4.*)

Q. A question was put to you in relation to your paying royalties. You may state about that. You have paid royalties, as I understand you, from about the time the contract was made down to what year?

A. 1879, I think.

Q. Under what circumstances did you continue to pay royalties?

A. We paid royalty from the fact that we supposed that we were working under his original patent; we did not know to the contrary. * * * until we finally received the file wrappers from Washington, informing us to the contrary, and when we received them, together with the patent, we found out that we were not working under his patent and refused to pay further royalty.

(*Testimony of Geo. H. Ely. Record, p. 59.*)

Q. You may state at what time you discovered that the patent of 1870, which was the basis of your contract with the defendant, covered nothing but a combination that you had abandoned?

Objected to.

A. The first remembrance that I have of our knowing that was in August, 1879.

Q. Up to that time about how much royalty had you paid the defendant?

A. About $40,000.

Q. How did you make this discovery?

A. We sent to Washington for copies of the patent, and on examining it found what it was.

Objected to.

Q. Did you, at the same time, get a copy of the file wrapper?

A. At about that time. In the month of August or September we obtained copies of the file wrappers of the patent of 1870.

Q. What followed that, so far as your having interviews was concerned?

Question objected to.

A. We took counsel then to find out what our position was—whether we were under any obligations to Isaac N. Topliff under the contract which had been subsisting between us, and after obtaining legal opinions we presented the legal opinions to him, a little before the middle of September, or about the middle of September, 1879, and after reading him the opinion that we had obtained from Judge Ranney told him that that opinion was our position, and that we should take the position as given us in that opinion, and, in carrying out that position, told him that we considered that the contract which had been made between us null and void, as we were not manufacturing the article named in the patent.

Answer objected to.

The opinion referred to by the witness is offered in evidence by the complainants, and is hereto attached, marked "Exhibit No. 1 to deposition of George H. Ely." Objected to by defendant's counsel.

Q. You may state if, after that, you refused to pay any more royalty.

A. Yes, sir.

(*Same, p. 62.*)

Q. You may state whether your contract with the defendant, dated December, 1870, has been at any time subsisting between you and the defendant since the interview you had with him in 1879, which you have before set forth.

A. At that interview we informed him that the patent was null and void, and we never have retracted or modified that statement in any way, and have acted

in accordance with the position taken at that time ever since.

Q. Has there been any contract subsisting between you since then?

A. No, sir.

Q. You may state whether at that interview you told him, in addition to what was contained in the opinion you read to him, that you had no longer any mutual rights to use the patent.

A. We did so state to him; yes, sir.

Q. And whether you stated that the contract was at an end between you.

A. We stated that the contract was at an end between us.

When the complainants had so notified Isaac N. Topliff of their rescission of this contract, he at once signified his assent thereto by assuming sole ownership and control of his patent of December 27, 1870, by surrendering the same for cancellation and asking for a re-issue, which was granted on January 6, 1880, and thus, as we contend, gave his full assent to the rescission, as otherwise he would have had no right whatever to surrender a patent in which he had given the complainants an exclusive license.

REISSUE OF THE PATENT OF DECEMBER 27TH, 1870.

When we come to examine the file wrapper and contents of this reissue application, we shall see that Isaac N. Topliff not only assented to the fact that his original patent was invalid, but that he also took

action, based on the repudiation by Topliff & Ely of their contract with him, which, in the most significant way possible, expressed his assent to its recission; and all this almost immediately after the notice of September, 1879.

As to the first point, we find (*Record p. 74,*) that Isaac N. Topliff files an affidavit with his application for a re issue, in which he avers that "he verily believes that by reason of an insufficient or defective specification his aforesaid letters patent are inoperative or invalid." He bases his claim for reissue on such invalidity, and this invalidity taints the patent from its inception: it was always invalid and could not legally form the basis of any right in the defendant under the contract. Had the parties agreed to attempt to correct this invalidity by reissue, the case might be different, but such is not the case at all. The defendant, without the knowledge of complainants, and without their consent, expressed or implied, surrendered the patent for cancellation.

(*Testsmony of Geo. H. Ely, Record pp. 60-61.*)

Q. Did you or your partner, to your knowledge, ever give any consent to the obtaining of such reissue?

A. We neitner of us gave any consent, or were aware that any reissue was to be obtained until it had been granted.

Q. When did that knowledge come to you?

A. In December, 1879, or January, 1880, I could not say which.

As to the other point, we have also in the same proceeding (*Record p. 74.*) and in the same affidavit, the sworn statement of Isaac N. Topliff, "That *he is the sole owner* of said letters patent." This was true if the complainants had repudiated the agreement under which they were to have the exclusive right to said invention under said original patent, and the defendant could hardly have more plainly or emphatically declared his assent to the repudiation and rescission of that contract, than by his assertion of the exclusive title to and control or that patent.

He certainly had no moral or equitable right to surrender and deliver up for cancellation a patent, the exclusive right to the use of which he had granted to others from whom he had been receiving large sums of money for royalty, unless he did so on the ground that they had repudiated the contract and refused to make any further claim therein, or to pay any further royalty thereunder, and that he had assented thereto. He must have considered the contract at an end, and his right to the patent thereby restored to him, or he had no right to surrender the patent without the assent of the parties to whom he had given such extensive rights, and from he had been receiving, and expected still to receive, so large a royalty.

Undoubtedly the surrender of the original patent by the patentee destroyed it, as the foundation of any claim whatever thereunder from the date of the reissue.

This point was expressly decided by this court in the case of *Moffitt vs. Gaar, 1 Black, 283,* in which the court say :

"A surrender of a patent to the commissioner "means an act, which, in judgment of law, extinguishes "the patent. It is a legal cancellation of it, and hence "can no more be the foundation for the assertion of a "right after the surrender, than could an act of con- "gress which has been repealed."

See also *Reedy vs. Scott, 23 Wall, 352-364.*

Fry vs. Quinlan, 13 Blatch, 205.

In a more recent case of *Peck vs. Collins, 103 U. S., 664,* this court, citing the case of *Moffitt vs. Gaar,* say : "Since the decision of this case, it has been uniformly held, that if a reissue is granted the patentee has no rights except such as grow out of the reissued patent. He has none under the original. That is extinguished." In the case of *Peck vs. Collins,* the suit was between an assignee under the original patent, and a party to whom he had agreed to sell an interest. The patentee had applied for a reissue, which was not granted, and the original patent, instead of being cancelled, was returned to the assignee by the patent office. The supreme court held that the patent having been surrendered for reissue was thereby extinguished, as against the assignee, although not actually cancelled, and although the application for reissue had been made by the patentee and not by the assignee. This we sub-

mit as conclusive against any claim under the original patent. But more than this, we contend that the surrender of the patent by the patentee, accompanied by an oath that he was then the sole owner thereof, was an assertion of a right based upon the rescission of the contract with the complainants, Topliff & Ely, at the date when they notified him that they could no longer be held bound, on account of the invalidity of the patent.

It is clear, therefore, that by the act of surrender and reissue of the original patent, without the assent or knowledge of the complainants, the defendant destroyed the rights which he had assumed to confer on them under the original patent, and for which they had agreed to pay a very large royalty, and it remains to be seen whether the reissued patent which he obtained in its stead was valid, and if, as we shall show, it was not, then it is apparent that the consideration of the agreement between him and the complainants was taken away and destroyed by the act of the defendant, which was justifiable only on the ground that the agreement had been rescinded by mutual consent.

INVALIDITY OF THE REISSUE.

In the original patent there was no claim for the tubular iron or for the concave scalloped socket as specific devices, or otherwise than in combination, and when so claimed they are both *ipso facto* admitted to be

old devices. On this point this court says: (*Brown vs. Selby, 23 Wall, 181-224.*)

"The summary of the patentee's claim annexed to "the specification admits that all that is not included "is old. This is equally true of combinations; claim-"ing a combination is an implied declaration, as con-"clusive, so far as that patent is concerned, as if it "were expressed that the specific combination, or thing "claimed, is the only part which the patentee regards "as new."

See also *Keystone Bridge Co. vs. Phœnix Co., 95 U. S., 274-279.*

See also the leading case of *Miller vs. The Brass Co., 104 U. S., 350*, where this court says at p. 352:

"It must be remembered that the claim of a spe-"cific device or combination, and an omission to claim "other devices or combinations apparent on the face "of the patent, are in law a dedication to the public of "that which is not claimed. It is a declaration that "that which is not claimed is either not the patentee's "invention, or if his, he dedicates it to the public."

Now, the claim in the original patent is for a combination of the tubular iron and the scalloped socket. Neither of these parts was claimed to be new. Although the scalloped socket was not separately claimed, its use, whether in combination with another device or not, would be an infringement on a prior device, and omitting it from the claim would not make the reissue any

more valid than the original; but by the omission of the scalloped socket from the claim, and claiming the tubular bow separately, as is done in the first claim of the reissue, the reissue is not only very seriously broadened in its scope, but it is for a different invention from the original, and is therefore void; and this whether the inventor might have claimed in the original what he afterwards claimed in the re-issue or not.

That the omission of one of the elements of a combination from the claim in a re-issue broadens the patent and renders the re-issue void, has been decided in many recent cases by this court.

In the case of *Gage vs. Herring, 107 U. S., 640*, the patent was for a device for cooling flour on its passage from the grindstones to the bolts, consisting of a suction fan and spout, a meal chest, conveyor, fan and elevator. There was also a second meal chest and shaft which connected with the same fan and elevator and by which any meal dust which escaped from the first chest was carried to the fan and elevator. The claim of the original covered two meal chests, two shafts and the elevator, fan and spout. The re-issue claimed one meal chest, one shaft and the elevator, fan and spout, thus omitting the second meal chest and shaft, which were not essential to the operation of the machine, and the court held the re-issued claim to be void.

In the case of *Turrell vs. Bradford, 15 Fed. Rep., 808*, it was held that those who do not use the entire com-

bination of the original patent do not infringe, although the re-issue claimed sub-combinations which were used by the defendant.

The case of *Bantz vs. Frantz, 105 U. S., 160*, decided by this court in 1882, is so exactly in point that we will make a few extracts from the opinion. The patent was granted in 1858, re-issued in 1872, and extended in the same year. The court says, at page 163-5 :

"We are clearly of opinion that the reissued patent "is void. It is evident, on a cursory reading of the "specification and claim of the original patent, that it "was meant to cover a *combination* of the several con- "trivances therein described, and not to cover the "several parts of the former, as distinct inventions. "No claim is made for the several parts of which the "former is constructed. * * * * * "If the reissued patent is valid, the appellant could "maintain an action against any person who infringed "any one of the separate claims covered by it. Under "the original patent, suit could be maintained only "against those who employed the *combination*, em- "bracing all the distinctive contrivances described in "the reissued patent. The re-issue is, therefore, broader "than the original patent, and is, under the circum- "stances of the case, void."

The court then quotes the *53d section* of the act of congress of July 8, 1870, under which the patent was issued, and which is the same as *section 4916* of the

revised statutes (as stated by the court in the cited case,) under which the Topliff re-issue was granted. The court then proceeds:

"In this case the original patent bore date June 22, "1858. The re-issue bore date February 6, 1872, "more than thirteen years and six months after the "date of the original patent, and less than five "months before its expiration. If the specification in "the original patent was defective or insufficient in "claiming a combination of several devices instead of "making a distinct claim for every device which en- "tered into the combination, the fact was instantly dis- "cernible, even to an unpracticed eye, as soon as the "patent was read. Therefore, as said by Justice Brad- "ley in a similar case, Miller vs. The Bridgeport Brass "Co., decided at the present term, if any correction "was desired it should be applied for immediately. "The right to have the correction made was abandoned "and lost by unreasonable delay. The case referred to "is apposite and conclusive of this,"

The cited case of *Miller vs. The Brass Co., 104 U. S. 350*, has been followed in a great number of cases decided in the year 1882 and subsequently, and is now the accepted rule of decision in regard to re-issues. See *Mathews vs. Machine Co., 105 U. S., 54. Wollensak vs. Reiher, 115 U. S., 96.*

If then, as we have shown, the granting of the re-issue proves the invalidity of the original, and the two

facts that the re-issue is broader than the original, and that there was unnecessary delay in applying for the re-issue, make the re-issue void, then the whole ground is covered, and it is needless to inquire whether the original was valid before the re-issue, or whether the re-issue might have been valid if applied for within a reasonable time after the grant of the original.

As to what is such reasonable time, the case of *Miller vs. Brass Co., ubi supra*, is conclusive. In that case this court held that where the re-issue broadened the claim a delay of over two years took away the right to re-issue, and rendered the re-issued patent void; and in *Jones vs. Barker, 11 Fed. Rep. 597*, Judge Lowell says that anything like two years' delay would be inadmissable in ordinary cases.

And the court says in the *Brass Co. case, supra*, that "in reference to re-issues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied."

Numerous cases might be cited, both in the supreme court and circuit courts of the United States, in which re-issued patents, which would have been perfectly valid if the original had been surrendered and the re-issue applied for within two years from the date of the former, were declared invalid simply by reason of lapse of time in applying for re-issues.

In the case at bar, the original patent was granted December 27, 1870, (*Record p.* 28,) and the re-issues

applied for October 18th, 1879, (*Record p. 70,*) an interval of *nearly nine years.*

It is clear, therefore, we submit, that the re-issue was invalid and utterly worthless to secure any exclusive rights to the complainants, unless it comes within the exception stated by this court in the case of *Gage vs. Herring*, before cited, on the point that "the invalidity of a new claim in the re-issue does not impair the validity of the original claim which is repeated and separately stated in the re-issued patent."

As we have already shown when citing this case, (*supra*) it decides that the omission of some of the elements of the claim of the original patent broadens the re-issue and renders it void. This is the case as to all of the prior claims of the defendant's re-issue.

The claim of defendant's original patent (*Record, p,* 28,) is for three elements "all combined, constructed and arranged as and for the purposes set forth."

These three elements are :

1. The straight part of the bow A, tubular and flattened at the lower end.

2. The bow socket D, consisting of two concave scallopped pieces.

3. The bent part of the bow B.

Now the re-issue has *four* claims, (*Record, p. 71,*) all but the first being for combinations, but not one of them contains as an element of the combination "the bow socket D, consisting of two concave scalloped

pieces." The last claim of the re-issue mentions "a socket," but not as an element of the combination at all; the claim being:

"A carriage bow consisting of bent wooden section "B, and the tubular sections A, A, the latter consti- "tuting the straight or vertical sides of the bow, and "constructed at their lower ends to be attached to a "socket or carriage seat, substantially as set forth."

So that not only is the socket left out of the combination but the limitation in the claim of the original patent, that the tubular part A shall be flattened at the lower end, is also omitted.

This case of *Gage vs. Herring* clearly demonstrates the invalidity of the defendant's re-issued patent.

We have already seen that the evidence in the case establishes that the complainants are the owners of the letters patent described in the bill and that the defendant has infringed that patent, unless it shall appear that the complainants have granted him the right to use their invention under and by virtue of the clause in the contract that "any improvement made on these articles shall be for the mutual benefit of the parties."

We deny that any such right was granted to the defendant, or if we are wrong in this, then we contend that the contract was legally rescinded by complainants with the assent of the defendant. If we are right on either point, then the court below erred in dismissing complainants' bill.

DEFENDANT'S RIGHT TO USE COMPLAINANTS' INVENTION.

We contend that the court erred in holding that the contract set up in the defendants answer conferred a right upon the defendant to use the complainants' invention.

Assuming for argument's sake that the contract was alive and in force when this suit was begun, then our contention is that the terms of this contract did not confer upon the defendant any right to use the invention described in John A. Topliff's patent of August 24th, 1875.

The clause in the contract upon which this claim of a right to use our invention is in these words: "It is also further agreed that any improvement made on these articles by either party shall be for the mutual benefit of the parties." (*Record p. 11.*)

It will be noticed that the contract alleges that Isaac is "the sole owner of a certain patent for tubular iron bows," and then follows the granting clause giving to complainants "the exclusive right of manufacturing and selling the above mentioned articles," after which comes the clause under discussion which speaks of "any improvement made on these articles," all referring to the "tubular iron bows" described in the "certain patent" of which Isaac was sole owner.

Now "the article" referred to in the agreement

and the article which the complainants have been making under the John A. Topliff patent, are not the same articles. If the Isaac N. Topliff patent had covered all carriage bows having tubular metallic side pieces, as the defendant at the time of making the contract represented it did, and as the complainants were led to believe it did, then the John A. Topliff patent might have been considered as an improvement thereon. But as we have seen, such is not the case. The "article" described in Isaac's (the defendant) patent of 1870 was a carriage bow having tubular metallic side pieces flattened at the end and fitted into a socket composed of two scalloped pieces of sheet iron. Now, no carriage bow which does not have these two elements can be the same article, or an improvement on the same article, as that which was patented under Isaac's (the defendant) patent. The removal of the scalloped bow sockets destroys the identity of the article as effectually as the substitution of a solid metallic or non-metallic bow would do.

On this point then we submit that there was error in the holding of the court below that the defendant had the right to use the complainants' invention whether with or without the payment of royalty.

THE CONTRACT NOT IN FORCE.

We also contend that the court below erred in holding that the contract was a subsisting contract and binding upon the parties at the time of the commission of the acts of infringement complained of, and this contention of the complainants is based upon the facts which appear in the record in this case.

We have shown by the testimony of the parties, and by the phraseology of the contract, itself, that the consideration of that contract was the exclusive right to use a patent, which had been applied for and not yet issued, for an invention made by the defendant for tubular iron bows. (*Brief ante p.* 11.)

We have shown that the defendant represented to the complainants that the invention, not yet patented, consisted of "a tubular iron for the support of a buggy top, to take the place of the straight part of the wooden bow." (*Record p. 54.*)

We have shown that the defendant, without the knowledge or consent of complainants, had abandoned and withdrawn from the patent office any claim he might have for the tubular iron as a separate device, and had accepted in lieu thereof a patent for a mere combination of particular devices, which in itself not only had no utility, and was of no practical value, and the manufacture thereof was abandoned with the knowledge and consent of defendant, but was legally

invalid because it infringed a prior patent. (*Brief ante p.* 12–20.)

And finally, we have shown that the complainants, the moment they discovered these facts, under the advice of counsel, notified the defendant that they regarded the contract as no longer binding on them, and repudiated it on the ground that the defendant, by his misrepresentations, had practiced a fraud on them, and inasmuch as the patent device was a failure and its manufacture compelled to be abandoned, that the entire consideration was false and a nullity. (*Brief ante p.* 24.)

Now we submit as well settled rules of law:

I. That a party to a contract which is founded on a consideration that is wholly false or a mere nullity, has an absolute right to rescind that contract, and that upon his giving proper notice of such rescission to the other party, such contract will be no longer binding.

See *1 Parsons on contracts, (5 Ed.) p. 462.*

In *Nash vs. Lull, 102 Mass., 60*, which was a suit on a promissory note, the only consideration for which was the grant of a right under a patent, the court held that the question of consideration depended on the *validity of the patent.*

If the patent was void the note was without consideration and no recovery could be had.

Harlow vs. Putnam, 124 Mass., 553, the plaintiff gave defendants an exclusive license under plaintiff's

patent for one year, and an agreement to convey the patent to the defendants at the end of the year for an agreed sum, the defendants agreeing to pay plaintiff a certain sum monthly during the year, the same to be applied on the agreed price if at the end of the year the defendants concluded to buy the patent, but otherwise to be regarded as payment for the license. Before the second monthly payment fell due the defendants discovered that the patent was invalid and refused to make further payment for that reason, and notified plaintiff that they no longer regarded the agreement as binding. In a suit for the monthly payment the court held:

"The only consideration for the promise of the "defendants was a right under the patent. The patent "being void, the license gave no rights which the "defendants had not before, and the assignment if "made, would not have conveyed any, because the "patent gave none to its owner. The case is, there-"fore, within the principle repeatedly declared by this "court that the grant of an interest in or a right under "a void patent is not a valid consideration for a "promise by the grantee."

"By the notice to the plaintiff the defendants aban-"doned all benefit of the license and left it open to the "plaintiff to test his title to the invention by suit "against them for infringement."

Also, see *Bliss vs. Negus, 8 Mass., 46.*

Dickinson vs. Hall, 14 Pick., 217.
Bierce vs. Stocky, 11 Gray, 174.
Lester vs. Palmer, 4 Allen, 145.
Howe vs. Richards, 102 Mass., 64.
Jackson vs. Allen, 120 Mass., 64.
Jenkins vs. Abbott, 54 N. H., 447.
Joliffs vs. Collins, 21 Mo., 338.
Cragin vs. Fowler, 34 Vt., 326.

II. That when a contract is entered into by one party under the inducement of a false representation made by the other party, the former will be entitled to consider the contract at an end on discovering the fraud.

This is an elementary principle and needs no authority to establish it. If the facts be as we have shown, the defendant's right to rescind the contract was perfect the moment they discovered the fraud and this court in *Pence vs. Langdon*, (*99 U. S., p. 578*,) recognizes and enforces the soundness of this doctrine.

In the case at bar the proof is that the plaintiffs had not the slightest knowledge or suspicion of the invalidity or defects of the original patent until September, 1879. They then took prompt and decided action by at once notifying the defendant of their repudiation of the contract.

III. Where the consideration of a contract is an entirety, the whole contract based on that consideration must be held to be an entire one, and when that con-

sideration is a nullity or fails, the contract in all its parts must fail too. There is nothing left which will bind the promisor.

2 Parsons on Cont. (5 Ed.) p. 519.

In our case, as we have seen, the consideration of the contract was an entire thing, viz.: an exclusive right under the patent of 1870. This failed because the patent was wholly invalid, and because it did not cover the device it was represented to cover. There was and could be no apportionment of this consideration to the different parts of this contract, to-wit: To pay royalty, to share expenses of litigation, and the use of improvements. These several promises are all founded on the one consideration, which is expressed to be the exclusive right under the patent of 1870, which patent turns out to be invalid.

In *Chanter vs. Leese, 5 M. & W.*, 698, in the case of a sale of six patents for one consideration, five of which were valid and one void, it was held that there had been an entire failure of consideration on the ground that the amount agreed to be paid had not been apportioned by the contract to the different parts of the consideration. The court says:

"We see, therefore, that the consideration is entire "and the payment agreed to be made is entire, and we "see also a failure of the consideration, which being "entire, by *failing partially, fails entirely, and it follows* "*that no action can be maintained.*"

The court further stated that if the five valid patents had been enjoyed, they were of the opinion that no action could be maintained *on the agreement.*

In our case the defendant claims a right under one of the provisions of an agreement, the consideration of which was an entirety, and this had, not merely partially, but wholly failed, and had carried down with it not any one particular provision, but every provision in that contract. The whole contract was thus destroyed.

THE DEFENDANT'S ASSENT TO THE RESCISSION OF THE CONTRACT.

As the only real defense in this case rests upon the contract of 1870, set up in the answer of the defendant, it becomes important to consider whether that contract was in existence and binding on the respective parties thereto at and subsequently to the time when the alleged infringement occurred.

The defendant's admission of infringement is that he was manufacturing the bow socket marked Exhibit 6, at the commencement of this action, (Record, page 26,) that is at the date of the 28th of February, 1880, when this suit was begun.

Now it so happens that this very question has been already determined by a court of competent jurisdiction, to-wit: The court of common pleas, of Lorain county, Ohio, and that the judgment of said conrt has

since been affirmed by the supreme court of that state, to-wit: *That the action of the appellee (Isaac Topliff) touching the re-issue estops him from claiming that the articles made after the notice of September 13, 1879, were made under said contract.*

In order that the effect of that decision upon the present case may be understood it will be necessary to make a statement of facts which may involve, to some extent, a repetition of what has been already stated in this brief.

Cross suits were brought in the court of common pleas of Lorain county, Ohio, by the parties to this appeal against each other. Topliff & Ely sued Isaac Topliff to recover back royalties paid by them under the contract of 1869 (set up in this case by defendant) on the ground that the patent was void. The court held that they could not recover back such payments voluntarily made. Isaac (the appellee here) then sued Topliff & Ely (the appellants) for royalties under said contract from April 1, 1879, up to the date of the action. The defendants to that action set up the rescission of the contract and the invalidity of the patent and of its re-issue. The trial court gave judgment in favor of the plaintiff (Isaac) for royalties only up to the 13th of September, 1879, (the date when Topliff & Ely gave notice to Isaac that his patent was invalid and that they were no longer bound under the contract and would pay no more royalty.)

From both of these judgments writs of error were taken to the supreme court of the state where it was held that :

1. Both of these judgments were right.

2. The contract gave royalties upon articles made under the patents of 1871 and 1875 as well as that of 1870.

3. Under the contract and conduct of the parties the invalidity of the patent of 1870, and its re-issue were immaterial as to the royalties accrued *before* the notice of September 13, 1879.

* * * * * * * * *

5. *Isaac's action touching the re-issue estops him from claiming that articles made after the notice of September 13, 1879, were made under said contract.*

The opinion of the supreme court as reported in 41 Ohio State Reports, page 359, is printed as an appendix to this brief.

The court expressly declines to decide anything as to the rights or interests of the parties under the patents of 1871 and 1875. This was probably because they regarded that question as one of which the federal court had exclusive jurisdiction, and at any rate it was not necessary to the decision of the points raised by the writs of error in the cases before them.

We assume that we have a right to refer to this decision as determining the rights of the parties to this suit under the contract referred to and set up as a

defense in this suit, for the reason that if the contract of 1869 was rescinded on September 13, 1879, and ceased to be binding on the parties thereto after that date, then the only defense to the allegation of infringement in this case fails; and for the further reason that it was competent for the state court to decide, as it did decide, that Isaac (the appellee in this suit) was estopped "from claiming that articles made after the notice of September 13, 1879, were made under said contract;" and further, that although the decision of the supreme court of Ohio was rendered subsequently to the trial of this case in the U. S. circuit court, yet it is a mere affirmance of the judgment of the trial court of the state, which judgment was before the circuit judge at the hearing of this case. (*Record, page 60.*)

If, however, this court should be of the opinion that we have no right to rely on the decision of the supreme court of Ohio, as fixing the rights of this appellee and these appellants under said contract, then we beg leave to refer to that decision in the cases *Ely et al. vs. Topliff*, and *Topliff vs. Ely et al.; 41 Ohio State, 359*, as an authority in a case not only similar to that before this court, but so far as the point in issue is concerned, *precisely the same.*

What then is the effect of that decision upon the case presented in this appeal? It is based as we have seen upon the finding that the contract under which the appellee here defends was rescinded by the notice

given to him by the appellants on September 13, 1879, and expressly holds that he is estopped from claiming that the articles made after that date were made under the contract.

Now, as the articles made by appellee after that date include the articles like "*Exhibit 6*," it follows as a necessary corollary, that they are not made under the protection of that contract, and consequently that the appellee cannot defend *his* manufacture of such articles made in conformity with the patent in suit by reason of the contract of 1870.

The supreme court of Ohio say that this estoppel arises from the conduct of Isaac (the appellee) in relation to the re-issue of his patent of 1870. We have already seen what that conduct was and need not refer to it again in detail; suffice it to say that when notified by the appellants in September, 1879, that his patent was invalid, and did not cover what they had contemplated, and that they would no longer be bound by the contract, the appellee (Isaac) immediately assumed the *exclusive ownership* of his patent and surrendered it for re-issue without the knowledge or assent of the appellants, making oath that he was the *sole owner* thereof. (Record, page 74.) By this act of surrender he destroyed the original patent, which thereby became a nullity, and obtained a re-issued patent which was worthless, as we have already shown. We do not dispute his right to do this if the contract of 1870 was

Claims of Original Application.

1. The upright part of carriage bows, constructed of tubular sheet metal A, in construction [combination] with the wooden bow B, put together in the manner for the purposes set forth and described.

2. The tube A, with elongated flat portion *c*, to form a solid joint with the bow socket D in the manner described.

3. The scallop-edged sheet iron bow socket D to be used in connection with the tubes A and A′, in the manner described.

Original Patent, December 27, 1870.

CLAIM: The straight part of the bow A, tubular and flattened at the lower end, the bow socket D, consisting of two concave scalloped pieces, and the bent part of the bow B, all combined, constructed and arranged as and for the purposes set forth.

Reissue January 6, 1880.

1. A carriage bow, the side or upright portions A A, of which are tubular, substantially as and for the purpose shown.

2. A carriage bow, consisting of the bent wooden section B and the tubular sections A A, the latter constituting the vertical sides or arms of the bow, the opposite ends of the bent portion B being secured to the upper ends of the tubular sections A A, substantially as set forth.

3. A carriage bow consisting of the bent wooden section B and the metallic tubular sections A A, the latter constituting the straight or vertical sides of the bow, substantially as set forth.

4. A carriage bow consisting of the bent wooden section B and the tubular sections A A, the latter constituting the straight or vertical sides of the bow, and constructed at their lower ends to be attached to a socket or carriage seat, substantially as set forth.

rescinded, but we insist that by so doing the appellee gave his assent to the rescinding of the contract, and, as the supreme court of Ohio held, is estopped to contend that articles made since the date of that rescission are made under the contract.

The question of the rescission of the contract of 1869, is one of which the state court had jurisdiction and one of which the federal court would not have jurisdiction by reason of the subject matter. (*Hartell vs. Tilghman, 99 U. S., 547.*) The decision, therefore, of the question, whether articles made by the defendant under the patent of 1875 (in suit here) were made under the contract of 1869, or in other words, whether that contract was in force as to such articles, was a question, of which the state court having jurisdiction, the decision of the court of last resort of that state is *final and conclusive.*

The questions which arise in this case and before this court are different, being the validity of the patent of 1875 and its infringement by the appellee. Of these questions the federal court has exclusive cognizance. The appellee (defendant below) virtually admits the validity and infringement of the patent, but sets up the contract as a defense; to this we reply that the contract is no longer in force, and was not when the infringement was committed, and that this question has been conclusively determined by a court of competent jurisdiction and ultimate resort, and between the

same parties, and hence that there is nothing left for this court to decide but the questions of validity and infringement, and that the rescinded contract is unavailable as a defense.

HENRY S. SHERMAN,

W. BAKEWELL,

Of Counsel for Appellants.

APPENDIX A TO APPELLANT'S BRIEF.

(Reported in 41 Ohio State Reports, page 357.)

In the Supreme Court of the State of Ohio.

GEORGE H. ELY ET AL. VS. ISAAC N. TOPLIFF.

ISAAC N. TOPLIFF VS. GEORGE H. ELY ET AL.

Cases in error. Reserved in the district court of Lorain county.

Sherman & Hoyt and *W. Bakewell* for *George H. Ely et al.*
S. Burke for *Isaac N. Topliff.*

By the court. By writing, Isaac agreed with John and George thus:

They to have the exclusive use of his patent for tubular carriage bows, dated December 27, 1870; one-third of the expense of maintaining the right of the patent against infringements and other patents, to be paid by Isaac, and two-thirds by the others; any improvements made by either to be for the mutual benefit of all; in consideration of "the above grant," John and George to pay to Isaac fifteen per cent. out of the wholesale selling prices, as royalty. They were also to make the articles of quality and finish to meet Isaac's approval, and to do all in their power to extend the sales. The prices were to be settled by agreement of the three. In May, 1871, Isaac obtained another patent for an improvement in the articles, and in August, 1875, an

improvement on that was patented in the name of John. They made articles according to the patent of 1870, until about February, 1871; but worked without interruption or interference under that of 1871, from its date, conforming to that of 1875, after its date. They stamped upon all articles made up to September, 1879, the date of the patent of 1870, as well as the dates of the other patents after their issue. They actually enjoyed a monopoly and gained large profits. They paid the royalties that accrued prior to April 1, 1879. On September 13, 1879, they notified Isaac that his patent of 1870 was invalid; that the contract would be no longer recognized by them, and that they would not pay any more royalties. In October, 1879, Isaac applied for a re-issue of the patent of 1870. In December, 1879, it was re-issued. In February, 1880, John and George sued to recover the royalties paid. The trial court rendered judgment for Isaac. In June, 1880, Isaac sued John and George for royalties accrued after April 1, 1879. His petition set out the whole contract; averred that the royalties were earned under the patent of 1870 upon "articles manufactured by the defendants after June 30, 1879." The answer denied the validity of that patent, and averred its re-issue.

At the trial John and George did not object to evidence proving the patents of 1871 and 1875, and that the articles were made under them under said contract. The trial court gave judgment for Isaac for unpaid

royalties accrued prior to the notice of September 13, 1879. Held:

1. Both judgments were right.

2. The contract gave royalties upon articles made under the patents of 1871 and 1875 as well as that of 1870.

3. Under the contract and conduct of the parties the invalidity of the patent of 1870, and its re-issue, were immaterial as to royalties accrued before the notice of September 13, 1879.

4. As they did not object to evidence that the royalties were earned, pursuant to said contract, under the patents of 1871 and 1875, John and George cannot complain because the trial court treated the case as if the petition had been so amended as to aver such earning.

5. Isaac's action touching the re-issue estops him from claiming that the articles made after the notice of September 13, 1879, were made under said contract.

6. We do not decide anything as to the rights or interests of the parties in the patents of 1871 and 1875, after September 13, 1879.

UNITED STATES PATENT OFFICE.

JOHN A. TOPLIFF, OF ELYRIA, OHIO, ASSIGNOR OF ONE-HALF HIS RIGHT TO GEORGE H. ELY, OF SAME PLACE.

IMPROVEMENT IN CARRIAGE-BOWS.

Specification forming part of Letters Patent No. **166,950**, dated August 24, 1875; application filed November 16, 1874.

To all whom it may concern:

Be it known that I, JOHN A. TOPLIFF, of Elyria, county of Lorain and State of Ohio, have invented a new and useful Improvement in Bow-Sockets for Buggy-Tops; and I do hereby declare that the following is a full, clear, and exact description of the same, reference being had to the accompanying drawings, forming a part of this specification, in which—

Figure 1 is a part sectional view of the bow-socket embodying my invention; Fig. 2, a detached view of the strip of steel; Fig. 3, a detached view of the wood filling, and Fig. 4 a side sectional view of my invention.

This invention has relation to bow-sockets for buggy-tops; and consists in placing a filling of wood in the tubes of the bow-sockets to strengthen the same; also, in extending the strip of steel which is inserted in the wood filling far enough down to enable it to be welded or otherwise fastened to the slat-iron.

Previous to my invention the method employed for strengthening the bows was to slit the wooden bow, placing therein a tapering piece of sheet-steel. The great difficulty in the bows constructed as above described was the continued bending or breaking of the back tubes where the steel strip ends near the slat-iron. To prevent this, in making the bow-sockets there is inserted in the back tube A a tapering strip of steel or other suitable metal, *a*, the same extending far enough down to enable it to be welded into or otherwise fastened to the slat-iron *b*, the strip of steel *a* being in reality a continuation of the slat-iron within the tube A, thus leaving no weak place to bend. I have also found that all the tubes of a bow-socket are much stronger when they are well filled with wood, and as it is difficult to properly fill them with the bows used on the buggy-top, I make small pieces of wood *c* the shape of the inside of the tube, as illustrated in Fig. 3 of the drawings, and large enough to drive in tightly, and when driven in to reach from the slat-iron *b* to within a short distance of the top of the tube, or far enough from the top to allow the buggy-bows to enter sufficiently to hold them. It is necessary that the wood filling for the back tubes be split far enough from the small end to receive the steel strip *a*. The wood filling *c* is formed with the usual groove *d* for the bead or lock upon the inside of the tube. The wood fillings can be made by machinery to fit the tubes much better than the wood bows can be fitted by hand, and very much cheaper, and, as they fit better, will make them stronger.

Having now fully described my invention, what I claim as new, and desire to secure by Letters Patent, is—

1. In combination with the back tubes of bow-sockets and wood bows or fillings, a steel or other hard-metal plate, welded or otherwise fastened within the tube to the slat-iron, substantially as and for the purpose specified.

2. The combination, with the metal tubes of bow-sockets, of a wooden filling, substantially as and for the purpose set forth.

JOHN A. TOPLIFF.

Witnesses:
HERMAN ELY,
FRED. N. SMITH.

J. A. TOPLIFF.

Carriage-Bows.

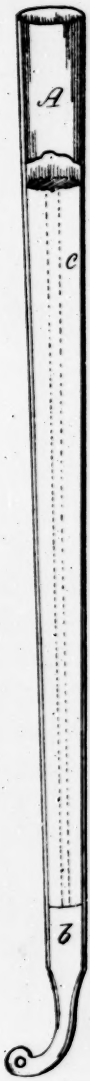
No. 166,950. Patented Aug. 24, 1875.

Fig 1.

Fig 2.

Fig 3.

Fig 4.



Witnesses:

Herman Ely

Fred N. Smith

Inventor

J. A. Topliff

122-121

SUPREME COURT

OF THE UNITED STATES.

No. 286.

JOHN A. TOPLIFF AND GEORGE H. ELY,

Appellants,

VS.

ISAAC N. TOPLIFF.

BRIEF FOR APPELLEE.

M. D. LEGGETT,

of Counsel.

HATCH PRINTING COMPANY,

CLEVELAND, O.

IN THE

UNITED STATES SUPREME COURT.

J. A. TOPLIFF
and
GEORGE H. ELY,
Appellants.
vs.
ISAAC N. TOPLIFF,
Appellee.

IN EQUITY.

If your Honors, please:—

This cause comes up from the United States Circuit Court for the Northern District of Ohio.

The suit was there brought by the appellants for the alleged infringement of United States Letters Patent, No. 166,950, of date August 24, 1875, for Improvement in Carriage Bows, granted to J. A. Topliff, one of the complainants.

The appellants here were complainants below. The following is the language of that portion of the decree which gives the decision of the Circuit Court:

"This cause came on for hearing, etc., and the court

being fully advised in the premises, and being satisfied, under the contract set up in the answer, that each party has the right to use, without the payment of royalty, the patent issued to the complainant, it is therefore ordered and decreed that the bill be dismissed at complainant's costs, to be taxed, etc." (Record p. 77).

In December, 1869, the appellee, Isaac N. Topliff, had an application for patent pending in the United States Patent Office for Improvement in Carriage Bows, and during the pendency of said application he entered into a contract with the appellants, John A. Topliff and George H. Ely, which contract was to extend during the lifetime of the patent that should issue.

This contract is to be found copied in full in the defendant's answer on page 11 of the Record.

Said contract, as your Honors will notice, recites that the patent was for tubular iron bows, used in manufacturing carriages and buggy tops.

The second clause of said contract contains the following provision :

"It is also further agreed that any improvements made in these articles, by either party, shall be for the mutual benefit of the parties."

This contract also provides in its first clause, that the appellants should have the exclusive right of manufacturing and selling the article patented for five years from the date of the agreement, and that at the expiration of five years the appellee should have the right to have the inven-

tion manufactured at not more than two other places; but in all other respects, the rights and privileges of the appellants should continue during the entire life of the patent.

Your Honors, in reading the record, will discover that almost the only question at issue is whether the appellants' patent, upon which the suit was brought, was such an improvement, as is referred to in the said second clause of said contract.

The appellants have proceeded in taking their testimony and in presenting the case to the court below, upon the ground that the improvement referred to was to be an improvement on the invention of said Isaac N. Topliff; and they have endeavored to show that the invention described and claimed in the patent at issue, was a radically different invention and not in the nature of an improvement upon said invention of said Isaac N. Topliff; but the language of the clause referred to in the contract shuts out such a construction of the contract. The language of the clause is:

"It is also further agreed, that any improvements made on *these articles*, by either party, shall be for the mutual benefit of the parties."

It is not for an improvement on the patent, but any improvement on the article. The record clearly shows that the two Topliffs, who were brothers, were struggling to bring these carriage bows to perfection, and that each was

making suggestions to the other. They were constantly improving them, until finally they seem to have been brought to a high degree of perfection.

The appellee, I. N. Topliff, entered into the employ of the appellants, and became their traveling agent; and, as the testimony shows, worked up a very large custom, to such an extent that the profits of the business amounted to not less than fifty thousand dollars annually.

As Isaac N. Topliff was constantly among the users of these carriage bows, he heard all of the objections made to them, and was constantly making suggestions of improvemsnts to the appellants.

The parties all discovered six months before the issue of the patent to Isaac N. Topliff of 1870, that the device, as described in said patent, was not practical; and abandoned the manufacture of the same two or three months before making said contract.

Isaac N. Topliff obtained another patent, No. 114,885, of date May 16, 1871, which was also thrown into the hands of the appellants, under said second clause of said contract, though not named in said contract. This patent is found on the 28th page of the record.

In accordance with this contract the appellants had agreed to pay the appellee, as royalty, a sum equal to fifteen per cent. on the wholesale selling price of the articles manufactured. They paid these royalties without com-

plaint or objection, up to 1879, when said appellee was making arrangements to commence the manufacture of the device at Cleveland, Ohio, in accordance with the terms of his contract.

When he entered into the contract he reserved the right to manufacture at two other places than the appellants, after five years, but he permitted nine years to pass before he attempted to do so.

The record shows that the rupture of the friendly relation between the parties occurred at the point of time when the appellee determined to manufacture the device.

The testimony in this case is confined entirely to the parties.

There were but three witnesses called, the two Topliffs and Mr. Ely, and their testimony is so brief that it is scarcely necessary to make any synopsis of it as we presume your Honors will read the testimony of these witnesses.

The record, though small, embraces considerable other matter than the testimony of the witnesses named; and in so reading, your Honors will discover that the appellants have made an effort to convince the court that the defendant gave no consideration for the contract that so long existed between the parties and that was acquiesced in by both parties for about ten years; and until the defendant attempted to avail himself of a clause of the contract that permitted him to manufacture for himself.

The defendant applied for a patent in November, 1869,

which was granted December 27, 1870, and was made the basis of the contract between the parties.

There is no doubt but the defendant believed when he applied for his patent that he was entitled to a patent on the metallic tubular upright portion of the bows, but that claim, it seems, was rejected upon two references. One was a patent previously granted to A. C. Shelton, December 29, 1857, and numbered 18,992, and which did not contain this invention at all, while the other reference was a rejected application lying in the Patent Office, which did contain it.

At that time rejected applications in the Patent Office were regarded as sufficient reference upon which to reject a subsequent application; but subsequently the courts decided that merely a rejected application, without proof of public use, was not such a reference as should or could prevent a valid patent afterwards obtained for the same thing, so that the defendant, as far as any proof goes, was the first to develop and bring into public use the tubular part of the carriage bow made by the parties to this suit.

The appellants claim that they did not know until 1879 that such a claim was not allowed, and the probabilities are that the defendant did not know it until some time after. At that time he commenced proceedings to obtain a reissue, which is shown in the record, and in this reissue

he obtained a broad claim in the following language as shown on the 71st page of the record:

"A carriage bow, the sides, or upright portions, A A, of which are tubular substantially as and for the purposes shown."

As the courts considered reissue patents at that time, viz.: July 6, 1880, when this reissue was issued, this claim was valid, but under the subsequent and present holdings of the courts, it would be invalid, as being new matter not claimed in the original, but the fact that this claim was allowed in 1880 is evidence that it should have been allowed in the 1870 patent.

Both parties believed that the patent covered it, and there is no evidence that anybody else attempted to manufacture it during the time of its existence, so they had the exclusive right to this tubular portion and the exclusive use of it, the same as if the patent had covered it, as all parties supposed it did.

In 1871 the defendant obtained a patent No. 114,885 (see page 49 of the record) which embraces a strip of plate steel to be placed in these tubular portions of bows for the purpose of stiffening and strengthening them. This, under the contract for all improvements, was also turned over to the use of the appellants.

In 1875 Mr. J. A. Topliff, one of the appellants, obtained a patent for welding these strips of steel to the slat irons of the carriage bows, and also for a wooden filling to

be put into these tubular portions of the bows by the side of the metallic strip.

The testimony of the defendant shows clearly that the defendant was really the inventor of the filling of these metallic tubes with wood beside of the metallic strips, and that it ought not to have been embraced in the patent of J. A. Topliff, as J. A. Topliff was not the inventor, and it was in use more than two years prior to the application for the patent.

This, we think, is clearly shown in the defendant's testimony.

On the bottom of page 26, and top of page 37 of the record, your Honors will see that the defendant has sworn that the wood filling was placed in these metallic tubes as early as July or August of 1870, and that they went into public use on carriages that were being repaired at the complainants' shop.

The evidence shows, therefore, that the patent, No. 166,950, for the alleged infringement of which this suit is brought, was not the sole invention of John A. Topliff, but the joint invention of the two brothers, John A. Topliff and Isaac N. Topliff, and being such joint invention it could not be sustained against either of them, and the patent itself must be invalid. But admitting the patent to be a valid patent, as before stated, it must be included under the second clause of the contract made between the parties to this suit in 1870, as shown on page 11 of the record.

To show this more clearly, let us trace, step by step, the construction that was given to this clause by the parties themselves.

The defendant's patent of 1870 was included by the terms of the first clause of the contract.

The defendant's patent of 1871, No. 114,885, page 49 of the record, was obtained May 16, 1871, and was immediately adopted by the complainants and used under the second clause of this contract, so the defendant has produced the tubular portion of the bows, and has placed within said tubular portions a metallic strip to strengthen them.

This certainly was regarded as an improvement made on the articles which were the subject of the contract, and was also an improvement of the device described in I. N. Topliff's patent of 1870.

In 1875 J. A. Topliff obtains a patent, page 27 of record, for fastening the defendant's strip to the slat iron of these bows; and certainly if the defendant's patent of 1871 was an improvement on the articles so as to be adopted by the complainants, and absorbed into their business, the patent to John A. Topliff being a single step further in the same direction, certainly must be held also to be such improvement, and to be included within the contract, and moreover, it was an improvement on, and merely another step in the perfection of Isaac N. Topliff's inventions of 1870 and 1871.

It was certainly so regarded by all the parties, as they

continued, after 1873; to manufacture strictly in accordance with this patent of 1875 and to pay royalty to the defendant down to 1879.

We have, then, the parties themselves all recognizing the fact that these patents are all for improvements on the articles referred to in the agreement between them; but we do not need their construction of the patent in order to sustain the defendant's claims under it, for the language is not ambiguous, and needs no construing, for it reads:

"It is also further agreed that any improvement made on these articles by either party shall be for the mutual benefit of the parties."

If the J. A. Topliff patent of August 24, 1875, was for an improvement in tubular iron bows used in manufacturing carriage and buggy tops, then it certainly must be the improvement referred to in this agreement; and that they have treated it as such improvement, there can be no doubt, for all parties have manufactured it and nothing else since 1873.

We respectfully submit, therefore, that if the patent is valid the defendant has a right to use the same in common with the complainants, as decided by the court below; and second—if it is not valid then the decree must be in favor of the defendant, as he cannot be held responsible for the use of mechanism covered by an invalid patent.

Respectfully submitted,

M. D. LEGGETT,

of Counsel for Appellee.

122-121

Supreme Court of the United States.

October Term, 1886.

No. 286.

JOHN A. TOPLIFF, et al., Appellants,

vs.

ISAAC N. TOPLIFF, Appellee.

BRIEF FOR APPELLEE.

Appeal from the Circuit Court of the United States for the Northern District of Ohio.

S. BURKE, and
W. W. BOYNTON,
Counsel for the Appellee.

FAIRBANKS & HART, Printers, 74 Frankfort St., Cleveland, O.

Supreme Court of the United States.

October Term, 1886.

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BRIEF FOR APPELLEE.

Appeal from the Circuit Court of the United States for the Northern District of Ohio.

S. BURKE, and
W. W. BOYNTON,
Counsel for the Appellee.

STATEMENT OF THE CASE.

By their bill the complainants, Topliff & Ely, sought to restrain the respondent, Isaac N. Topliff, from making and selling carriage bows which, it was alleged, were an infringement on the letters patent granted to the complainant, John A. Topliff, Nos. 166, 950, August 24th, 1875.

The bill also prayed for an accounting. By the answer of the respondent, he set up :

1. Non-infringement.

2. Want of novelty ; and

3. That by the terms of the contract entered into between the appellants and appellee, and set out in the defendant's answer, he had the right to manufacture all articles covered by the patent of John A. Topliff. Issue was joined by replication to the new matter set up in the answer. The case went to trial and the Circuit Court, without passing upon the issues arising upon the first and second defense, gave judgment for the appellee on the 3d defense above stated, viz.: That by the terms of the contract set up in the defendant's answer, he had the right to manufacture the improvement covered by the patent of John A. Topliff ; from that decree the complainants brought the case to this court by appeal. Counsel for the plaintiff are quite wrong in saying that the appellee does not insist upon the want of novelty in the invention covered by the patent of the complainant, Topliff, if the defense is not sustained upon which judgment was given in favor of the appellee by the Circuit Court ; but we will discuss this question further on.

The following facts, if not undisputed, are clearly established by the evidence : In 1869 the appellee applied to the Patent Office for Letters Patent for an improvement in carriage bows. His brother, one of the complainants, then a manufacturer of carriages, examined it, and being well pleased with it, desired to secure for the complainants the exclusive right to manufacture the improved article. Thereupon an agreement was entered into be-

tween the complainants and the respondent, which was made a part of the respondent's answer, and will be found on page 16 of the record. It was well known by the parties at that time that a patent had not been granted upon the application and consequently the date at which the agreement was concluded was left blank with a view of supplying the date after the Letters Patent should be issued.

The agreement in effect gave to the complainants the entire monopoly in the manufacture and sale of the patented article and all improvements that might be made thereon during the life of the patent, and during the life of any patent that might be issued upon any improvements made upon the same, with the single reservation to the respondent of the right to manufacture the articles after five years in two places in the United States outside of the place where the complainant resided.

It was also provided that the expense of maintaining the right of the patent against any infringement of other parties should be borne by the respective parties in the proportion of two-thirds to the complainants and one-third to the respondent, and that all improvements made upon the articles by either party should be for the mutual benefit of both parties. The complainants immediately went into the manufacture of the article and continued to manufacture it until certain improvements were suggested by the parties in some part or parts of the article manufactured, from which time the article as improved was manufactured until 1871, when the respondent procured a patent embodying these improvements. The complainants continued to manufacture the improved

article so covered by the second patent until further improvements suggested themselves, which were adopted upon mutual consultation between the parties, which article so secondly improved was manufactured by the complainants until the year 1873 or 1874, when the idea of extending the strip of steel, which was inserted in the wood filling for the tube, further down in the tube and weld or otherwise fasten it to the slat-iron, was suggested by complainant, John A. Topliff. This improvement was patented in 1875, long after it had been put into use by the complainants. During all this time the respondent was in the emplyment of the complainants, spending most of his traveling throughout the United States and in opening up a field for the sale of the article thus manufactured. He continued in their employment until 1879. The complainants during the whole period from 1869 to 1879, recognized the contract between the parties above referred to as binding and fully recognized the right of the respondent to share in all the improvements that had been made on the article patented in 1870; and no question was made by them as to the rights of the appellee to his share of the benefits of the improved article, and to royalty on all bows sold as stipulated, until the respondent sought to avail himself of the right reserved in the contract to open up the manufacture of the same article in the City of Cleveland. Here was a practical and unquestioned construction of the contract between the parties for the period of nearly five years after the issuing of the complainant's patent, and for nearly seven years after the parties first conceived the notion of strengthening the bow by welding the steel to the

slat-iron. During all this time the complainants enjoyed the exclusive monopoly of the manufacture and sale of the articles and derived therefrom large income and profits; and as an evidence of the fact that the article was satisfactory to them, and that they were still manufacturing it, notwithstanding the statement of John A. Topliff in his testimony, to the contrary—in 1871 they put out the following circular, found on page 50 of the record which gave their knowledge of its merit: "We have the pleasure of presenting to our numerous friends and customers in the following pages, a descriptive catalogue of our bow-sockets. We have now been manufacturing the bow-socket for a year, during which time we have constantly been improving them, overcoming every fault that has been discovered, and now offer them as the best article that can be used in making a top for buggies and carriages.

The demand for the bow-socket was so much greater than we had expected that we were obliged to disappoint many who favored us with orders, it being utterly impossible to manufacture enough to supply the demand. That we may be able to fill all orders promptly, we have greatly increased our facilities for manufacturing, and hope to be able to give all orders prompt attention. We shall be pleased to hear from all our old customers, and as many new ones as may favor us with their orders."

And in 1872, page 52 of the record, is another statement made by the complainants of the character of the bow-socket:

"We have the pleasure of presenting to our numerous friends and customers, in the following pages, our second

annual catalogue of bow-sockets. We have now been manufacturing the bow-sockets for two years, during which time we have constantly been improving them, overcoming every fault that has been discovered, and now offer them as the best article that can be used in making a top for buggies and carriages.

In our last catalogue we had some patterns which were not so strong as those we now make, and offer only those which, which by long and severe trial have stood the test. The bow-sockets we now make only differ from each other in style of slat-iron, and of these we have a variety of styles to suit all tastes. The slat-irons are all forged from the best Norway iron and the tubes are welded on.

Many of the best carriage makers in the country have favored us with recommendations of the bow-socket, but the simple fact that these same carriage makers use the bow-socket is as valuable an endorsement as any letters can be; we therefore give a partial list (see page 9) of well known carriage makers who have been using the bow-socket during the past year. As far the greater number buy from the hardware dealers, our list includes only a small part of those who are using the bow-socket, and only those who have bought direct from us. Probably every one will find in the list we give the names of one or more with whom he is acquainted, and their disinterested opinion will have more influence than any statements we can make."

The improvements here spoken of and the various improvements made down to A. D. 1873, appear from the testimony of the respondent on page 37 of the record.

Q. "You may state how these improvements were brought about and what discussions you had concerning them with your brother. State fully the history of the transaction down to the last improvement made."

A. "All of the improvements were made in consultation with Mr. Topliff, my brother, and Mr. Ely. As we saw that they needed improvement we improved on them. The improvement of filling was put in, because we saw that carriage makers did not fill them as fully as they should. In shaving the bow, they would not fill it, so by having the pieces turned they were better filled and driven in by ourselves. The first idea of *filling was my own*, as early as June or July in 1870; about the same time we thought of inserting this strip steel in the back of the bow as a stiffener. That was my suggestion also. The lock of the tube was at my suggestion as early as January, 1870; soon after they began to get machines to lock them."

Q. "Those were all the improvements down to 1873?"

A. "Those were all the improvements and they were patented in my name. There never was any dispute but what I was the inventor of the patented devices."

Q. "What change, if any, was made in 1873?"

A. There was no change in 1873 with the exception of welding the steel to the end of the slat-iron, as we called it, and putting the filling into all that we sold. We had put in filling before that, but it was mainly done on repair jobs. When a man would break a bow, to repair it we would cut off the broken bow and fill one of the tubes."

Q. "Whose device was this welding?"

A. The welding of the steel to the slat-iron I suppose was my brother's device. I understand that it has been claimed, though, by others—that others did it previously to that."

Q. "How did it come about that the firm of Topliff & Ely and yourself adopted that device."

A. "It was talked up that those steels that we sent out with the sockets to be put into bows, we found out that they were not put in, and my brother suggested that we weld them right to the slat-iron and put them in ourselves, and in that way the carriage makers would be compelled to use them if they used the sockets."

Q. "Was that a subject matter of conversation between you and your brother?"

A. "Yes, it was talked up a number of times before it was adopted."

Q. "Was there any conversation between you and your brother as to the procuring a patent for that device?"

A. Yes, sometime in 1874 or 1875, I think it was. I came home and my brother said that they concluded to patent that device of welding the steel to the slat-iron, and he said that he thought they had better take out a patent and make a claim for the filling also. I told him that the filling, of course, was my improvement, and I did not know that it would be right to insert it into his patent. He said that *it would make no difference as our contract would cover it all.* He said that it would make no difference which took out the patent, whether it was in his name or my name, and I made no further objection to it; but I always claimed, and he never disputed it that

time, that the device was mine as the filling was concerned. I had used it from as early as July or August, I am not certain which, in 1870."

A careful or even casual reading of the testimony given by the complainants and the respondent, will show that during the early years of manufacturing carriage bows or bow-sockets, both parties to the above contract were on the lookout for defects in the article with a view to their improvement. The testimony of the complainant Ely, page 55, not only shows that the respondent was in consultation with the complainants over improvements, but that he was equally interested therein. The following are some of the interrogatories and answers :

Q. "You may state whether or not the defendant, was with you, aiding or suggesting in any way, in regard to the manufacture under the original patent."

A. "Most of the time he was traveling. Occasionally he would be at home and then would advise and consult with us."

Q. "Do you know of his making any objection to the manner in which you were making them?"

A. "Yes."

Q. "At what time?"

A. "I could not state the time. He would see failures as they would occur, as they would in any new article, and speak of them and suggest remedies; sometimes would show dissatisfaction, as was natural, for he was anxious to see a success of it, and would, as he supposed, justly hold us accountable for the failures, where we would say unjustly, because our interests were as great as his to make it as successful as we could."

Q. "Were his suggestions considered by you?"

A. "They were considered, occasionally may have been adopted, occasionally we thought best not to adopt them."

With a recapitulation of the facts clearly appearing from the testimony, we leave this branch of the case.

FACTS.

Prior to December, A. D. 1869, appellee had filed his application for a patent for tubular iron bows used in manufacturing carriages and buggies.

Some time in December, A. D. 1869, the contract in writing was made between the parties in the terms set out in the answer.

At the time this contract was signed a sample set of the iron bows had been made which the parties had for inspection.

The complainants commenced to manufacture these articles about the first of January, A. D. 1870.

The appellee went into their employment as traveling salesman, and to work up a trade for the carriage bows.

The articles as first made did not prove entirely satisfactory; improvements were made from time to time; suggestions being made by all interested.

December 27th, 1870, letters patent were granted the appellee on the application above referred to.

In May, 1871, letters patent were granted to the appellee for an improvement in the articles.

In August, 1875, letters patent were granted to the complainant, John A. Topliff, for a second improvement.

All these improvements were made prior to December,

A. D. 1873, although the patent to John A. was not issued until August, 1875.

All of the improvements, except the one of welding the steel to the slat-iron, were suggestions of the appellee; and those suggestions, or rather improvements that grew out of them, were carried into the patent of the complainant, Topliff, in August, 1875 ; he adding, as his own suggestion, the improvement of welding steel to the slat-iron.

The complainants at first manufactured the articles as originally invented by the appellee and covered by his patent of December, 1870.

Then for a while they manufactured the article, improved, as shown by the second patent of the appellee, A. D. 1871, and after 1873 or 1874, the article as improved in the manner shown by the patent of John A. Topliff.

The appellee continued in the employment of the complainants until the year 1879. During all this time royalty was paid under this contract and in accordance with its terms as well as under the improvement made by John A. Topliff as under the improvements made by himself, without any question of his right to receive it. In view of these facts it is submitted that the Circuit Court was right in holding that the appellee under the contract between the parties had a right to manufacture after the expiration of the five years the improved article at his manufacturing establishment in the city of Cleveland. Although the Court was clearly wrong in putting into the decree the finding not at all involved in the case that we were not entitled to royalty on their completed manufacture.

II.

To the claim of the appellants that the reissuing of the patent of 1870, and the securing of the same, *ipso facto*, operated as a recision of the contract and an abandonment by the appellee of all the rights thereunder, there are several decisive answers :

1. The parties had long since by common and mutual assent abandoned the manufacture of the article in strict accordance with the specifications of the patent of 1870, and were working under the patents of 1871 and 1875, making what all conceded to be an improvement upon the article patented in 1870. Every good quality or feature of the patent of 1870, had been carried into the patent of 1871 and 1875, and hence the reissuing of the patent of 1870, in nowise affected the rights of the parties under the patents of 1871 and 1875 and the appellants are still enjoying the benefits of those two patents.

But, secondly, if the reissue is for any reason void, neither it or the surrender of the patent of 1870, could in anywise affect the appellants or their interest in the patent, as they were not mere licensees, but assignees of an interest in the patent, and were not parties to the surrender, nor did they consent thereto.

Section 4915 of the Revised Statutes, provides :

"Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee's claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertance, accident or mistake, and without any fraudulent or desceptive intention, the Commissioner shall, on the surrender of such patent and

the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification to be issued to the patentee, or in the case of his death or of *an assignment* of the whole or any undivided part of the original patent, then to his executors, administrators or *assigns*, for the unexpired *part* of the term of the original patent."

This statute saves the right of all the assignees in case of an assignment by requiring the reissued letters to run to the assignee for the unexpired part of the original term.

In *Littlefield vs. Perry*, 21 Wall., 225, this court, speaking through the Chief Justice, said: "If a reissue is obtained with the consent of an assignee, it inures at once to his benefit; if without, he has his election to accept or reject it."

The assignment vests in the assignee an interest indefeasible by the act of the patentee. When the patent or an interest in it has been assigned the reissued patent must run to the owners. The reissue does not create a new interest, but amends the original patent from its commencement by correcting a defective specification.

Curtis Law of patents, 197.

This author further says, that, "where a patentee has by an assignment vested in an assignee a portion of the monopoly which he holds, he connot affect the rights of such assignee by a surrender and reissue without his consent."

And again, that the proper effect to be given to the statute above cited, requires that, where the whole patent has been vested in an assignee, he should make

the surrender, and where a part only has been assigned, the assignee should unite with the patentee in the surrender. But, if the surrender is made by the patentee alone, and the patent is reissued to him previous assignments are not vacated, but the reissued term enures to the benefit of the assignee without any new assignment.

Weth v. Stone, 1 Story, 273.

Woodworth v. Stone, 3 Story, 749.

Brooks v. Bicknell 4 McLean, 64, 333, 526.

And again, if the assignee has not consented to the surrender and elects not to accept the benefit of the reissue, or if the reissue is void, his rights remain unaffected thereby and the surrender is wholly inoperative upon him.

Curtis on patents, 197.

Woodward v. Stone. *supra*.

What then were the rights acquired by the appellants under the contract? Were they mere licences, with no legal interest in the patent, or were they assignees of a legal interest therein? If they acquired an interest in the patented invention as distinguished from the mere right to practice it, or to use the thing patented, they were assignees.

Section 4898 of the patent act provides, that every patent or any interest therein shall be assignable in law by an instrument in writing; and the patentee or his asssgns or legal representatives, may in like manner grant and convey an exclusive right under his patent to the whole or any specified part of the United States.

This section makes any interest assignable by a written instrument, and such instrument carries a legal

interest as distinguished from equitable one; and by a like written instrument the patentee may grant an exclusive right under his patent to the whole or any part of the United States.

In Curtis on the Law of Patents, sec. 211, it is said "that the distinction between an assignment and licence under our patent laws, relates to the interest in the patent, as distinguished from the mere right to use the thing patented or to practice the invention. An assignment, whether of the whole or an undivided part of the patent of the exclusive right within a particular district necessarily operates to diminish the interest of the patentee. But a licence is a grant or permission to practice the invention or to use the thing patented, which leaves the interest of the patentee just as extensive as it was before."

In Walker on patents, section 252, it is said "an assignee of a patent is a person to whom the entire legal interest or an undivided part of the entire legal interest, in a patent, has been duly assigned by an instrument in writing."

The grant, in the present case, in it legal effect, was of all the right and title of the appellee in and to the patented invention for its life, with the reservation by the appellee of the right to have the article patented, manufactured after five years in two places other than the one where in the appellants' manufactory was located. The right assigned was exclusive for five years, and also exclusive for the remainder of the life of the patent, with the exception stated.

Had the assignment been formal for the whole inter-

est, the assignees giving back a licence to the patentee to manufacture the patented article in two places in the United States, outside of Elyria, where the complainants works were located, to be selected by him, the effect of the transaction would have been precisely the same as it now is. And were this its form, who would for a moment contend that the buyer did not take a legal interest? The appellants were not merely permitted to cause the article to be manufactured and sold at and from their factory. They could have established and can now establish a factory in every town in the United States and territorities for its manufacture. To say that the interest they acquired was only a mere right to manufacture, when the patentee had deprived himself of the right to licence to others the right to manufacture is to lose sight of the full scope and intent of the contract. A mere licensee can bring no action for infringement for the obvious reason that he is not affected by it, but an assignee is, to the extent of his interest, affected as much as the patentee, and hence can maintain an action to enjoin the infringement. Would it for a moment be doubted that the interest acquired by the appellants under the contract was sufficient for the basis of an action to restrain third parties from infringing the patent.

It is quite true that the contract does not in terms authorize the appellants to grant to others the right to make and vend the patented article; but that they had and have such power, seems perfectly clear, for the appellee did not retain it, and no one will claim that the right was extinguished. It was the exclusive right *of* manu-

facture that the appellee granted to the appellants, and in all other respects, after saving the right to have the article manufactured in two other places the right and privilege of the said party of the second part (complainants) shall continue the entire life of the patent.

The interest acquired by the appellants under the contract was quite as extensive as that acquired by the assignee of the patent in *Woodworth* v. *Wilson*, 4 How., 712, where it was held that the patentee and assignee were properly joined as plaintiffs in an action to enjoin an infringement. The interest acquired in that case was the "exclusive right to construct and use ten machines in the city of Louisville and a district of country within ten miles thereof." If this had not been a legal interest such suit by the assignee could not have been maintained.

See *Gaylord* vs. *Wilder*, 10 How., 477.

In *Perry* vs. *Corning*, 7 Blatchford, 191, the patentee transferred all his right and interest in letters patent, embracing all future terms and improvements, to the assignee to manufacture and sell the same within the State of New York and Connecticut. There the right in term conveyed was to manufacture and sell; and it was contended that the instrument gave a mere license and not an assignment. The court, however, held that such an instrument, if not technically an assignment of an undivided part of the patent was a grant of the exclusive right, under the patent to make and use, and *to grant to others* the right to make and use the thing patented within the limits specified.

If in the present case the exclusive right of manufacture and sale throughout the United States had been grant-

ed during the life of the patent of instead five years, there would be no question that the grant would carry an irrevocable interest in the patent to the grantees. And any interference with or infringement of the right thus assigned, would authorize the assignees to maintain an action to restrain the unlawful use, whether the infringement was by the patentee or anyone else. And we submit that the same right would exist in the assignee to enjoin the patentee from infringing the right assigned, where there was a limit or period put to the enjoyment by the assignee, during such period, as where the right assigned extended through the life of the patent. The statute is clear in its language that every patent, or any interest therein, shall be assignable in law by an instrument in writing, Section 4898.

Whether an instrument in writing operates to effect an assignment is one of intention. As was said by Taney C. J. in *Gaylor* or *Wilder*, *supra*, 467 the thing to be assigned is not the mere parchment on which the grant is written. It is the monopoly which the grant confers; the right of property which it creates. This certainly went to the appellants under the contract between the parties.

It is also said by counsel for the appellants, page 46 of their brief, that the question of recision has been settled by a court of competent Jurisdiction and states in support of that proposition that the Court oi Common Pleas, of Lorain County, Ohio, so held and that its judgment has been since affirmed by the Supreme Court Commission of Ohio. And in support of this statement they refer to page 90 of the record. It is quite remarkable

ITEMS OF EVIDENCE BEARING ON THE CONSTRUCTION TO BE GIVEN TO THE CONTRACT.

"We continued to manufacture and sell sockets under the patent of my brother until my patent was obtained. (Testimony of John A. Topliff, record page 19)."

"Sent out steel strips covered by the patent of 1871 with sockets manufactured under the patent of 1870." (Testimony of Ely, page 62.

"When patent of 1870 issued we had ceased to manufacture its combination. I. N. Topliff had made application for second patent and we paid little attention to first." (Testimony of Ely, page 63.)

"On return from trips by Isaac he would refer to defects and we would consult about them." (Ely, page 64.)

"First change as a result of interviews was to lock tube instead of solder." (Ely, page 64.)

"Next change abandoned plates and inserted slat-irons." (Ely, page 64.)

"There was no particular point specified in patent of 1871, where steel should end." (Ely, page 65.)

"We changed from one improvement to another until we produced the article in its present shape." (Ely, page 65.)

"I know it to be true that John and Isaac were in frequent consultation over the defect (supplied by welding) and the manner of remedying it." (Ely, page 68.)

"We welded the steel into the slat-iron in the latter part of 1872." Ely, page 68.)

"No offer was ever made to surrender or cancel the contract." (Isaac Topliff, page 42. Not denied.)

"The reason of first failure was attributable to a great extent to poor manufacture." (Isaac, page 40.)

"The complainants said if I would not go into the business, they would continue royalty." (Isaac, page 39.)

"Never denied my right thereto." (Isaac, page 39. Not denied.)

that such a claim should be ma of the fact
that there is not the slighest refe ch an action
in any pleading filed in this case ticle of com-
petent testimony offered respect iat an action
may have been pending in the t, when this
case was pending below, and inv ne feature of
the controversy between the part case, may be
true, but this court surely cannot be advised what
the issue was, what the evider ior what the
result was except by the proper pl d proof made
by the record of it. No such ple here, and no
such proof, and neither the Circui r the counsel
for the appellee, were advised n intimation
that the claim was made that the of such an
action or the judment of Common ein, had any
bearing whatever on the present the court, in
the case referred to in the 41 O. age 358, ex-
pressly say that it did not deci g as to the
rights or interest of the parties nts of 1871,
and 1875, after September 13th, g the ques-
tions made in this case entirely nd entirely
unconsidered, even if it were sh ey were in-
volved in the controversy, which r that adjudi-
cation.

The agreement had a sufficient consideration whether the patent was valid or invalid. Marston v. Swett, 66 N. Y., 206.

THE COMPLAINANT'S DEVICE ABLE.

III.

3. We further contend that the device of the complainant consisting of the welding of the steel to the slat-iron is not patentable. It is nothing more than ordinary mechanical skill would have suggested. It matters not

that the answer does not in express language set up such objection, as this court has repeatedly held that such an objection can be taken in the absence of an averment.

In *Brown vs. Piper* 91 U. S., 37 to 44, this court, speaking through Mr. Justice Swayne say: "We think this patent was void on its face" (because the improvement described therein was not patentable,) "and that the court might have stopped short at that instrument, and, without looking beyond it into the answers and testimony, *sua sponte*, if the objection were not taken by counsel, well have adjudged in favor of the defendant."

So again in the case of *Dunbar vs. Myers*, 94 U. S., 187, the patent was held void because the claim of the improvement did not describe a patentable invention, notwithstanding the pleading raised no question upon the point.

In *Slawson vs. Grand Street R. R. Co.*, 107 U. S., 649, the same doctrine was reaffirmed. Mr. Justice Woods, referring to the practice sanctioned by the two cases just referred to, says: "We think the practice thus sanctioned is not unfair or unjust to the complainant in a suit brought on letters-patent. If they are void because the device or contrivance described therein is not patentable, it is the duty of the court to dismiss the cause on that ground whether the defense be made or not. It would ill become a court of equity to render a money decree in his favor for the infringement of letters-patent which are void on their face for want of invention. Every suitor in such a cause should, therefore, understand that the question whether the invention, which is the subject matter in controversy, is patentable or not is always open to the

consideration of the court, whether the point is raised by the answer or not."

Did then the complainant's improved patent in 1875 amount to an invention within the meaning of the act of congress, section 4886 of the Revised Statutes.

In the *Atlantic Works vs. Brady*, 107 U. S., 199-200, it was said: "The design of the patent laws, is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. It was never their object to grant a monopoly to every trifiing advice, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures."

To the same effect is the case of *King vs. Gallun*, 109 U. S., 99, where it was said, that: The court will take judicial notice of maters of common knowledge, and of things in common use."

In this case it was likewise held, that the article of manufacture described in the specification and claim of complainant's patent in that case did not embody an invention, and that the patent was for that reason void; and the court upon its own examination of the specification and claim, affirmed the judgment dismissing the complainant's bill.

The same principle was affirmed in *Estey vs. Burdett*, Do, 633.

So in *Bussey vs. Excelsior Manufacturing Company*, 110 U. S., 131, the same principle was applied.

In *Phillips vs. Detroit*, 111 U. S., 604, the patentability of the invention therein considered was denied, and in

disposing of the case, the court say: "In passing upon the novelty of the alleged improvement covered by this patent, we are permitted to consider matters of common knowledge or things in common use."

"In *Terhune vs. Phillips* 99 U. S., 593, it was held: "We cannot fail to take judicial notice that the thing patented was known and in gereral use long before the issuing of the patent. The substitution of metal for wood was destitute both of patentable invention and utility."

In *Morris vs. McMillan*, 112, U. S., 244, it was said, reaffirming the doctrine of the above cases that "The process of development in manufactures creates a constant demand for new appliances which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different directions. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequences."

Again, in *Hollister vs. Benedict & Burnham Manufacturing Company*, 113 U. S., 59. it was held that "novelty and increased utility in an improvement upon previous devices do not necessarily make it an invention."

"A device which displays only the expected skill of the maker's calling, and involves only the exercise of ordinary faculties of reasoning upon materials supplied

by the special knowledge and facility of manipulation resulting from habitual intelligent practice, is in no sense a creative work of inventive faculty, such as the constitution and the patent laws aim to encourage and reward."

And in the case of *Thompson vs. Boisselier*, 114 U. S., 3, it was held that whether a given device "amounted to an invention, the state of art at the time of procuring the patent must be regarded." And the doctrine above quoted from the *Ateantic Works vs. Brady*, 107 U. S., to the effect that every trifling device which would naturally and spontaneously occur to any skilled mechanic or operator, in the ordinary progress of manufacturers, was not patentable, was reaffirmed.

Within the principle of these cases we submit that the so-called "discovery," or conception, that it would sufficiently strengthen the back bow to weld the steel to the slat-iron, was not "invention" within the meaning of the Act of Congress; (Sec. 4886 R. S.), and displays no more than the "expected skill of the mechanic's calling," and involves "only the exercise of ordinary faculties of reasoning upon materials supplied by special knowledge and facility of manufacture resulting habitual intelligent practice. Indeed it required much less than this. It had been ascertained that the back bow was weak at the point where the slat-iron approached the steel; common sense would have suggested that the difficulty could be readily obviated by extending the steel to the point of contact and welding the two parts together. This was all the "creative work" and the full extent of the "inventive faculty" supplied by the complainant Topliff; and for this remarkable exhibition of inventive genius,

he calls upon the remainder of mankind to pay him tribute.

Every other part of his alleged combination was taken from the patent and the discovery of the appellee. This will appear by a comparison of the specifications, drawings and claims of the patent of 1871, and the patent of 1875, in connection with the testimony showing the appellee to have suggested the wood filling for the tube, adopted by toe complainants.

We therefore, respectfully submit, first, that the appellee hasthe clear right under the contract to manufacture the article covered by the patent of 1875, and if not, that the patent is void for want of invention.

Respectfully submitted,

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Solicitors for the Appellee.